IN THE

Supreme Court of the United States

October Term, 1901. *No.*

JOHN A. BRILL AND THE J. G. BRILL COMPANY,
Petitioners,

vs.

THE PECKHAM MOTOR TRUCK AND WHEEL COMPANY, *et al.*,
Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

ARGUMENT FOR PETITIONERS.

John A. Brill and the J. G. Brill Company, the Petitioners herein, respectfully ask for a writ of *certiorari* directed to the United States Circuit Court of Appeals for the Second Circuit.

The reasons for invoking the supervising action of this Court are as follows:

This cause was heard in the Circuit Court for the Southern District of New York upon bill and injunction affidavits on behalf of the complainants, and answering affidavits on behalf of the defendants. Under the rules of practice in that court, the defendants' affidavits were not filed or served upon the complainants' counsel until the argument began, and the com-

plainants were not permitted to present rebutting affidavits. It appeared that a previous suit upon the same patent here in controversy (*Brill* vs. *Third Avenue Railroad Company*) had been heard by Judge Shipman upon a long and elaborate record, and that the learned Judge had sustained the patent in suit and claims 1, 2, 9, 10, 11, 12, 14 and 27 thereof. The Circuit Court, it appearing that *no new matter* was set up as a defence that had not been presented in the prior case before Judge Shipman, and that the interpretation placed by Judge Shipman upon claims 1 and 2 (upon which alone the motion for a preliminary injunction on this case was made) undoubtedly settled all the questions of infringement, ordered a preliminary injunction to issue upon claims 1 and 2, staying its operation, however, pending an appeal if taken within five days. Upon appeal, the Circuit Court of Appeals for the Second Circuit, though not denying that Judge Shipman's interpretation of those claims *fully covered the trucks of the defendants* in this case, held that "it was not necessary in that case (before Judge Shipman) to define accurately claims 1 and 2;" proceeded to consider them afresh, though the defence set up was precisely the same as in the prior case before Judge Shipman, placed a different construction upon them from that of Judge Shipman and made an order reversing the decree of the Circuit Court and directing that a decree be entered dismissing the bill of complaint. The court below based its decree solely upon the case of *Mast, Foos & Co.* vs. *Stover Manfg. Co.*, 177 U. S. 484.

The petitioners deem themselves aggrieved by this decree, and seek a writ of *certiorari* to correct it, for the following reasons:

I. *The doctrine of the Mast-Foos case does not apply to the case at bar.*

II. *The court below should have affirmed the decree of the Circuit Court under the "Rule of Comity," upon the prior adjudication of Judge Shipman.*

I. *The Mast-Foos case does not apply.*

We submit that the doctrine of that case was entirely misapprehended by the court below and that its application to the facts of the present case was error. We submit that there is no resemblance between the facts of this case and of the *Mast-Foos* case, except that both cases arose upon motions for a preliminary injunction which had been granted in the Circuit Court, and that in both cases the Circuit Court of Appeals reversed the decree of the Circuit Court, and directed a decree that the bill be dismissed.

In the *Mast-Foos* case the patent in suit related to the use in a windmill of a simple mechanical gear device as old as mechanics. When the record came before the Circuit Court of Appeals in that case there was no single *fact* in dispute. It was not denied that the merits of the case were fully before the court—as fully as they could ever be. The sole contention of the complainant whose bill had been dismissed appears from the following specifications of error in the petition for a writ of *certiorari:*

> "That it was error of law for the Circuit Court of Appeals for the Seventh Circuit to *dismiss this bill.* . . . . upon mere *ex parte affidavits;* which decision . . . . was rendered without a trial 'according to the course and principles of courts of equity.'"
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> "That it was error of law for the Circuit Court of Appeals for the Seventh Circuit to make this *final* decision on the *merits* without affording your petitioner the right of trial on evidence in chief and in rebuttal, taken by the examination and cross-examination of witnesses, as provided in Rules 67, 68, etc."

And in the brief on behalf of the petitioner in that case the same grounds for the writ were set forth:

> "The dismissal of the bill of complaint on such *ex parte* affidavits in such interlocutory proceeding on appeal

from the Circuit Court granting a preliminary injunction; 'such dismissal of the bill for want of equity under such conditions depriving the petitioner of the right of trial of its cause.'"

The brief proceeded as follows:

"Upon these facts, two questions of law arise for determination by this Court, to-wit: (1) was the dismissal of the bill right or wrong? And (2) is the so-called 'rule of comity' between the Federal courts to be maintained or not?"

No other questions than the above were raised in the argument for the petition.

The Transcript of Record in the cause shows that the entire evidence for the defendants consisted of a large number of letters patent, together with evidence of what is referred to in the opinion of this Court as the Perkins Mill, as to which the facts were undisputed. The prior art set up in the case was different from that set up in the prior adjudication and, therefore, the Rule of Comity was not applied.

In the opinion sustaining the decree of the court below ordering the bill to be dismissed, this Court most carefully defines the class of cases in which it is proper to dismiss a bill upon an appeal from a decree awarding a preliminary injunction. We quote from the opinion of this Court in the *Mast-Foos* case:

"Does this doctrine apply to a case where a temporary injunction is granted *pendente lite* upon affidavits and immediately upon the filing of a bill? We are of opinion that this *must be determined from the circumstances of the particular case.* If the showing made by the plaintiff be *incomplete;* if the order for the injunction be reversed, because injunction was not the proper remedy, or because under the particular circumstances of

the case, it should not have been granted; or if other relief be possible, notwithstanding the injunction be refused, then, clearly, the case should be remanded for a full hearing upon pleadings and proofs. But if the bill be obviously devoid of equity upon its face, and such invalidity be incapable of remedy by amendment; or if the patent manifestly fail to disclose a patentable novelty in the invention, we know of no reason why, to save a protracted litigation, the court may not order the bill to be dismissed. Ordinarily, *if the case involve a question of fact*, as of anticipation or infringement, we think the parties are entitled to put in their evidence in the manner prescribed by the rules of this court for taking testimony in equity cases. But if there be nothing in the affidavits tending to throw a doubt upon the existence or date of the anticipating devices, and giving them their proper effect, they establish the invalidity of the patent; or if no question be made *regarding the identity of the alleged infringing device*, and *it appear clear that such device is not an infringement*, and no *suggestion* be made of *further proofs* upon the subject, we think the court should not only overrule the order for the injunction, but dismiss the bill."

It appears, therefore, that the doctrine *does not apply:*

"If the showing made by the complainant is *incomplete.*"

"If the case *involve a question of fact*, as of anticipation or infringement."

If any "*suggestion* be made of *further proofs* upon the subject" of infringement.

The limitations to be placed upon the rule can be inferred with equal clearness from the three cases cited by this Court, as the authority for the rule of practice then laid down by it. They were the following:

Gardt vs. *Brown*, 113 Ill. 475.

This was a bill filed by the owners of real estate to restrain the closing up of a certain door. The complainant procured a temporary injunction. On answer filed, there was a motion to dissolve the injunction, which was heard on bill, answer and affidavits, and an order was entered dissolving the injunction and dismissing the bill. The Supreme Court in its opinion said:

> "It is urged that the Court, on dissolving the injunction, should have retained the bill for a hearing on evidence. We are unable to perceive any reason for doing so, because *the bill on its face discloses no equity*, and unless it had been amended it would have been useless to retain it for any purpose. The bill, as framed, involved only the construction of the deed and lease, and *that arose on the bill.* It was, therefore, improper to retain the bill, as to have done so would only have resulted in increased costs. Appellants have treated the decree as final, and had they not, their appeal would be as dismissed. The circuit court judge who tried the case made this order: 'The order is, that the injunction be dissolved; and further, if complainants desire to take an appeal, that the bill be dismissed.' It was then *optional with appellants* to have the bill retained or to consider it as dismissed, and having made the election they must be held to their choice."

Green vs. *Mills*, 35 U. S. App. 383; 69 Fed. Rep. 852.

This case went no further than the Illinois case just cited. It was in substance a *political* bill "brought to restrain the registering officer from discharging the duties imposed upon him by law by which these complainants and others similarly situated might be deprived of a political right."

Chief Justice Fuller said, in dismissing the bill:

"We repeat that the action sought to be enjoined is *political and governmental*, and it is not pretended that any right of property or civil right is threatened with infringement thereby.

"This being so, we are clearly of opinion that *no ground of equitable cognizance exists*, and, although the appeal is from interlocutory orders, yet, *as we entertain no doubt that such a bill cannot be maintained*, we are constrained, in reversing these orders, to remand the cause with a direction to dismiss the bill."

Knoxville vs. *Africa*, 47 U. S. App. 74; 77 Fed. Rep. 501. This was a bill to settle the right of Africa, who was engaged in the operation of an electric street railway in the City of Knoxville, to extend his railway and occupy three unoccupied streets of the city. The Circuit Court granted a preliminary injunction upon bill, answer, exhibits and *ex parte* affidavits filed in support of the bill. On appeal from the preliminary injunction, the Court of Appeals for the Sixth Circuit was of opinion that the complainant, *by his own showing*, had no right under the law to occupy the streets in question, and that as the question was one of law and was *fully presented by the record*, the case should be decided upon the merits and if found to be with the defendant, the bill should be dismissed, and this was ordered to be done. The ground upon which this was done is more fully stated in the opinion of Lurton, C. J., rendered upon a petition for rehearing. He says (77 Fed. Rep. 511):

"The appeal was from an interlocutory injunction. So far as the propriety of that injunction depended upon the validity of the ordinance of January 11, 1876, *we were in possession of a complete record*, and *could do full and final justice by determining the matter of law* upon which the street rights claimed under that grant depended."

But a *rehearing was granted* upon the ground that the court had failed to take notice of the *fact* that Central Avenue and Crozier Street were one and the same street, and that an insignificant portion of Central Avenue was not under the actual occupancy of the complainant, the court holding that the "record is not in such a condition as to justify a *final disposal* of the questions of *fact* upon which the ultimate rights of the parties must depend." The order dismissing the bill was revoked and the cause was permitted to proceed to final hearing.

It may be confidently urged that there is nothing in any of these three cases which in the slightest degree sustains the application of the doctrine of the *Mast-Foos* case to the case at bar. The cases of *Gardt* vs. *Brown* and *Green* vs. *Mills*, were obviously bills upon which a demurrer would have been sustained, and the courts in both cases substantially so treated them. In *Knoxville* vs. *Africa* it appeared that the complainant showed, by his own affidavits, that, as a question of law upon *undisputed facts*, he had no equity under his bill.

It may be pointed out that the doctrine of the *Mast-Foos* case is merely a similar rule to that under which a patent bill may be dismissed on demurrer. But the cases where this has been done *are few* in the books. In most of the reported cases it has been refused, and it will always be refused, "If *doubt* exists . . . if the faults pointed out by the defendant *may, by any chance, be cured by proof;* if, in short, *there be a possibility* that the complainant *may* succeed (*Electr. Co.* vs. *Winton Co.*, 104 Fed. Rep. 814).

We submit, therefore, that upon the language of the opinion of this Court in the *Mast-Foos* case, upon the facts of that case, and upon the authorities cited by this Court in support of the doctrine there announced, the rule in that case will not be applied unless it appears that the *entire merits* are before the Court of Appeals, that the complainant has fully proved

all the facts which are relevant in support of the bill of complaint, and that no fact alleged on behalf of the defendant is disputed; or, to state it in the language of this Court, if there is "any suggestion of further proofs," the rule cannot be applied.

The petition fully sets forth the questions of fact as to which the "showing made by the complainant is incomplete," and as to which they claim the right to adduce proofs and to cross-examine the defendants' witnesses. A summary of such matters will be found on page 21 thereof. Without repeating them here, the attention of this court is called thereto. Upon them we submit that this case falls far outside the class of cases intended to be covered by the *Mast-Foos* case.

Another important difference exists between the facts of the *Mast-Foos* case and of the case at bar, which has an essential bearing upon the case. In that case the complainant was served with the defendant's affidavits and was permitted to reply to them by counter-affidavits which were read at the hearing. In the case at bar, under the practice of the Circuit Court for the Southern District of New York, the defendants were not required to serve their affidavits upon the complainant prior to the hearing, and, consequently, the complainants were not permitted to present counter-affidavits. These rules of practice have long been in force, it is believed, in that court. They may have been proper rules of practice originally, though their propriety is not obvious, but, in view of the doctrine that the Circuit Court of Appeals has jurisdiction to dismiss a bill upon an appeal from the granting of a preliminary injunction, their propriety may be very seriously doubted. It is, perhaps, not going too far to say that it would be difficult to imagine a case where the complainant's bill could be *justly* dismissed upon an appeal from the granting of a preliminary injunction at the hearing of which the complainant was de-

barred from filing counter-affidavits in reply to the affidavits of the defendant. The orderly trial of causes by hearing first the evidence of complainant and then the evidence of the defendant and then the rebuttal evidence of the complainant, is so thoroughly fixed in our system of law that it would seem that so radical a departure from this method as was enforced against the petitioners by the courts below in this case, followed by the dismissal of the bill, amounts of itself to a denial of justice as commonly administered in courts in the United States and England. We submit that the decree dismissing the bill was, for this reason alone, reversible error on the part of the court below, quite independent of all other considerations.

In this connection another fact is entitled to consideration —that not only was the defendant debarred, under the practice in the Second Circuit Court for the Southern District of New York, from presenting counter-affidavits in reply to the facts set up in the defendant's affidavits, but they were also, under the rules of the Circuit Court of Appeals for the Second Circuit, limited in the argument of the cause on appeal to a single hour, which was entirely inadequate for the proper and due argument of the cause. This limited time did not permit of any argument on the real merits of the case, and it may almost be said that the case was submitted without oral arguments—certainly without adequate argument commensurate with the condition of the record; the state of the facts involved therein; and the importance of the issues involved. It is not pretended, of course, that the imposing of such a limit to the argument of the cause was in itself in the nature of error, the Court having the undoubted right to make such rules as it may deem fit in the hearing of causes before it; but the fact has significance when considered in connection with the dismissal of the bill in this case in which it cannot be pretended that the complainants had their day in court to establish by

proof the *facts* necessary to sustain the averments of their bill or to present to the Court adequate arguments of counsel on their behalf.

It is submitted that the extension of the rule announced in the *Mast-Foos* case to the facts of the case at bar, would effectually put an end to the practice of motions for preliminary injunctions on patents.

It is certain that this would be an unfortunate result and would go far towards destroying the value of property in letters patent. It is certainly in the interest of justice and of the public that a patentee who has sustained the validity of his patent after a test case upon pleadings and proofs, fully and honestly contested, should have the full benefit thereof in a suit against another infringer. But under the ruling of the Circuit Court of Appeals in this case, it is believed that no litigant, under such circumstances, would venture to move for a preliminary injuction. No matter what facts the complainant might set up in his injunction affidavits, the defendant will ordinarily set up a counter statement of facts. The complainant, being debarred from presenting any counter-affidavits, would be bound by the statement of facts in the defendants' affidavits quite as fully as if he had admitted their truth, and, on appeal, would go to what might be made a final hearing upon a record made up in this one-sided manner.

II. *The court below did not give "sufficient weight" to the Rule of Comity, and therefore the decree was reversible error.*

The proper scope of the "Rule of Comity" and its application by Circuit Courts of Appeal is stated in the opinion of this court in the *Mast-Foos case*. We submit that the present case, as presented to the Circuit Court of Appeals, was one in which the rule was peculiarly applicable and should have been applied, and that the refusal of the Court below, under the circumstances, was reversible error.

The adjudication of Judge Shipman, sustaining the validity of the letters patent, was made after a long and arduous litigation, ably contested at every point; and more than that, it was made by the Circuit Court for the Southern District of New York, in which the present proceedings were pending. There was no alleged anticipating device before the Circuit Court in this case which had not been fully considered and disposed of by Judge *Shipman;* therefore the validity of the patent was not open on the question of a preliminary injunction. Nor was the *question of infringement open*, because the scope of claims 1 and 2 had been defined by Judge Shipman in terms which clearly covered the infringing trucks of the present defendants. Judge Lacombe so held in the following words in awarding a preliminary injunction:

> "The only question presented is whether defendants' structure infringes. That involves the construction of the claims declared on and for the purpose of this motion the construction already adopted *by this court* on final hearing in the Third Avenue case should be followed, for there is no prior patent, no prior use proved here which was not before Judge Shipman. * * * The combination *which Judge Shipman described as the gist of the invention is undoubtedly in defendants' structure.*"

In *Mast, Foos & Co.* vs. *Stover Mfg. Co.*, it was said by this Court:

> "Comity, however, has no application to questions not considered by the trial court, or, in patent cases, to alleged anticipating devices which were not laid before that court. * * * It is scarcely necessary to say, however, that when the case reaches this court we should *not reverse the action of the court below* if we thought it correct upon the merits, though we were of opinion it had not given sufficient weight to the doctrine of comity."

This seems to imply a rule that in a *proper case* this Court *will* reverse a Circuit Court of Appeals for a failure to apply the doctrine, unless it appears that that Court was correct upon the merits.

We submit that the case at bar is such a case; that "sufficient weight" was not given to the doctrine of comity by the court below; and that for this reason also the petitioners are entitled to a writ of *certiorari* in order that they may be heard in this Court on the question as to whether the refusal of the court below to enfore that doctrine was reversible error.

The Rule of Comity and its application to a proper case in aid of a patentee who has already established the validity of his patent, is a matter of general importance in the *administration* of justice throughout the country. The question is constantly arising in a great number of cases. It is essential in the interests of uniformity in the various circuits that the extent of the rule should be defined by an authoritative decision of this court. The constitution of the Federal Courts with nine separate and equal appellate tribunals, a system hitherto unknown in any English-speaking country, seems to render this absolutely necessary. Unless they act under some rules by which there is at least an attempt to secure uniformity of decision, the uncertainty will be intolerable and the system will break down. This was recognized in *Columbus Watch Co.* vs. *Robbins*, 148 U. S. 266, where it was held that the fact that diverse judgments had been rendered in two Circuit Courts of Appeals under the same conditions "might furnish ground for *certiorari*."

It is conceded that the chief function of a final Court of Appeal is to preserve uniformity of law rather than to do justice between man and man; and it was for this reason that a general supervision over the nine Circuit Courts of Appeal was retained in this court by the Act of 1891—to be exercised by it in questions which it might deem of general

importance. Necessarily, questions of *administrative law*, such as arise here, must be of general importance. The same considerations which induced this court to supervise the lower court in the ***Mast-Foos*** case will, we submit, induce it to supervise the present case and correct the misapplication of the doctrine of that case, if it shall so consider it.

The Rule of Comity had been carefully laid down by the *court below itself*, as recently as February, 1900, in *Consolidated Fastener Co.* vs. ***Hays***, 100 Fed. Rep. 984, where it said:

> "Shortly after its organization this Court had occasion to enunciate the proposition that, where there was an appeal from an order granting preliminary injunction, the Court below having followed an adjudication at circuit sustaining the patent after contest upon pleadings and proofs, such adjudication is to have the same weight which it should have before the Circuit Court. . . . The propriety of some such rule is apparent. The prior adjudication has been secured by complainant on testimony which has been sifted by cross-examination, and it would seem that he should be entitled to cross-examination of defendant's experts before being deprived of the advantage of his previous decree. Especially so in view of the ease with which *ex parte* affidavits of experts exploiting any theory desired may apparently be obtained. This practice has been ever since adhered to by this Court.
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> "In Fastener Co. *vs.* Littauer, 28 C. C. A. 133, 84 Fed. 164, we quoted from the Paper-box case, *supra*: 'The adjudication upon which the motion for preliminary injunction was based, not being the subject of the appeal, is to have the same weight which it should have before the Circuit Court . . . . in the absence of some controlling reason for disregarding it,' and added:

"'No such controlling reason is shown here. No prior patent or prior use or prior publication, having an important bearing upon the validity or construction of the patent, and which was not before the court in the Columbian Company case, is now presented; no new authority on patent law is now first cited; there is nothing to show an improvident exercise of legal discretion by the circuit judge; and, apparently, this is an *effort to review the decision in the Columbian case at final hearing* upon a *partial presentation* of the evidence then considered, and without the *cross-examination*. There is *no warrant for such practice*, which was *expressly condemned* in American Paper-pail & Box Co. *vs.* National Folding Box & Paper Co., *supra*.'

"It has seemed desirable once more to restate this rule of practice, since the appeal here seems to have been mainly *argued on the theory that the decision of Judge Colt was to be reviewed*, as if this were an appeal from that decision upon the record before him."

We submit that Judge Lacombe's view of the present case, when he heard the motion for a preliminary injunction, was correct and should have been sustained on appeal. Instead of doing so, the court below proceeded to review Judge Shipman's adjudication and practically reversed both it and the decree of Judge Lacombe.

It was, of course, entirely competent for the Circuit Court of Appeals for the Second Circuit to overrule its *well-established* comity *rule*, but we submit that where a litigant comes before a Court in that Circuit, in reliance upon its own rule, offers only proofs sufficient (and Judge Lacombe held in the Circuit Court that they *were* sufficient) to bring his case under that rule, it certainly seems a hardship to overrule it and then proceed to dismiss the complainants' bill for want of the very proofs which the settled practice of the court (and so Judge Lacombe held) rendered entirely unnecessary. Certainly it is

making the reasonable doctrine of the *Mast-Foos* case a weapon of destruction rather than an instrument of justice.

Among the cases cited in *Mast, Foos & Co.* vs. *Stover Mfg. Co.* at page 489, as being "well-considered cases" on the Rule of Comity, is the following:

Electric Mfg. Co. vs. *Edison Electric Light Co.*, 61 Fed. Rep. 834, where it was held:

> "Where the validity of a patent has been sustained by prior adjudication, upon final hearing, and after *bona fide* and strenuous contest, the matter of its validity upon motion for preliminary injunction is no longer at issue, all defense, except that of infringement, being reserved to the final hearing."
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> "When, upon judicial contest, a competent court has sanctioned the grant and determined the right thereunder, the monopoly thereby granted ought not be permitted to be invaded except upon a clear showing that the decision invoked in its favor was wrong."

Of course, both the *validity* of the patent and *infringement* must clearly appear before a preliminary injunction can be granted. But both did appear beyond question in this case. Judge Shipman in his prior adjudication upon this patent in the Circuit Court for the Southern District of New York *had accurately* and *precisely* defined the scope of claims 1 and 2 of the patent in suit before him and here in suit, and sustained them broadly, and it was *necessary to the decision of that case to do so*. There has never been any pretence in this case that the defendants' trucks do not infringe upon claims 1 and 2 as they were defined by Judge Shipman. And there has never been any pretence that they do not contain what Judge Shipman found to be the *gist* of the invention. Judge Lacombe so held in his brief opinion in the Circuit Court in this case.

But the opinion of the court below avoided the difficulty by *assuming* that "inasmuch as the infringing car trucks (in the *Third Avenue* case) embodied the combination specified in all the claims, it was not necessary in that case for the court to define accurately claims 1 and 2 in order to determine what, if any, limitations not expressed therein were to be read into them by implication."

In this statement the learned court was undoubtedly in error. This can be stated with certainty and can be *demonstrated* by a reference to the circumstances of the *Third Avenue* case. The defendants' *entire contention* there was as follows:

1. That *all* the claims, *including claims 1 and 2*, were limited to an arrangement of springs by which the elliptical springs came under compression subsequently to the spiral springs, and

2. That *their* trucks did not have this feature of subsequent compression, *in fact*, and therefore they did not infringe any claims. But Judge Shipman *negatived* both positions. He held that claims 1 and 2 covered the *gist* of the invention and were for the combination of elliptical and spiral springs in connection with the movable and stationary frames of the patent in suit; *i. e.*, that those claims are to be taken to mean what they said; and that claims 9, 10, 11 and 14 added the *minor* feature of subsequent compression of the elliptical springs. That we are correct in stating that Judge Shipman *did* accurately define claims 1 and 2 and it *was a necessary part* of the case before him to do so, is made clear by the fact that if he had found that claims 1 and 2 were to be limited by implication (as claims 9, 10, 11 and 14 were limited by their express language) to subsequent compression of the elliptical springs, the defendant in that case, whose truck springs were arranged for subsequent compression, could have entirely escaped the charge of infringement of any and all of the claims by merely placing a block between the top of

his elliptical springs and the movable frame so as to bring both sets of springs under compression at once.

It is perfectly clear, therefore, that Judge Shipman *did*, and *did* necessarily, "define accurately" claims 1 and 2.

And the same considerations show that the court below was equally in error in the reason it gave for assuming that Judge Shipman did not "define accurately" claims 1 and 2, viz., because the infringing trucks (before Judge Shipman) "contained the combination specified in all the claims." If this means that they *admittedly* "contained the combination specified in all the claims," counsel who prepared and argued the case can only say that the court is under a misapprehension as to the facts.

The error into which the learned court below has fallen in regard to this vital part of the case before it, with such disastrous results to the Petitioners, may be said, with great respect to it, to illustrate the danger of the injustice that may follow the application of the somewhat drastic rule of the *Mast-Foos* case to a case where the complainant who moves for a preliminary injunction upon a prior adjudication, is not permitted to file counter-affidavits, and is not adequately heard on appeal in the argument of his cause, and then deciding the cause upon an *assumption* that the court which made such prior adjudication did not mean what it said it meant in its opinion.

It may not be improper for the writer of this argument to express his thought in this connection in the language of a paper read by his colleague before the Section of Patent Law of the American Bar Association (Report of 1899, p. 651):

> "Moreover, in one circuit at least, the Rule of Comity is apparently to be ignored; so that it would seem that in this circuit, which covers a territory in which manufacturing interests have been developed almost to a greater extent than in any other part of the United States, a

patentee who has succeeded in establishing his patent in another circuit is to be treated as if his patent had not been sustained. It hardly seems possible that the doctrine of Comity should be generally ignored; but if it is not to be recognized in all the circuits as of practically *controlling importance*, the situation of a patentee will soon be even more intolerable than is the case at present. . . ."

"Theoretically, the situation is intolerable, and we must all agree that practically the patentee by no means gets that protection which the constitution and laws of the United States were framed to give him as a reward for his contribution to the progress of the useful arts."

As to the Merits of the Case.

We conceive that where a Circuit Court of Appeals has erroneously applied the rule in the *Mast-Foos* Case, this Court will not desire, on an application like the present, to consider at length the merits of the case that was before the lower court. The ground of the interference on the part of this court would in such case be that the complainant's *real case* was not before the Circuit Court of Appeals and, therefore, whether that Court was correct or not in their view of the *part of the case which was before them*, would not be important. We deem it proper, however, to make a brief argument in addition to the facts set forth in the petition now before this Court.

And we do this also because one ground of this application for a writ of *certiorari* is that the Court below did not give "*sufficient weight*" to the "Rule of Comity"—a ground upon which this Court has said that it would not reverse the Court below if of opinion that the Court below was correct upon the merits.

The invention of the patent in suit consisted essentially of spiral and elliptical springs combined with the side beams (stationary frames) and movable frames of a car truck, the elliptical springs being of slower action and of a different period of action from the spiral springs, the whole being intended to provide a simple and more efficient spring-support for a car and to lessen oscillation or galloping.

It is admitted in defendants' affidavits that an elliptical spring has a more *sluggish* action than a spiral spring. See, for example, Abbott:

> "It is true that, owing to the frictional contact between the leaves of an elliptic spring, or semi-elliptic, that *its action is more sluggish* than that of coiled, or, as they have been called in this case, spiral springs."

See, to the same effect, the defendants' affidavits by Fowler and Newbury. So the Brill patent says (p. 2, line 4):

> "The elliptical springs being *slower in their action* than the spiral springs."

It is for this reason that the combination of the elliptical with the spiral springs in the patented relation lessens or prevents the longitudinal oscillation of the car by breaking the rhythm. And this was what was considered by Judge Shipman "the gist of the invention."

A *subordinate* feature of the invention was described by Judge Shipman as follows:

> "The result of the minor invention of claims 9, 10, 11 and 14 was important, though, upon first inspection, its marked importance does not appear, but it perfected the general invention of the first two claims."

Claims 1 and 2 cover the *main* invention, and are commensurate with it. Claims 9, 10, 11 and 14 cover the *minor feature* of the invention.

When a car is placed upon the movable frames which are supported by the springs, the spiral springs are forthwith com-

pressed and bring the weight down to the elliptical springs, which, thereupon, come under compression. During the actual use of the loaded car both sets of springs support the weight of the car and its load and prevent longitudinal oscillation. Inasmuch as a car truck is a structure intended *for use under a load*, it must be considered from that standpoint. This explains why, in the drawing of a truck *without a car superimposed upon it* in the patent in suit, a space is shown between the top of the elliptical springs and the movable frames. As just stated, when the car is placed upon the truck this space is taken up and the weight is brought down so as to compress the elliptical springs. Any other mode of construction would be an absurdity. The object of using the two kinds of springs is to prevent oscillation, and they *cooperate* to this end in practical use.

This is shown by the following language of the specification (p. 2, line 120):

> "To this end I supplement the axle-box springs by placing elliptical springs of slower action between the extended portions or sections of the side beams and upper chord, and so arrange them in respect to each other that the elliptical springs will not come into play until after the axle-box springs have begun to compress."

Just *how heavy* the load must be before both sets thus cöoperate, is, of course, impossible to specify and the patent in suit does not attempt to specify, either in the language just quoted therefrom or in two other passages therein in which the expression "abnormal depression" of the car is used. This latter phrase clearly has no definite significance. The point is that one set of springs will come first into action with the load of the car and thereafter both sets will co-operate to support the weight and prevent or lessen oscillation.

Mr. Abbott, the expert witness for the defendants in this case, refers to the Brill truck as supporting the car body upon

the *spiral* springs "*when the car is empty or carrying a small load.*"

But we conceive that the proper distinction should be between the *car body* alone and a *loaded* car.

This view is supported by the affidavit of another of defendants' witnesses, Mr. Beetem, a practical railway man, who says:

> "In the trucks manufactured by the Brill Company the entire weight of the *car-body* is carried on the spiral springs."

The Court below found that the mode of operation of the defendants' trucks was the same. We quote the language of its opinion:

> "In the car trucks of the defendant, both sets of springs are brought into action and begin to compress simultaneously *when the weight upon them is greater than the normal weight of the car.*"

This is precisely the mode of operation which is shown by the passages from the patent and from Mr. Abbott's testimony which we have just quoted.

Claims 1 and 2 are for the broad combination of spiral and elliptical springs with the movable and stationary frames. That was Mr. Brill's real invention, and Judge Shipman has so found.

But the Court below considered the patents to Manier and Peckham and read the specifications in the light of those patents and held, contrary to Judge Shipman's decision, that claims 1 and 2 must be limited to a special construction in which the elliptical springs are not brought into action until after the spiral springs have begun to compress. We will therefore ask the attention of the Court to the Manier and Peckham patents, and to the specification in this connection.

The Manier Patent.

The Manier patent is not, as counsel for the defendant has frequently stated, for a *combination* of spiral and elliptical springs. One of the drawings shows spiral springs only and the other shows elliptical springs only. The Court below states that "this patent shows every element of the first claim of the patent in suit broadly considered, except the conjoint use of spiral and elliptical springs." The exception is *vital* and removes this patent from the need of further consideration. The learned court below finds that Manier "does not show a combination of the second claim." During the hearing below the learned court, after an inspection of this patent, stated to counsel that they did not consider it as of any importance.

Judge Shipman pointed out that Manier's only thought was the "mounting of the body springs forward of the axles," and that "the springs, or the kind of springs, which he was to use are no part of his invention." Judge Shipman further said:

> "Manier's invention was entirely apart from that of Brill and had no conception of its character. . . . Manier's invention was not designed nor adapted nor used for the performance of the function performed by Brill's device, nor was the way to accomplish Brill's result suggested by Brill's invention (*Topliff* vs. *Topliff*, *145 U. S. 156*)."

Manier was one of the entirely unsuccessful attempts made in the early days of electric street railway propulsion to remedy the pressing evil of oscillation. Of these earlier attempts Akarman speaks in his affidavit on behalf of the complainants and his statement was not disputed. He says:

> "This type of truck [the Brill truck] has gone into universal use under four wheel cars, and has substanti-

ally, if not completely, displaced all other constructions of car trucks."

The learned court below nowhere points out the extent to which it considers that the Manier patent imposes any limitation upon the broad invention of claims 1 and 2. It need not be further considered.

The Peckham Patent, 419,876.

In restricting claims 1 and 2 to a narrower scope than their terms import and than the original invention of the patentee and that given to these claims by Judge Shipman, the opinion of the Court below relies mainly upon the Peckham patent, 419,876.

It must be borne in mind that every presumption is against this Peckham patent disclosing a structure having the same mode of operation as the Brill combination of springs; for it appears that the Peckham, in all his three types of trucks here complained of as infringements (Record, p. 72), combines with the spiral springs full elliptical springs, *located between the extended sections of the sides of the upper chords* and *of the side beams; precisely as Brill did*, and *has not used* the transverse semi-elliptical springs of his own patent.

In fact, this Peckham patent is a mere paper patent. Neither Mr. Peckham in his affidavit describing various forms of car trucks used by defendant company, nor any other of defendants' witnesses, suggests that a single truck of the construction shown in this Peckham patent has ever been manufactured or sold by Mr. Peckham or either of the Peckham companies, *or used by any street railway company.* In fact, as is shown by the Record (p. 91), the Peckham Company continued up to 1895 to advertise car trucks supported by sets of *spiral* springs only; and it was after the issue of the Brill patent, and the wide adoption of the Brill invention,

that the Peckham Company began the use of its infringing constructions, and Peckham applied in 1894 and in 1895 for two patents, Nos. 555,530 and 563,685, which show the combination of spirals and full elliptics on the side beams, here complained of as infringements.

Judge Shipman held in the *Third Avenue* case, in the most emphatic language, that the Peckham patent was irrelevant because the construction "*has not the conjoint action of the patented combination, nor does it perform the function of the Brill device;*" and pointed out that defendants' expert in that case had not referred to this patent in his direct examination as one of the "best anticipations."

The Peckham patent (Figs. 4 and 5) *is radically different from that used by Brill and in the defendants' infringing truck, not so much because* it has *a semi-elliptical* spring, as because there are no elliptical or semi-elliptical springs *located between the extended sections of the upper chord and the side beams* to support the car body at *each of its four corners;* on the contrary, each of the two semi-elliptical springs is carried across the truck transversely, so that it contacts at its middle with a supplementary transverse truss at the front or rear of the car body, and its ends *play loosely* in shoes on the side beams.

And these sidebeams are only *loosely* hung from the axle boxes, and have themselves *longitudinal pivotal motion.* The corners of the car have no support, and the pivoted, loosely moving sidebeams furnish no substantial support for the semi-elliptic springs nor any for the motor, which is an essential requirement of modern electric street railway trucks. For these reasons the Peckham device was *not a modern truck capable of use.*

It is most significant, too, that this Peckham device was gotten up by one who, at the time, was a truck builder, and who, therefore, must have endeavored to put it on the market, and who would have done so if it had been capable of prac-

tical use, especially at a time when the real requirements of the business were none too well understood and the street car companies were all looking anxiously for a truck with which they could run their cars at the required speed.

The court below quotes in its opinion the words of the Brill patent (p. 1, lines 66-69), "*between the extended sections of the upper chord and the side beams* I place elliptical springs, which *preferably* extend *longitudinally* of the truck;" and, we submit, misinterprets that language. For that Court deduces from this passage the conclusion that "the circumstance that the semi-elliptical springs of the Peckham patent extend *transversely* instead of *longitudinally* is, therefore, immaterial." But the point of this passage in the patent is that the *four elliptical springs support the four corners of the car*, and are, therefore, *necessarily* placed "between the *extended sections* of the upper chord and the side beams." In this location *each of the* four springs may extend either *longitudinally* or *transversely*, although obviously, the longitudinal is the preferable position, as the patentee says. But Peckham's semi-elliptical springs are not between *the longitudinal extensions of the upper chords and the side beams at all;* each is between the two side beams and a transverse truss, and, therefore, each of the four corners of the car is left without any support, a construction which would be wholly inoperative in practical use. Judge Shipman had this distinction in mind where he states of the Peckham patent:

> "The upper beams are supported on *spiral* springs on the axle-boxes."

The distinction is not, as the Court below seems to suppose, *in which direction* the elliptical springs extend, but *where they are located.*

This matter of the *location* of the elliptical springs is mentioned over and over again in the Brill specification. For example, page 2, line 122:

"By placing elliptical springs of slower action *between the extended portions* or sections of the side beams and upper chord."

Line 130:

"The devices which secure the elliptical springs *between the side beams and the upper chord.*"

Page 3, line 26:

"The [elliptical] springs are *rigidly secured to the side beams.*"

Line 71:

"A portion of this action would be taken on the springs *supported on the ends of the side beams.*"

There is a vital difference between the location of the complainants' and defendants' elliptical springs, on the one hand, and the location of the semi-elliptical spring of the Peckham patent on the other. Not only had Peckham in his patent *no notion of the utility* of combining elliptical and spiral springs (as is evident both from the language of this patent and from his own subsequent conduct and patents), but the construction shown by him in Figs. 4 and 5 of this patent was not practical.

There are other features which distinguish the construction of the Peckham patent from that of the Brill patent, and prove that the former is not useful. We refer to a statement in regard to them in the petition.

All these considerations show why the Peckham patent was rejected by Judge Shipman after the fullest consideration, as not anticipating or imposing any limitation upon claims 1 and 2; why it was rejected by the Patent Office in reference to these two claims; why it was rejected by the defendants' expert witness in the *Third Avenue* case, who *did not even refer to it in his examination in chief;* why the able and experienced counsel for the defendant in that case relied upon it but slightly in their printed argument; why Mr. Abbott,

the defendants' expert witness in this case, barely referred to it in his deposition; and why the counsel for the defendants in this case paid slight attention to it in his argument. The real defence made by counsel in this case did not rest upon this Peckham patent, but upon the contention that oscillation in the defendants' trucks is overcome by the *tension spring* which the defendants use in their trucks, and that they use elliptical springs, not because they are useful to overcome oscillation (as to which purpose they courteously say they are a "*positive detriment*" to their trucks), but because they serve as a brace to prevent the side sway of the car body on the truck.

Furthermore, the learned counsel for defendants, in his brief handed up to the court below, expressly admitted that the overcoming of oscillation "*by so combining elliptical and spiral springs in a car truck that the rhythm of the one should overcome that of the other, is not foreshadowed in any way in either the Manier or Peckham patents.*"

Again, suppose even that the patentee, G. M. Brill, in conducting his experiments in 1889 (as all the street railway world were) towards a successful electric truck, had himself designed the truck of the Peckham patent, 419,876, and that it turned out a complete failure, was refused by the trade and was thrown aside (which was the fate of the Peckham device). Certainly such a failure would not invalidate a patent for a successful truck which he afterwards invented, which the trade immediately and *universally adopted*, and for which he applied for and received the protection of the patent laws.

Clearly, such a case would fall within the remark of Mr. Justice Brown in the Barbed Wire case: "In the law of patents, *it is the last step that wins.*"

When, in 1889, Mr. Peckham and Mr. Brill and the hundred other expert minds were struggling to devise a truck which would meet the vital requirements of the business, Mr. Peck-

ham hit upon the device of the Peckham patent, 419,876, and obtained a patent for it. He does not appear to have sold a single truck of this construction. It was not only an entire failure, but is demonstrated to be *incapable* of practical use. He appears not even to have advertised it, because at that very time he was advertising another type of truck, which he said "successfully solved the problem of oscillation." On the other hand, Mr. Brill, in 1889, (as his affidavit shows) devised his truck and patented it, and it met with immediate and universal acceptance upon its introduction in January, 1891. Mr. Peckham and his companies soon began to sell infringing trucks. When sued for infringment he assumes the position that his device of 1889, useless and never used, places such a limitation upon the *successful* invention of Mr. Brill that he can infringe upon the Brill patent in suit, and yet escape the penalty of his wrong doing.

The Language of the Brill Patent.

But it is urged by the defendants (respondents), and the court below appears to have accepted the theory, that if the complainants' case should be heard on proofs, still the language of the patent is such that all the claims must be limited to an arrangement of springs in which the elliptical springs are not brought into play till the spiral springs have been compressed.

We submit that this position is entirely erroneous for the following reasons:

1. Brill *really invented* the *broad combination* of spiral and elliptical springs in their patented relation, without regard to the *minor* element of subsequent spring compression. This is shown:

(*a*) By the position of his invention in the art. There is no real pretence of any anticipating patent but Peckham, 419-876, and it has been shown upon that that patent is entitled to no more consideration here than Judge Shipman

gave it in the *Third Avenue* case. It did not disclose the combination of claims 1 and 2 of the Brill patent nor their separate elements. It was not a practical device and taught nothing to the art. *All* the earlier devices, many in number, were useless to remedy oscillation and pounding. As soon as the Brill device was brought out, all other trucks were rejected and the Brill device was "universally adopted." The defendant Peckham Company, about 1892, *gave up all their earlier truck forms* and began to sell the Brill device, and they now advertise that up to 1900 they had sold 10,000 of them.

(*b*) Judge Shipman, after an arduous contest and full hearing in the *Third Avenue* case, sustained the broad construction of claims 1 and 2. He says:

> "The only remaining question is that of patentable novelty. It has already appeared that the *gist of the invention* is described in claims 1 and 2. The necessity for a remedy against the pounding of the car, the importance of the result, the adoption of the invention by experienced railway superintendents, the number of previous attempts at a remedy and the barrenness of their results go far to show that the work of an inventive mind was required and was active in the invention. The testimony of the defendant's expert itself, as he goes through the history of the art and thereby points out what the patentee's combination did, as compared with previous efforts to do something, shows that the patented improvement was patentable."

2. The patentee, having made the broad invention of the use of elliptical springs (of slower action and different periodicity) combined with quick-acting spiral springs, in the patented relation, described one method of applying the principle and claimed it *broadly* in claims 1 and 2, and claimed it *with the modification of subsequent spring compression*, in claims 9, 10, 11 and 14. He clearly comes within the rule of *Winans*

vs. *Denmead*, 15 How. 330, where it was held that, the "patentee, having described his invention and shown its principles, and claimed it in that form which most perfectly embodies it, is, in contemplation of law, deemed to claim every form in which his invention may be copied, unless he manifests an intention to disclaim some of these forms."

Brill, in fact, made the broad invention; he describes more fully one modification of it and he claims it broadly to cover its various modifications. We submit that his broad claims should not be cut down so as to take from him the *substance* of the invention and permit the defendant Peckham Company to escape infringement by 10,000 trucks which, as it cannot deny, were built upon the broad invention of Brill and in direct accord with claims 1 and 2 of his patent and which were built after the trade had universally adopted "Brill and rejected every other form of four-wheel truck."

3. Even if we admit (which we do not) that claims 1 and 2 are to be limited to *some degree* of subsequent spring compression, then we point out (1) that Brill is entitled at least to the credit of being the first to have made the combination of movable and stationary frames and spiral and elliptical springs in which *either* the spiral or elliptical springs are first compressed; and (2) that the court below *finds* that defendants' trucks *have* the element of subsequent compression of one set of springs. It cannot be argued that it makes any difference which set of springs are the last to compress. Claims 9 and 10 expressly negative this. Claim 9 refers to the subsequent compression of *some* of the springs without specifying which, and claim 10 refers to the subsequent compression of the *end* springs. In view of these claims and of the primacy and importance in the art of the Brill invention—"universally adopted"—shall these defendants appropriate it and go free by merely reversing the order in which their springs act? There is no evidence that, *in practice*, it makes any difference

which set of springs compress subsequently. The theory of the patent being the breaking of rhythm (as Judge Shipman found), there *can* be no difference in that respect.

Claims 9 and 10 were fully sustained by Judge Shipman.

4. Infringement of other claims, and especially of claims 9 and 10, can be shown at final hearing. Claims 9 and 10 relate to subsequent compression as between two sets of springs, but without specifying that it is the spiral springs which are compressed before the ellipticals. Either set may compress after the other. Claim 9 states that *some* of the springs are compressed subsequently to other springs, which applies to all three of defendants' classes of trucks. Claim 10 specifies that the *end* springs are compressed subsequently to the other springs, which applies to their "Standard" and "Extra Long" trucks, on their own showing and as found by the court below in these words:

> "In the car trucks of the defendants, both sets of springs are brought into action, and begin to compress simultaneously when the weight upon them is greater than the normal weight of the car."

Obviously, this is equivalent to stating that one set of springs takes the entire weight up to a point, and, after that, the other set begins to compress—which is subsequent compression of one set.

And while the defendants *allege* that their elliptical springs are stronger than their spiral springs and *call* them their *main* car springs, yet they did not offer to show *how much* stronger they are, and it is obvious that the four elliptical springs on one of their so-called "Extra Long" trucks *cannot* be stronger than the twelve spiral springs on the same structure.

It should be observed that *all* the defendant's trucks have spiral springs between their saddles and their movable frames and that all their elliptical springs rest on the *extensions* of their stationary frames.

5. Furthermore, the petitioners aver that they expect to be able to establish at final hearing from defendant Peckham Company's advertisements, that the defendants' *spiral* springs are in fact their *main* car-supporting springs, and sustain the greater part of the load. Consequently, it must be their elliptical springs which come under subsequent compression "when the weight upon them is greater than the normal weight of the car." (Judge Wallace's language.)

We submit that these considerations completely dispose of the contention that the complainants cannot establish their rights in these proceedings if the cause goes to final hearing.

Even with the Limitations placed upon Claims 1 and 2 by the Court below, the Defendants infringe.

Again, admitting (which we do not) that the court below is correct in limiting claims 1 and 2 to an arrangement having subsequent compression of one set of springs, the defendants' trucks have *in fact* the element of subsequent spring compression, and infringe upon those claims as so limited. The argument will be in part a repetition of what precedes.

The opinion of the court below specifically finds that the defendants' trucks have this element of subsequent spring compression, thus:

> "In the car trucks of the defendant both sets of springs are brought into action, and begin to compress simultaneously when the weight upon them is greater than the *normal weight of the car*."

This is precisely in accordance with this language of the patent in suit. Thus it states:

> P. 1, l. 62.—"The spiral springs . . . . . *normally* take the weight of the *car*."

> P. 1, l. 67—"I place elliptical springs . . . . . so disposed that they will not be brought into action until the weight of the load on the axle-box springs begins to depress said springs abnormally."

The defendants' elliptical springs, therefore, as found by the court below, must support at least the weight of the car before *any weight* comes on their spiral springs, and this is certainly equivalent to stating that there *is* subsequent compression of the spiral springs in their trucks.

Just *how heavy* the load must be *before* both sets of springs thus cooperate, either in the defendants' truck or in the truck of the patent, it is of course impossible to specify, and the patent in suit does not attempt to specify. In two places (p. 1, l. 73; p. 2, l. 3) that patent speaks in a general way of the "abnormal depression" of the car, but this phrase clearly has no *definite* significence. It would seem, however, to correspond in its scope to the language just quoted from the opinion of the court below in which reference is made to the "normal weight of the car" in connection with defendants' trucks. The fact is that in both defendants' trucks and the truck of the patent, one set of springs first comes into action with a light load, and thereafter both sets cooperate to sustain the heavier load and to lessen the objectionable oscillation. The exact relative adjustment as between the two sets of springs is a matter for the practical spring maker or car builder who regulates it to produce an easy-riding car under varying conditions of load.

But we submit that "*abnormally*" in the patent is not to be given any *controlling* weight, for this reason:

On p. 2, l. 126, the patent states: "The elliptical springs will not come into play until after the axle-box springs *have* BEGUN to compress." This language is quite distinct from "abnormal compression" used in the earlier part of the pat-

ent and indicates about the same degree of subsequent compression as the court below finds in defendants' trucks. Why should the court below rely upon "abnormal compression" to strike down a meritorious patent and give no weight to the equally important language just quoted, which clearly shows that the patentee did not attach any special importance to the words "abnormal depression" used in an earlier part of the specification?

If it be argued that the subsequent compression referred to in the patent in suit must relate to the elliptical springs, it is a sufficient reply to say that claims 9 and 10 both relate to successive compression as between two sets of springs, but without specifying which set of springs are to be compressed first and which class compressed last. Rhythm of oscillation is equally broken in either case, and that is the distinctive method of operation of the Brill invention.

It is wholly unimportant *in practice* whether it is the elliptical springs or the spiral springs that mainly support the car with a light load, and, conversely, which class are subsequently compressed. In fact, we do not understand that any one has alleged that there is any difference in practice in this respect.

We add that in defendants' "Extra Long" truck, which has twelve spiral springs and only four elliptic springs, the twelve spiral springs are *necessarily the main car springs* and the four elliptic springs must necessarily be subsidiary springs, supplementing the spiral springs under the weight of a full load and acting by subsequent spring compression, and the same is true of their other forms of trucks which have eight spirals and four elliptical springs each.

But the petitioners further aver that they expect to be able to prove, from published statements of the defendant Peckham Company (and they would have proved this on the motion for a preliminary injunction, if it had not been un-

necessary, under the established practice of the court below in such cases), that the spiral springs of the defendants' trucks are *in fact* their *main* car-supporting springs, and that they do in fact support the greater part of the weight of the car-body and its load, and consequently that the defendants' elliptical springs are those which come under subsequent compression "when the weight upon them is greater than the normal weight of the car" (Judge Wallace's opinion).

It will be noticed that in Figure 1 of the patent in suit the drawing shows merely a car truck *without a car body supported thereon.* The *added weight of the car body* would bring the spiral springs under compression and bring the structure down so as to reach or begin to compress the elliptical springs. With the added weight of the passengers, both sets of springs would come simultaneously under compression. And this is precisely the case with the defendants' trucks, as stated in the language of the court below just quoted, where it is said that in defendants' trucks "both sets of springs begin to compress simultaneously when the weight upon them is greater than the normal weight of the car."

Reference to particular points in the opinion of the Court below:

It is said, in the learned opinion of the Court below, that the combination of spiral springs with elliptical springs "would not involve invention unless some new method of operation due to the conjoint action of the two kind of springs should result from doing so." But it is submitted that where the earlier art showed no truck which lessened oscillation within necessary and required limits, a truck which would bring oscillation well under control, may be said to have produced a new result and indicate a new method of operation. Such a case comes within the principle laid down by Mr. Justice Brown in the *Barbed Wire Case*, where, referring to *Loom Company vs. Higgins*, 105 U. S. 591, he said:

"It was said by the Court, in answer to the argument, that the combination was a mere aggregation of old and well-known devices, that this argument would be sound if the combination claimed by Webster was an obvious one for attaining the advantages proposed—one which would occur to any mechanic skilled in the art. But it is plain from the evidence, and from the very fact that it was not sooner adopted and used, that it did not, for years, occur in this light to even the most skillful persons. It may have been under their very eyes, they may almost be said to have stumbled over it; but they certainly failed to see it, to estimate its value, and to bring it into notice . . . . Now that it has succeeded, it may seem very plain to any one that he could have done it as well. This is often the case with inventions of the greatest merit. It may be laid down as a general rule, though perhaps not an invariable one, that if a new combination and arrangement of known elements produce a *new and beneficial result never attained before, it is evidence of invention.*'"

Even if we should admit, for the sake of argument (which we do not), that, as stated in the learned opinion of this Court, "the only novelty of the invention of those claims [1 and 2,] details of construction being disregarded, consists in the substitution of both spiral and elliptical in place of either spiral or elliptical springs," still if none of the thousand expert minds who were at work on the problem of a successful four-wheel truck ever thought of the truck of the Brill patent, and if it completely solved the problem, is not the inventor of such a device the very person for whose protection the patent laws are intended?

We submit that it is an erroneous view to take of the patent in question, to say that "the inventions . . . reside merely in the substitution of elliptical for the semi-elliptical

end springs." The invention consists, we submit, in the combination of spiral and elliptical springs in connection with the stationary and movable frames, as set forth in claims 1 and 2 of the patent, in such a way as to constitute a *new truck structure;* and it may seem useless to repeat again that this new truck was successful in overcoming oscillation, and that thenceforth the trade threw aside every other truck device and bought and used only this.

The language of the complainants' expert witness, quoted by the Court below, is given, we submit, undue weight. Of course, any truck with long overhanging ends will *better* support those ends if those ends are in some way supported on extensions of the side frames. This is merely the same as saying that *some* support is *better* than none. So the old spiral springs on extended side frames were *better* than no support at all. But they were really a failure and, till Brill devised his new truck, the electric street railway business was not a commercial success. And the truck of this Peckham patent was also a failure. Though it suggested a method of supporting the overhanging ends, its construction was entirely impracticable. It is hardly worth while to speculate about it when it was not capable of practical use.

Finally, we repeat the words of Judge Shipman, who, after a full and elaborate argument on a long Record in a hotly contested case, and with the deeper insight into the merits of the invention and the great value of Mr. Brill's contribution to the art gained thereby, summed up the case for the patent in these words:

> "The necessity for a remedy against the pounding of the car, the importance of the result, the adoption of the invention by experienced railway superintendents, the number of previous attempts at a remedy, and the bar-

> renness of their results, go far to show that the work of an inventive mind was required, and was active in the invention. The testimony of the defendants' expert itself, as he goes through the history of the art, and thereby points out what the patentee's combination did, as compared with previous efforts to do something, show that the patented improvement was patentable."

Brill made the invention in May, 1889, which was prior to the dates of the Manier and Peckham patents.

We submit that the evidence that Mr. Brill invented the device of the patent in suit in May, 1889, is ample under the decisions. If so, his invention antedates both the Manier and Peckham patents, and those patents drop out of the case. Judge Shipman was not required to decide this question, as he disposed of both those patents in another way.

Without elaborating the argument, in a brief already too long, we point out that the evidence of J. A. Brill and G. M. Brill in this Record, shows a completed invention of the broad claims of the patent, in May, 1889, fully within the rule of *Loom Co.* vs. *Higgins*, 105 U. S. 594, where it was said:

> "But Webster had invented it before that time, and had made a drawing of it which, in March, 1868, he exhibited and explained to Davis. An invention relating to machinery may be exhibited either *in a drawing* or in a model, so as to lay the foundation of a claim to priority, if it be sufficiently plain to enable those skilled in the art to understand it."

If this contention is correct, the principle basis for the ruling of the court below is removed from the case, and its findings were therefore erroneous.

We submit that on the whole case the court below erred:

1. In directing the bill to be dismissed.

2. In not affirming the decree of the Circuit Court upon the Rule of Comity.

And we pray a writ of *certiorari* to the court below, to the end that the Record may be brought into this court and here examined in order that these errors may be here duly corrected.

FRANCIS RAWLE,
for Petitioners.

FREDERICK P. FISH,
Of Counsel.

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Supreme Court of the United States

OCTOBER TERM, 1901 No. 151

JOHN A. BRILL AND THE J. G. BRILL COMPANY,
Petitioners,

vs.

THE PECKHAM MOTOR TRUCK AND WHEEL COMPANY *et al.*

ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

BRIEF OF ARGUMENT FOR PETITIONERS

JOSEPH A. ISETT,
FRANCIS H. [illegible],
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of Counsel.

INDEX.

PAGE

I. Statement of Case 1

II. Specifications of Error 4

III. Argument 6

Further facts in the case 6

Judge Lacombe's Opinion in the Circuit Court 7

1. Mast-Foos rule does not apply 9

Authorities cited in opinion in Mast-Foos case analyzed 12
They show the narrow limits of the rule 14
Reasons why the Petitioners should be permitted to go to final hearing 15
The Complainants, in the Circuit Court, were not permitted to file rebuttal affidavits 16
The time allowed for argument in the Court below did not permit a sufficient argument 17
Judge Shipman's accurate definition of Claims 1 and 2 was necessary to the proper decision of the issues in the Third Avenue Case 17
The rule in the Mast-Foos case ought not to be extended beyond narrow limits 20

2. Rule of Comity was not given due weight 21

Cases cited defining the Rule of Comity 23
The case at bar is a hard one 29

3. Merits of the case 30

The patent in suit—its object was to provide an easy-riding car and to lessen oscillation 31
The serious evil of oscillation 32
Brill's was the first truck that was successful in lessening oscillation 35
The truck has been universally adopted 35

PAGE

Claims 1 and 2, together with the specification, considered 36

The relation of Claims 1 and 2 to the other claims of the patent in suit 39
The patent has three groups of claims 40
Claims 1 and 2 constitute a group of broad claims 40
This was established in the Third Avenue Case 41
The relation, graduation and operation of the two sets of springs when at work 43

The language of the patent. It does not impose any limitation upon the broad Claims 1 and 2 46

Brill made the broad invention of the combination of spirals and elliptics, combined and disposed as in Claims 1 and 2 .. 46
He claimed it broadly and also claimed it with limitations 47
Even if Claims 1 and 2 are to be limited to some degree of subsequent spring compression, the Respondents' trucks are covered thereby 47
Drawings of patent shows only initial compression of one set of springs 49
Illustrative drawing from Figs. 1 and 2 of patent 52

Infringement shown 52

Infringement shown, even if a limitation is placed upon Claims 1 and 2 56

The alleged prior art set up by Respondents 60

No art set up that was not considered by Judge Shipman 60
It is admitted that combining spiral and elliptical springs to break up rhythm is not foreshadowed in the two patents set up 60
Manier Patent 61
Peckham Patent 419,876 62
Is a mere paper patent 62
Its truck never used 62
Differs from Brill invention 63
Is incapable of use 64
Never used by Peckham Company 64
Its structure compared with truck of patent in suit 66

PAGE

Other considerations as to this Peckham patent..... 67
Its frame considered. It is not the frame of the patent in suit..... 68
Its spring system considered. It is not the spring system of the patent in suit..... 71
These considerations show why this Peckham patent has been rejected at every stage (except in the Court below).. 79
The Respondents do not justify under any of their own patents..... 80
History of development of truck art as disclosed by various patents in evidence and those set up in the answer..... 80
The historical method is the proper method for ascertaining patentable novelty..... 87

Cases on taking the market..... 88

Opinion of Court below—Its Erroneous Conclusions..... 90

1. In that it states that Claims 1 and 2 do not involve patentable invention..... 90
A. In that it states that the inventions are a mere substitution of elliptical for semi-elliptical end springs..... 92
B. In that it states that it is immaterial that Peckham 419,876 end springs are transverse..... 93
C. In that it states that the claims disclose a mere aggregation..... 94
D. In its reference to expert's statement as to Peckham 419,876..... 95
E. In finding that the Brill invention did not embody a new result..... 96
2. In holding that the language of the specification limits Claims 1 and 2..... 97
The combination of Claims 1 and 2 is new in the art..... 98
There is a broad group and also a limited group of claims... 98
The spirals are to be made weaker..... 99
The drawings show simultaneous compression under car body weight alone..... 99
"Abnormally" is not a controlling word or of definite significance..... 100
Cases cited which the Court below should have followed..... 103

Cases on patentable invention..... 106

PAGE

Respondents' theory that their trucks do not infringe..... 109

Herein as to time and manner of introduction of Brill truck..... 110
Herein what Peckham companies were doing at this time..... 112
1. Respondents' theory as to their tension spring. 115
A. Negatived by their advertisements..... 116
B. Negatived by their own patents..... 116
C. Negatived by their own truck construction..... 118
2. Respondents' theory that there can be no difference of rhythm between spiral and elliptical springs in Brill patent.. 121
A. Negatived by Judge Shipman..... 122
B. Negatived by practical street railway men..... 122
C. Negatived by Respondents' own patents..... 123
D. Negatived by their advertisements..... 124

Respondents' contention that they adopted elliptical springs merely to prevent swaying of the car body.. 126

Their theories are untenable and throw suspicion on the entire defence..... 127

Mr. Duell's letter in 1897 does not refer to Peckham patent as relevant..... 127

The Court below erred in holding that it was not necessary for Judge Shipman to define accurately Claims 1 and 2.. 129

The file wrapper imposes no limitation on broad Claims 1 and 2..... 135

The complete conception of the invention was prior to the dates of Manier and Peckham patents 148

Supreme Court of the United States,

OCTOBER TERM, 1901.

No. 181.

JOHN A. BRILL AND THE J. G. BRILL COMPANY,
Petitioners,

vs.

THE PECKHAM MOTOR TRUCK AND WHEEL COMPANY *et als.*,
Respondents.

ON WRIT OF *Certiorari* TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

I. STATEMENT OF THE CASE.

This was a Bill in Equity in the Circuit Court for the Southern District of New York, praying for an injunction and an accounting for infringement of Letters Patent of the United States, No. 478,218, dated July 5, 1892 (application filed June 26, 1891), to George Martin Brill, assigned to the complainant, John A. Brill. The J. G. Brill Company, of which the patentee and John A. Brill are both officers, are exclusive licensees under the patent.

The letters patent relate to an improvement in 4-wheel non-pivotal trucks for electric street cars.

The J. G. Brill Company is a manufacturer of street cars and trucks at Philadelphia, and the defendant, The Peckham

Motor Truck and Wheel Company, is a manufacturer of trucks at Kingston, New York.

The bill was filed October 15, 1900. It is in the usual form and avers broadly that the defendants have infringed upon the letters patent in suit. No particular claims are specified in the bill as having been infringed.

The Circuit Court heard the case on a motion on behalf of the complainants for a preliminary injunction upon Claims 1 and 2 of the patent in suit.

It was set up in the bill and was shown by complainants' affidavits that the validity of the patent in suit, as to Claims 1 and 2 (among others), had been fully established by an adjudication in the Circuit Court for the Southern District of New York, in a case of *John A. Brill* vs. *Third Avenue Railroad Co.*, in which the opinion of Judge Shipman was filed July 9, 1900 (Record p. 139).

The entire record of the case before Judge Shipman was before Judge Lacombe and is a part of the Record before this Court.

When the case was heard in the Circuit Court the defendants were permitted to file their affidavits at bar at the hearing. The complainants, therefore, had no opportunity to inspect them before the argument and no opportunity to file rebuttal affidavits.

The defendants' affidavits did not attack the validity of the patent in suit, but set up two United States patents (which had been fully considered and disposed of by Judge Shipman in the prior case), and took the ground that in view of these two patents, the scope of the two claims in controversy were not valid as they read and as construed by Judge Shipman, but that they must be limited in their scope, and denied infringement of the claims as thus limited.

Judge Lacombe, who heard the case, granted the motion. He held that as there was no prior patent before him which had not been before Judge Shipman, and as the combination which Judge Shipman described as the gist of the invention

was undoubtedly in the defendants' structures, the complainants were entitled to a restraining order "under well-settled rules of practice." (Record p. 135.)

Judge Lacombe, in entering a decree for an injunction, also entered a further order suspending the operation of the preliminary injunction until the hearing and determination of an appeal, to be taken within five days. (Record p. 138.)

The defendants then took an appeal to the Circuit Court of Appeals for the Second Circuit. After a hearing before Judges Wallace, Wheeler and Thomas, an opinion was filed directing that the order granting an injunction be reversed and that the cause be remanded to the Court below with instructions to vacate the injunction and dismiss the bill with costs (see p. 150 of Record). This was based upon the authority of *Mast, Foos & Co.* vs. *Stover Manufacturing Co.* 177 U. S. 485.

A petition was filed for a rehearing. The Court granted the petition and directed that the parties should submit briefs but that no oral argument should be had. Upon consideration of these briefs a *per curiam* opinion was filed to the effect that "a *majority* of the Court remain of the opinion that there should be no modification of the order made." (Record p. 166.)

The appellees below thereupon filed a petition in this Court for a writ of *certiorari* upon the ground that the case did not fall within the rule of *Mast, Foos & Co.* vs. *Stover Manufacturing Co.* and that the Court had erred in dismissing the bill in the then condition of the proceedings, and, further, in not affirming the injunction order of the Court below under the Rule of Comity.

This Court granted a writ of *certiorari* and the Record in the case is now before it.

II. SPECIFICATIONS OF ERROR.

1. The Court erred in not affirming the decree of the Circuit Court ordering a preliminary injunction until final hearing.

2. The Court erred in reversing the decree of the Circuit Court.

3. The Court erred in ordering that the cause be remanded to the Circuit Court with instructions to dismiss the bill.

4. The Court erred in finding that Claims 1 and 2 of the patent in suit were to be limited in their scope, and that, as so limited, they were not infringed upon by the appellants (respondents here).

5. The Court erred in finding that it was not necessary for Judge Shipman, in the case before him, to define accurately Claims 1 and 2 of the patent in suit, and in proceeding to review his finding in respect thereof.

6. The Court erred in not giving adequate legal effect to the adjudication of the Circuit Court for the Southern District of New York, in the case of Brill *vs.* Third Avenue Railroad Company.

7. The Court erred in not confining its consideration of the cause to the question of whether or not the Circuit Court, in awarding an injunction, had exceeded the exercise of its reasonable discretion.

8. The Court erred in holding that "it was old in the prior art to employ for the purpose of obviating the oscillation of the car body all the parts enumerated in the first and second claims, except the two kinds of springs in the same car truck."

9. The Court erred in holding that the combinations of Claims 1 and 2 of the patent in suit, which involve, as the Court held, for the first time the use "of both spiral and elliptical in place of either spiral or elliptical springs," were not patentable as defined in said claims.

10. The Court erred, when considering the question of patentability, in disregarding the "details of construction" recited in Claims 1 and 2, and in determining their patenta-

bility solely upon whether the use in a truck "of both spiral and elliptical in the place of either spiral *or* elliptical springs," was patentable or not, without regard to the manner of the employment of such springs.

11. The Court erred in holding that the combinations claimed in Claims 1 and 2 were not novel as therein claimed.

12. The Court erred in holding that "the inventions . . . reside merely in the *substitution* of elliptical for the *semi*-elliptical end springs."

13. The Court erred in holding that "the circumstance that the semi-elliptical springs of the Peckham patent extend transversely instead of longitudinally is therefore immaterial."

14. The Court erred in holding that "the inventions secured by the claims are of a very narrow character, and they cannot receive the broad construction which their language would authorize without affirming their invalidity for want of patentable novelty."

15. The Court erred in holding that the combinations of Claims 1 and 2 are "merely an aggregation of old parts."

16. The Court erred in holding that no "*new mode of operation* due to the conjoint action of the two kinds of springs" results from the combinations of Claims 1 and 2.

17. The Court erred in holding that the combinations claimed in Claims 1 and 2 are "merely an aggregation of old parts" and do not embody a "new result" and therefore were not patentable.

18. The Court erred in not holding that the combinations of Claims 1 and 2 were new combinations; that their respective elements in their new environment conjointly operated in a a new and improved way, and that the sum of the new combinations and the improved mode of operation constituted a new result, and was patentable.

19. The Court erred in holding that a new combination having a new or improved mode of operation was not patentable.

20. The Court erred in holding that "the structural changes in form and arrangement which may be discovered in the

specification afford the only features of novelty which can support the claims."

21. The Court erred in holding that the patentee having "contemplated special features of construction and arrangement of the springs," the patent must be limited to the most specific form of such arrangement.

22. The Court below erred in limiting Claims 1 and 2 to a mode of operation wherein the elliptical springs are "not brought into play . . . until the weight of the load on the axle box springs begins to depress said springs abnormally."

III. ARGUMENT FOR PETITIONERS.

A brief outline of the questions involved has been given above. Before proceeding with the argument it is necessary to state some additional facts.

The case before Judge Shipman was hard fought at every stage. The manufacturers of the trucks there in suit undertook the defence of the cause. The testimony covers 646 printed pages, and the argument occupied an entire day. The defendant was represented by eminent counsel. Judge Shipman sustained the validity of the patent as to Claims 1, 2, 9, 10, 11, 12, 14 and 27, and found that they had *all* been infringed. Claim 17 was found invalid and a disclaimer was duly filed. The decree for a perpetual injunction was made final October 1, 1900. No appeal was taken. The motion for a preliminary injunction in the case at bar before Judge Lacombe involved *only Claims 1 and 2* of the eight claims which had been fully sustained by Judge Shipman. Numerous letters patents, alleged to be prior in date, had been set up by the defendants in the Third Avenue Case before Judge Shipman, but all had been found by him to be irrelevant as affecting the validity and scope of the letters patent in suit. In the present case no new prior art has been adduced; indeed, the respondents have presented only two

United States letters patent out of a large number offered in the prior case: *Manier*, No. 419,993, dated August 27, 1899, and *Peckham*, No. 419,876, dated January 21, 1890. Both of these patents were carefully considered by Judge Shipman in his opinion, and both were considered in his opinion and were held not to affect the validity of *any* of the claims in controversy or their construction.

The respondents have not attempted in either of the Courts below to attack the validity of the letters patent, but only sought to limit the interpretation placed upon Claims 1 and 2 by Judge Shipman, and argued that their trucks did not infringe these claims as thus limited.

Judge Lacombe, in ordering a preliminary injunction, held:

> "The only question presented is whether defendant's structure infringes. That involves the construction of the claims declared on and for the purpose of this motion, the construction already adopted by this Court on final hearing in the Third Avenue case should be followed for *there is no prior patent*, no prior use proved here *which was not before Judge Shipman*. It is true that in that case the defendant's device was a much closer copy than the one now under consideration, containing, as it did, the feature that the spiral springs came first into play and the further feature of depending caps in which the leaves of the elliptic springs play vertically, but *the Court most carefully indicates* that *the leading feature of the invention lies outside of these details;* that the '*gist of the invention consists* in combining with the frame of the truck and the spiral springs other springs, viz., elliptical springs between the car body and the extension of the independent frame;' the object being to break the rhythm of the springs, and thus do away with the galloping or rocking motion. The defendant here insists that there is no rhythm broken, indeed, that there is no rhythm to break, and that the combination of the quota-

tion does not do away with the galloping motion. On these points, however, the Court should follow the earlier decision. There are additional rods and also spirals below the frame, which apparently in defendant's structure do their share in eliminating galloping; but *the combination which Judge Shipman described as the gist of the invention is undoubtedly in defendant's structure*, and under well-settled rules of practice complainant is entitled to a restraining order until final hearing."

There can be no doubt and the respondents have never attempted to deny that infringement was clearly made out if:

1. Claims 1 and 2 are to be construed according to their terms, or if

2. They are to be construed as Judge Shipman defined them in the Third Avenue Case.

That is, Judge Shipman sustained the claims broadly as they read.

Judge Lacombe, in granting the restraining order, suspended its operation, provided an appeal was taken in five days, ordering the defendant company to file a sworn monthly statement of sales. The question of a suspension of the operation of the injunction was not raised at the hearing nor argued. The complainants were thus deprived of the fruits of their victory by a staying order the propriety of which they had no opportunity to argue. Indeed, the argument on the motion for a preliminary injunction covered hardly more than half an hour, and took place upon the defendants' affidavits of facts which complainants' counsel had never seen until the argument began and could not rebut.

An appeal was promptly taken and promptly heard by the Court of Appeals. At the argument but an hour was given to counsel for the appellee, which, after the appellees' side of the case had been properly opened, left barely twenty minutes for argument. Of the two letters patent which alone were relied upon by appellants below, as imposing a limitation upon

Claims 1 and 2 sufficient to permit the appellant to escape the charge of infringement, the *Manier* Patent and the *Peckham* Patent, the *Manier* Patent was, in the opinion, considered as having no bearing, and the *Peckham* Patent, after an inspection by the presiding Justice, was stated by him at bar to have no relevancy to the case.

In its opinion, the Court of Appeals, practically admitting that Judge Shipman's interpretation of Claims 1 and 2 fully covered the trucks of the appellants, held that "it was not necessary in that case [before Judge Shipman] to define accurately Claims 1 and 2" and proceeded to consider these claims afresh, though the defence set up was precisely the *same defence* that had been fully considered and disposed of by Judge Shipman.

The Court below, in ordering the bill to be dismissed, based its decree solely upon the case of *Mast, Foos & Co.* vs. *Stover Manf. Co.*, 177 U. S. 485.

The petitioners deemed themselves aggrieved by this decree, and sought a writ of *certiorari* to correct it, for the following reasons:

1. *The doctrine of the Mast-Foos case does not apply to the case.*

2. *The Court below, under the "Rule of Comity," should have affirmed the decree of the Circuit Court granting an injunction, upon the prior adjudication of Judge Shipman.*

1. The Mast-Foos doctrine does not apply.

We submit that the doctrine of that case was entirely misapprehended by the Court below and that its application to the facts of the present case was error. The facts of this case differ essentially from the facts of the *Mast-Foos* case.

In the *Mast-Foos* case the patent in suit related to the use in a windmill of a simple mechanical gear device as old as mechanics. When the record came before the Circuit Court of Appeals in that case there was no single *fact* in dispute. It was not denied that the merits of the case were fully before

the Court—as fully as they could ever be. The sole contention of the complainant whose bill had been dismissed appears from the following specifications of error in the petition for a writ of *certiorari:*

> "That it was error of law for the Circuit Court of Appeals for the Seventh Circuit to *dismiss this bill.* . . . . upon mere *ex parte affidavits;* which decision . . . . was rendered without a trial 'according to the course and principles of courts of equity.'"
>
> "That it was error of law for the Circuit Court of Appeals for the Seventh Circuit to make this *final* decision on the *merits* without affording your petitioner the right of trial on evidence in chief and in rebuttal, taken by the examination and cross-examination of witnesses, as provided in Rules 67, 68, etc."

And in the brief on behalf of the petitioner in that case the same grounds for the writ were set forth:

> "The dismissal of the bill of complaint on such *ex parte* affidavits in such interlocutory proceeding on appeal from the Circuit Court granting a preliminary injunction; 'such dismissal of the bill for want of equity under such conditions depriving the petitioner of the right of trial of its cause.'"

The brief proceeded as follows:

> "Upon these facts, two questions of law arise for determination by this Court, to wit: (1) was the dismissal of the bill right or wrong? And (2) is the so-called 'rule of comity' between the Federal Courts to be maintained or not?"

No other questions than the above were raised in the argument for the petition.

The Transcript of Record in the cause shows that the entire evidence for the defendants consisted of a large number of letters patent, together with evidence of what is referred to in

the opinion of this Court as the Perkins Mill, as to which the facts were undisputed. The prior art set up in the case was different from that set up in the prior adjudication and, therefore, the Rule of Comity was not applied.

In the opinion sustaining the decree of the Court below, in that case, and ordering the bill to be dismissed, this Court most carefully defines the class of cases in which it is proper to dismiss a bill upon an appeal from a decree awarding a preliminary injunction. We quote from the opinion of this Court:

> "Does this doctrine apply to a case where a temporary injunction is granted *pendente lite* upon affidavits and immediately upon the filing of a bill? We are of opinion that this *must be determined from the circumstances of the particular case.* If the showing made by the plaintiff be *incomplete;* if the order for the injunction be reversed, because injunction was not the proper remedy, or because under the particular circumstances of the case, it should not have been granted; or if other relief be possible, notwithstanding the injunction be refused, then, clearly, the case should be remanded for a full hearing upon pleadings and proofs. But if the bill be obviously devoid of equity upon its face, and such invalidity be incapable of remedy by amendment; or if the patent manifestly fail to disclose a patentable novelty in the invention, we know of no reason why, to save a protracted litigation, the Court may not order the bill to be dismissed. Ordinarily, *if the case involve a question of fact,* as of anticipation or infringement, we think the parties are entitled to put in their evidence in the manner prescribed by the rules of this Court for taking testimony in equity cases. But if there be nothing in the affidavits tending to throw a doubt upon the existence or date of the anticipating devices, and giving them their proper effect, they establish the invalidity of the patent; or if no question be made *regarding the identity of the*

alleged infringing device, and *it appear clear that such device is not an infringement*, and no *suggestion* be made of *further proofs* upon the subject, we think the Court should not only overrule the order for the injunction, but dismiss the bill."

It appears, therefore, that the doctrine *does not apply:*

"If the showing made by the complainant is *incomplete.*"

"If the case *involve a question of fact*, as of anticipation or infringement."

If any "*suggestion* be made of *further proofs* upon the subject" of infringement.

The limitations to be placed upon the rule can be inferred with equal clearness from the three cases cited by this Court in its opinion. They were the following:

Gardt vs. *Brown*, 113 Ill. 475.

This was a bill filed by the owners of real estate to restrain the closing up of a certain door. The complainant procured a temporary injunction. On answer filed, there was a motion to dissolve the injunction, which was heard on bill, answer and affidavits, and an order was entered dissolving the injunction and dismissing the bill. The Supreme Court in its opinion said:

"It is urged that the Court, on dissolving the injunction, should have retained the bill for a hearing on evidence. We are unable to perceive any reason for doing so, because *the bill on its face discloses no equity*, and unless it had been amended it would have been useless to retain it for any purpose. The bill, as framed, involved only the construction of the deed and lease, and *that arose on the bill.* It was, therefore, improper to retain the bill, as to have done so would only have resulted in increased costs. Appellants have treated the decree as final, and had they not, their appeal would be

as dismissed. The circuit court judge who tried the case made this order: 'The order is, that the injunction be dissolved; and further, if complainants desire to take an appeal, that the bill be dismissed.' It was then *optional with appellants* to have the bill retained or to consider it as dismissed, and having made the election they must be held to their choice."

Green vs. *Mills*, 35 U. S. App. 383; 69 Fed. Rep. 852.

This case went no further than the Illinois case just cited. It was in substance a *political* bill "brought to restrain the registering officer from discharging the duties imposed upon him by law by which these complainants and others similarly situated might be deprived of a political right."

Chief Justice Fuller said, in dismissing the bill:

"We repeat that the action sought to be enjoined is *political and governmental*, and it is not pretended that any right of property or civil right is threatened with infringement thereby.

"This being so, we are clearly of opinion that *no ground of equitable cognizance exists*, and, although the appeal is from interlocutory orders, yet, *as we entertain no doubt that such a bill cannot be maintained*, we are constrained, in reversing these orders, to remand the cause with a direction to dismiss the bill."

Knoxville vs. *Africa*, 47 U. S. App. 74; 77 Fed. Rep. 501.

This was a bill to settle the right of Africa, who was engaged in the operation of an electric street railway in the City of Knoxville, to extend his railway and occupy three unoccupied streets of the city. The Circuit Court granted a preliminary injunction upon bill, answer, exhibits and *ex parte* affidavits filed in support of the bill. On appeal from the pre-

liminary injunction, the Court of Appeals for the Sixth Circuit was of opinion that the complainant, *by his own showing*, had no right under the law to occupy the streets in question, and that as the question was one of law and was *fully presented by the record*, the case should be decided upon the merits and if found to be with the defendant, the bill should be dismissed, and this was ordered to be done. The ground upon which this was done is more fully stated in the opinion of Lurton, C. J., rendered upon a petition for rehearing:

> "The appeal was from an interlocutory injunction. So far as the propriety of that injunction depended upon the validity of the ordinance of January 11, 1876, *we were in possession of a complete record*, and *could do full and final justice by determining the matters of law* upon which the street rights claimed under that grant depended."

But a *rehearing was granted* upon the ground that the Court had failed to take notice of the *fact* that Central Avenue and Crozier Street were one and the same street, and that an insignificant portion of Central Avenue was not under the actual occupancy of the complainant. The Court holding that the "record is not in such a condition as to justify a *final disposal* of the questions of *fact* upon which the ultimate rights of the parties must depend," the order dismissing the bill was revoked and the cause was permitted to proceed to final hearing.

We submit that there is nothing in these three cases which sustains the application of the doctrine of the *Mast-Foos* case to the case at bar. The cases of *Gardt* vs. *Brown* and *Green* vs. *Mills*, were obviously bills upon which a demurrer would have been sustained, and the courts in both cases substantially so treated them. In *Knoxville* vs. *Africa* it appeared in the first judgment that the complainant showed, by his own affidavits, that as a question of law upon *undisputed facts*, he had no equity under his bill.

It may be pointed out that the doctrine of the *Mast-Foos* case is merely a similar rule to that under which a patent bill may be dismissed on demurrer. But the cases where this has been done *are few* in the books. In most of the reported cases it has been refused, and it will always be refused, "If *doubt* exists . . . if the faults pointed out by the defendant *may, by any chance, be cured by proof;* if, in short, *there be a possibility* that the complainant *may* succeed" (*Electr. Vehicle Co.* vs. *Winton Co.*, 104 Fed. Rep. 814).

We submit, therefore, that upon the language of the opinion of this Court in the *Mast-Foos* case, upon the facts of that case, and upon the authorities cited by this Court in support of the doctrine there announced, the rule in that case will not be applied unless it appears that the *entire merits* are before the Court of Appeals, that the complainant has fully proved all the facts which are relevant in support of the bill of complaint, and that no fact alleged on behalf of the defendant is disputed; or, to state it in the language of this Court, if there is "any suggestion of further proofs," the rule announced in that case cannot be applied.

The petition for the writ fully sets forth the questions of fact as to which the "showing made by the complainant is incomplete," and as to which they claim the right to adduce proofs and to cross-examine the respondents' witnesses. A summary of such matters will be found on page 21 thereof, as follows:

"Your petitioners submit that it would be an intolerable hardship and injustice to them if they should be finally deprived of the opportunity to present testimony on their own behalf and also to cross-examine the defendants' witnesses upon the following issues, among others, namely:

I. The actual construction of the defendants' various trucks as they have made and sold them from the time they began to manufacture trucks containing the combination of spiral and elliptical springs of the patent in suit.

II. The actual operation of the defendants' devices as compared with the devices of the patent in suit.

III. The question whether defendants' devices do, *in fact*, infringe Claims 1 and 2, if said claims are to be limited as held by the Court below.

IV. The question whether defendants' trucks do, *in fact*, infringe other claims of the patent in suit (*e. g.*, Claims 9, 10, 11 and 14, which have been sustained by Judge *Shipman*).

V. The question how the devices of the Peckham patent, No. 419,876, would operate, if used, and whether they necessarily limit the complainants' patent in the manner adjudged by the Circuit Court of Appeals.

VI. That the devices of the said Peckham patent were and are, *in fact*, incapable of practical use, and that they were never in fact used.

VII. The question whether the complainants' invention antedates the said Peckham and Manier patents.

VIII. The utility and value, as well as the wide adoption and use, of the combination of Claims 1 and 2 of the patent in suit, consisting essentially of spiral and elliptical springs combined with the side beams and movable frames of a car truck, the said elliptical springs being of slower action and of a different period of action from the spiral springs, as showing patentable quality in the invention, regardless of the relative times at which one spring or the other comes into use.

IX. That the defendants' trucks are *not*, as claimed by the counsel for defendants, the Peckham Company, in his argument against the petition for re-hearing in the Court below, "radically different, both in construction and mode of operation from that of the patent in suit," such allegation being based upon *ex parte* affidavits relating chiefly to certain alleged experiments conducted by witnesses for the very purpose of this case, to which affidavits your petitioners were not permitted to reply in the Record now before the Court."

Another marked difference exists between the facts of the *Mast-Foos* case and of the case at bar, which has an important

bearing upon this case. In that case the complainant was served with the defendant's affidavits before the argument and was permitted to reply to them by rebuttal affidavits. In the case at bar the defendants were granted an adjournment, for one week, of the hearing of the motion for a preliminary injunction with leave to file their affidavits *at bar at the hearing.* The complainants' counsel asked the Court that they be ordered to be filed and served two days before the hearing, but this was refused. The complainants' counsel not only did not know till the hearing what the defence would be, but were debarred from putting in rebuttal affidavits. Under such practice the application of the doctrine of the Mast-Foos case would seem to be peculiarly inapplicable.

And not only were the complainants debarred from presenting counter-affidavits, but they were also limited to a single hour in the argument of the cause on appeal. This limited time did not permit of proper argument on the real merits of the case; it may almost be said that the case was submitted without oral arguments—certainly without adequate argument commensurate with the condition of the Record; the state of the facts involved therein; and the importance of the issues involved.

The complainants submit that they have not had their day in Court *either* to establish by proof the *facts* necessary to sustain the averments of their bill or to present to the Court adequate arguments of counsel on their behalf.

Again the Court below overruled the deliberate adjudication of Judge Shipman, one of the judges of the same circuit, which, in a litigated case in which every point was necessarily and expressly involved, had settled the very question involved. It held that Judge Shipman's finding as to what he held to be the very *gist* of the invention, was *not necessary* for the decision of the case before him. We submit that in this the Court was mistaken. On the contrary, the precise interpretation of Claims 1 and 2 was of the essence of Judge Shipman's adjudication:

Claim 1 covers the stationary frame (supported on the running gear); the movable frame (on which the car body rests); spiral springs located between these two frames, and elliptical springs located between the outer extensions of the frames.

Claim 2 covers the said stationary frame (supported on the running gear by saddles); the said movable frame; spiral springs between said saddles and said movable frame; and the elliptical springs between said frames.

Claim 1 provides that the elliptical springs shall be located between the outward extensions of the movable and stationary frames, while Claim 2 specifies only that their location shall be between the said frames.

Judge Shipman, referring to Claims 1 and 2, held as follows:

"The *gist* of the invention consisted of combining with the frames of the truck and the spiral springs, another class of springs, viz., elliptical springs, between the car body and the extensions of the independent (stationary) frames. The *elliptical* springs are *slower* in their *action* than the spiral springs and *neutralize the longitudinal oscillation* of the car body."

"This *leading feature of the invention* is described in Claims 1 and 2, which *do not contain the limitations* of the invention described in the next paragraph.

"A *second* and *minor feature* of the invention described in claims 9, 10, 11 and 14 is such an arrangement of the elliptical springs with the car body that they 'will not come into play until after the axle-box springs have begun to compress, and the action of the spiral springs in lifting the car body is continued after the ellictical springs have ceased to act.' The elliptical springs are not depressed until the car body or one end of it has become depressed by the weight of the passengers or some other cause, when this slower motion interposes and checks the continuation or increase of oscillation.

"It has already appeared that the *gist of the invention* is described in Claims 1 and 2.

"The result of the *minor* invention of Claims 9, 10, 11 and 14 was important, though upon first inspection its marked importance does not appear, but it perfected the *general* invention of the first two claims."

In the Third Avenue case much of the evidence taken was as to whether the defendant's trucks had the element of subsequent compression or not; consequently the Court was necessarily obliged to consider and to define accurately both sets of claims, those with and those without subsequent spring compression. The defendant *admitted* that it had used trucks having the feature of simultaneous spring compression, and did not deny infringement of the broad Claims 1 and 2. But it endeavored to prove that none of its trucks had ever been operated with *subsequent compression*, and it *denied infringement* of the limited Claims 9, 10, 11 and 14. Judge Shipman found for the complainant on this issue; that is, he found that the latter group of claims *had* been infringed. The question to be decided was twofold. 1. As to the *validity* of Claims 1 and 2, the defendant denying their *validity*, but never pretending that they were to be *limited* in any way and not seriously denying their *infringement*. 2. As to *infringement* of the minor group of claims, the *validity* of which was not seriously denied.

It appeared there that the defendant, during its use of the trucks, had *altered* them by inserting blocks of wood over the elliptical springs so as to bring them under compression simultaneously with the spiral springs when the car body was on the truck. If, therefore, Judge Shipman, instead of sustaining Claims 1 and 2 as broad claims, had limited them (as the Court below has done in this case), the defendant could have continued even after injunction to use the trucks as so altered.

We will show further, at p. 129, that the condition and use of the trucks complained of in the Third Avenue case was such as not only to warrant Judge Shipman in defining *accurately*

the scope of Claims 1 and 2, but to impose upon him the *duty* of doing so in order to adjudicate the precise issues before him.

The present petitioners went into the Circuit Court for a preliminary injunction with a complete adjudication of the validity of their patent and one which defined accurately the scope of the claims, and this by a judge of the very Court to which they made their application. If his definition of Claims 1 and 2 was correct, no question of infringement could arise. Having secured this adjudication after a long and arduous litigation, they were entitled to an injunction to restrain further infringement of their established rights at least until final hearing.

It will be remembered that no new prior art was set up—that the Peckham Patent considered by the Circuit Court of Appeals as imposing a limitation upon the plain language and scope of Claims 1 and 2 had been fully considered by Judge Shipman in the prior case and held by him to have no revelancy.

On such a case and with a record which amounted to hardly more than formal proof, which was all counsel deemed necessary, under the practice, to sustain the right to a preliminary injunction, the Circuit Court of Appeals rejected Judge Shipman's interpretation of the claims, took up the Peckham Patent which he had, with the aid not only of patent experts but of practical street railway men of large experience, carefully considered on final hearing and had disposed of, and which the Court below itself had brushed aside when presented at the oral argument of this case, and found that it imposed a limitation upon the claims as they read and as Judge Shipman had construed them, and summarily dismissed the bill.

It is submitted that the extension of the rule announced in the *Mast-Foos* case to the facts of the case at bar would effectually put an end to the practice of motions for prelimi-

nary injunctions in patent cases—a result that would go far towards destroying the value of property in letters patent. Public interests demand that a patentee who has sustained the validity of his patent after a test case upon pleadings and proofs, fully and honestly contested, should have the full benefit of his victory in a suit against another infringer. But under the ruling of the Circuit Court of Appeals in this case, it is believed that no litigant, under such circumstances, would venture to ask for a preliminary injunction. No matter what facts a complainant might set up in his injunction affidavits, a defendant may be expected to set up a counter statement of facts. The complainant, being debarred from presenting rebuttal affidavits, would practically be bound by the statement of facts in the defendant's affidavits, and, on appeal, would go to what may be turned into a final hearing, as the petitioners have been forced to do here, upon a record made up *ex parte*.

2. The Court below did not give "sufficient weight" to the Rule of Comity, and therefore the decree was reversible error.

The proper scope of the "Rule of Comity" and its application by Circuit Courts of Appeal is stated in the opinion of this Court in the *Mast-Foos case*. We submit that the present case, as presented to the Circuit Court of Appeals, was one in which the rule was peculiarly applicable and should have been applied, and that the refusal of the Court below, under the circumstances, was reversible error.

The case has every feature which would call for the application of the rule:

A prior adjudication of the patent after
A long and arduous and fully contested case.
Defended by a competing manufacturer,
Represented by able and experienced patent counsel.
An adjudication on the very claims here in issue,

Holding them not only to be valid, but as constituting the gist of the invention,

The precise definition of the scope of the claims, directly involved in the case and necessary to its determination.

Infringement not denied if the prior adjudication is to stand, or

If the claims are to be interpreted as they read.

No new art set up that had not been fully disposed of in the prior adjudication.

In *Mast, Foos & Co.* vs. *Stover Mfg. Co.*, it was said by this Court:

> "Comity, however, has no application to questions not considered by the prior Court, or, in patent cases, to alleged anticipating devices which were not laid before that Court. . . . It is scarcely necessary to say, however, that when the case reaches this Court we should *not reverse the action of the Court below* if we thought it correct upon the merits, though we were of opinion it had not given sufficient weight to the doctrine of comity."

This seems to imply a rule that in a *proper case* this Court *will* reverse a Circuit Court of Appeals for a failure to apply the doctrine, unless it appears that the decision below was correct upon the merits.

We submit that the case at bar is such a case; that "sufficient weight" was not given to the rule of comity by the Court below; and that its decision was not correct upon the merits.

The Rule of Comity and its application to a proper case in aid of a patentee who has established the validity of his patent, is a matter of general importance in the *administration* of the patent law. The question is constantly arising, and it is essential in the interests of uniformity in the various circuits, that the scope of the rule should be settled by an authoritative definition of this Court. The constitution of

the Federal courts with nine separate and co-ordinate appellate tribunals, a system hitherto unknown in any English-speaking country, seems to render this absolutely necessary. Unless they act under rules by which there is at least an attempt to secure uniformity of decision, the uncertainty will be intolerable and the system will break down. This was recognized in *Columbus Watch Co.* vs *Robbins*, 148 U. S. 266, where it was held that the fact that diverse judgments had been rendered in two Circuit Courts of Appeals under the same conditions "might furnish ground for *certiorari*." Courts of Appeal exist rather to secure uniformity of law than to give suitors another day in court and it was for this reason that a general supervision over the nine Circuit Courts of Appeal was retained in this Court by the Act of 1891—to be exercised by it in questions which it might deem of general importance. Necessarily, questions of *administrative law*, such as arise here must be of the greatest importance. The same considerations which induced this Court to hear this case will, we submit, induce it to correct the failure of the Court below to give proper effect to the rule of comity in this case, to which, we submit, it is peculiarly applicable.

The rule of comity had been carefully laid down by the *Court below itself*, as recently as February, 1900, in *Consolidated Fastener Co.* vs. *Hays*, 100 Fed. Rep. 984, where it said:

> "Shortly after its organization this Court had occasion to enunciate the proposition that, where there was an appeal from an order granting preliminary injunction, the Court below having followed an adjudication at circuit sustaining the patent after contest upon pleadings and proofs, such adjudication is to have the same weight which it should have before the Circuit Court. . . . The propriety of some such rule is apparent. The prior adjudication has been secured by complainant on testimony which has been sifted by cross-examination,

and it would seem that he should be entitled to cross-examination of defendant's experts before being deprived of the advantage of his previous decree. Especially so in view of the ease with which *ex parte* affidavits of experts exploiting any theory desired may apparently be obtained. This practice has been ever since adhered to by this Court.

"In *Fastener Co.* vs. *Littauer*, 28 C. C. A. 133; 84 Fed. 164, we quoted from the Paper-box case, *supra*: 'The adjudication upon which the motion for preliminary injunction was based, not being the subject of the appeal, is to have the same weight which it should have before the Circuit Court, . . . in the absence of some controlling reason for disregarding it,'—and added:

"'No such controlling reason is shown here. No prior patent, or prior use or prior publication, having an important bearing upon the validity or construction of the patent, and which was not before the Court in the Columbian Company case, is now presented; no new authority on patent law is now first cited; there is nothing to show an improvident exercise of legal discretion by the Circuit Judge; and, apparently, this is an *effort to review the decision in the Columbian case at final hearing* upon a *partial presentation* of the evidence then considered, and without the *cross-examination*. There is *no warrant for such practice*, which was *expressly condemned* in *American Paper-Pail & Box Co.* vs. *National Folding Box and Paper Co*, *supra*.'

"It has seemed desirable once more to restate this rule of practice, since the appeal here seems to have been mainly *argued on the theory that the decision of Judge Colt was to be reviewed*, as if this were an appeal from that decision upon the record before him."

Among the cases cited in *Mast, Foos & Co.* vs. *Stover Mfg. Co.*, at page 489, as being "well-considered cases" on the rule of comity, is the following:

Electric Mfg. Co. vs. *Edison Electric Light Co.*, 61 Fed. Rep. 834, where it was held:

> "Where the validity of a patent has been sustained by prior adjudication upon final hearing, and after *bona fide* and strenuous contest, the matter of its validity upon motion for preliminary injunction is no longer at issue, all defense, except that of infringement, being reserved to the final hearing."
>
> "When, upon judicial contest, a competent court has sanctioned the grant and determined the right thereunder, the monopoly thereby granted *ought not to be permitted to be invaded except upon a clear showing that the decision invoked in its favor was wrong.*"

We will cite decisions from several of the circuits which sustain the following legal propositions:

1. *On appeal from an order granting a preliminary injunction the Circuit Court of Appeals will consider only whether the lower Court exercised a reasonable discretion in granting an injunction.*

Loew Filter Co. vs. *German-American Filter Co.*, 107 Fed. Rep. 949. C. C. of A., Sixth Circuit, before Lurton, Severens and Clark, JJ.:

> "We have repeatedly held that an order granting an injunction will not be reversed on appeal unless it clearly appears that the Court below has fallen into a misapprehension respecting the facts or law of the case in a matter vital to the issue. Duplex Printing Press Co. *vs.* Campbell Printing Press & Mfg. Co., 16 C. C. A. 220, 69 Fed. Rep. 250; Thompson *vs.* Nelson, 18 C. C. A. 137, 71 Fed. Rep. 339; Proctor & Gamble Co. *vs.* Globe Refining Co., 34 C. C. A. 405, 92 Fed. Rep. 357."

Bissell Carpet Sweeper Co. vs. *Goshen Sweeper Co.*, 72 Fed. Rep. 545. C. C. of A., Sixth Circuit. Lurton, C. J., said:

> "When the appeal involves only an order or decree granting a preliminary injunction, this Court will not consider or determine the merits of the cause, but confine itself to a consideration of the question as to whether the Circuit Court has abused its discretion in the allowance of the writ."

Stearns-Roger Mfg. Co. vs. *Brown*, 114 Fed. Rep. 939, C. C. of A., Eighth Circuit. Caldwell, Sanborn and Thayer, JJ.:

> "The primary question on an appeal from an order granting a temporary injunction is whether or not the injunction evidences an error in the exercise of its sound judicial discretion by the court which issued it. There are established legal principles for the guidance of that discretion, and where they are violated the action of the Court below should be corrected. But, unless there is a plain disregard of some of the settled rules of equity which govern the issue of injunctions, the orders of the Courts below on this subject should not be disturbed. The law has placed upon these courts the duty to exercise this discretion. It has imposed upon them the responsibility of its exercise wisely, and has left them much latitude for action within the rules which should guide them; and, if there has been no violation of those rules, an appellate court ought not to interfere with the results of the exercise of their discretion. The right to exercise this discretion has been vested in the trial courts. It has not been granted to the appellate courts, and the question for them to determine is not how they would have exercised this discretion, but whether or not the Courts below have exercised it so carelessly or unreasonably that they have passed beyond the wide latitude permitted them, and vio-

lated the rules of law which should have guided their action."

So. Pac. Co. *vs.* Earl, 82 Fed. Rep. 690. C. C. of A., Ninth Circuit. Appeal from an order granting a preliminary injunction.

"Inasmuch as the granting of an injunction *pendente lite* is committed to the discretion of the trial court, it necessarily follows—and so the authorities uniformly hold—that upon an appeal from such an order the only question which the Appellate Court is called upon to determine is whether the Court, in making such an order, abused its discretion. If there was before the Court evidence having a reasonable tendency to make out a *prima facie* case for the plaintiff, the order granting the injunction will generally be affirmed, notwithstanding there may have been a material conflict in the evidence submitted to the Court at the time of making its order; or, stating the same rule in different words, the decision of the Judge who made the order will not be reversed unless it appears, after a consideration of all the evidence upon which his action was based, that his legal discretion to grant or withhold the order was improvidently exercised."

2. *The prior adjudication, not being the subject of the appeal, is entitled to the same weight in the Circuit Court of Appeals which it should have had in the Circuit Court.*

Consolidated Fastener Co. vs. *Littauer*, 84 Fed. Rep. 164. C. C. of A., Second Circuit.

"The adjudication upon which the motion for preliminary injunction was based, not being the subject of the appeal, is to have the same weight which it should have before the Circuit Court, . . . in the absence of some controlling reason for disregarding it.

The Court said that this was an effort to review the decision in a prior case. There was no warrant for such practice.

Duplex Printing Press Co. vs. *Campbell Co.*, 69 Fed. Rep. 250. C. C. of A., Sixth Circuit. Taft, C. J.

> "On an appeal from an order granting a preliminary injunction in a patent case, a prior adjudication by the Circuit Court of another circuit sustaining the patent and finding infringement is entitled to the same consideration as in the Court below, and is sufficient ground for affirming the order."

American Paper Pail Co. vs. *National Folding Box Co.*, 51 Fed. Rep. 229, C. C. of A., Second Circuit. Appeal from an order for a preliminary injunction, based on a prior adjudication by Judge Lacombe.

> "The appeal calls upon this Court to state its position, as an appellate court, in regard to motions of this character, and particularly with respect to the weight which is to be given to the previous adjudication, which is generally the foundation of a preliminary injunction. The appellate court is to examine the interlocutory decision of the Circuit Court in the light of the affidavits, and of the history of the patent, and the adjudications thereon, which were presented to that Court. The adjudication upon which the motion for preliminary injunction was based, not being the subject of the appeal, it is to have the same weight which it should have before the Circuit Court."

Heaton-Peninsular Co. vs. *Elliott Co.*, 58 Fed. Rep. 220. C. C. Mich. Brown, C. J.:

> "Where an issue has once been passed upon by a Circuit Court, it is only in a case of clear mistake of law or fact, of newly discovered testimony, or upon some question not considered by the Court, that a Circuit Court sitting in another district is at liberty to review the find-

ings, and it will not do so merely because there is doubt as to whether the patent in issue has been anticipated, when that question has been previously passed upon."

Of course, both the *validity* of the patent and *infringement* must clearly appear before a preliminary injunction can be granted. But both did appear in this case. Judge Shipman in his prior adjudication had fully sustained the patent, *had also accurately* and *precisely* defined the scope of Claims 1 and 2 of the patent in suit before him and here in suit, and, as will be shown fully below, it was *necessary to the decision of that case to do so.* There has never been any pretence that the respondents' trucks do not infringe upon Claims 1 and 2 as they were defined by Judge Shipman, and that they do not contain what Judge Shipman found, after full consideration, to be the *gist of the invention.* Judge Lacombe so held in his brief opinion in the Circuit Court.

The case at bar seems a peculiarly hard one.

The invention was conceived in 1889. It was put in use in 1891. The application for a patent was filed June 26, 1891, and the patent was granted July 5, 1892. The applicant came out of the Patent Office with his broad claims, as filed, in spite of the references there cited against him, including the Manier patent and the Peckham patent 419,876 here solely relied upon as indicating the prior art.

He received a grant of a patent, which, as this Court has held, was *prima facie* valid from the date of its issue (*Mitchell* vs. *Tilghman*, 19 Wall. 390; *Lehnbeuter* vs. *Holthaus*, 105 U. S. 94). When such a patent is offered as evidence the burden is cast upon the defendant to show that it is invalid. (*Seymour* vs. *Osborne*, 11 Wall. 516, 538.) The defences of anticipation, etc., must be pleaded and proved, and so strong is the presumption of the validity of the patent that this Court has held that on such issues every reasonable doubt should be resolved against the defendant. (*Coffin* vs. *Ogden*, 18 Wall. 120, 124; *Cantrell* vs. *Wallick*, 117 U. S. 689.)

The invention soon went into general and almost exclusive use—was "*universally adopted*" *in the trade.* Competing truck builders began to infringe, as the railway companies would buy no other type of trucks. The Bemis Car Box Company built the infringing trucks in the Third Avenue case about 1894. That case was fought as a test case. In 1900, after a long and arduous contest, in which the Manier and Peckham patents were again set up, the validity of the patent was broadly sustained by Judge Shipman, who held that, in a most important art, the invention had provided "almost a complete remedy" for a serious difficulty and had been "universally adopted."

Relying upon this adjudication, the patentee at once (October, 1900) sought a remedy against another competitor, who had already sold 10,000 infringing trucks. Again the Manier and Peckham patents (and no others) are set up by the defendant. He obtains an injunction in the Circuit Court, but, without a hearing, is at once deprived of its effect by a suspending order. A record made up against him by *ex parte* affidavits which he never saw until the hearing, and could not rebut, is taken to the Court of Appeals, and there he is told that his hard-fought victory before Judge Shipman was of no value to him; that the twice rejected Peckham patent limits his invention, and that Judge Shipman's deliberate adjudication that his specification and claims were as broad as his invention was a mistake. And, finally, his bill is dismissed without a day in court for the ascertainment of his rights in the usual and orderly manner of courts of equity.

3. AS TO THE MERITS OF THE CASE.

The Patent in Suit and its Relation to the Art.

The only claims here in controversy are Claims 1 and 2.

Judge Shipman sustained the validity of Claims 1, 2, 9, 10, 11, 12, 14 and 27.

The patent in suit relates to the construction of non-pivotal electric street railway trucks for use under cars having a single four-wheel truck. The condition of the electric street railway business at the time of the invention of the subject-matter of the letters patent in suit, and the nature of this invention, found by him upon uncontradicted evidence, are clearly set forth in the opinion of *Judge Shipman* in the *Third Avenue case:*

"After electricity was substituted upon city railroads as a motive power to move cars formerly drawn by horses, the railroad corporations were subjected to great expense and the passengers to severe inconvenience in consequence of the oscillation of the cars from end to end, or 'galloping' motion as it was called. The horse cars were sixteen feet long and had a wheel-base or distance between the two pairs of wheels of six to seven and one-half feet. The new electric cars were from eighteen to twenty-two feet long, but, in consequence of the short radii of curves in city streets where cars turn from street to street, it was necessary to keep the wheel-base about as short as before to enable the car to pass around the curves, and, therefore, the car body was longer than the truck and overhung it. The result was that these overhanging and *unsupported* ends oscillated, pounded the rails, strained the trucks and *caused discomfort*, and, on heavily laden open cars, *danger to the passengers.* The patentee says in his specification:

"'The main object of my invention is to enable a truck of comparatively short wheel-base to be used, and to support a car body upon it, the ends of which overhang the truck for some distance. My invention is also intended to overcome in a measure the end vibration or oscillation of the car body and movable portion of the truck to which the car is secured.'

"In the patented structure, a pair of rigid longitudinal side beams, which derive their support from the axle

boxes, extend lengthwise of the truck beyond the wheels at each end and are called the 'independent frame.' At each side of each beam [box] a spiral spring is interposed between the beam and the spring plates upon which the car body rests and to which it is rigidly secured. These spring plates are secured to a rectangular frame called the 'movable portion' of the truck. At each side of the car there are two spring plates and four spiral springs, two between each plate and corresponding longitudinal beam or saddle, thus making a set of eight springs, called axle box springs. These springs, supported as they are upon a space equal to the length of the wheel base, cannot firmly support a car body of the length of the ordinary trolley car, and a multiplication of spiral springs between the wheels and the end of the car was also inadequate. The gist of the invention consisted in combining with the frames of the truck and the spiral springs, another class of springs, viz., elliptical springs, between the car body and the extensions of the independent frame. The elliptical springs are slower in their action than the spiral springs and neutralize the longitudinal oscillation of the car body."

John A. Brill, who has been building street cars and trucks for thirty years, avers (Record p. 31):

"The effect of it in the operation of the road was very serious. The old style of tracks, with the rails laid on parallel stringers, had a life of *hardly more than three years* under these conditions, owing to the *pounding of the single truck cars*. It became necessary to re-lay the rails with from 90- to 110-lb. rails to the yard, whereas on steam railroads the average weight of the rails was from 50 to 100 pounds to the yard. The effect on the truck of the *oscillation or galloping* was to bring about strains upon, and to loosen the component parts of, the truck and decrease its life and service; and the same was

true of the car bodies. *Oscillation* was also a source of great discomfort to the passengers, and on open cars there was an added element of danger to the passengers, it being well known that there have been instances where passengers have been thrown from their seats by the motion of the car. To make electric propulsion profitable, it was necessary to *increase the speed* of the cars in order to increase their daily mileage. The increase of speed, as above stated, greatly *increased the oscillation* and made it still more dangerous. When a car began to oscillate, it was necessary to *reduce the speed in order to steady the car*. There was also a constant danger of *derailment* in running a car while under this galloping motion. I have heard of very serious accidents happening by the derailment of cars caused by oscillation, attended with considerable loss of life. I have also heard of an instance where, under poor track conditions, it was found necessary to stop the running of cars entirely on account of this tendency. This tendency to excessive oscillation existed with the use of old styles of trucks and *before the introduction of the truck of the patent in suit.*"

To the same effect, George M. Brill, the patentee and probably the oldest car and truck builder in the country (Record p. 46).

Fagan's deposition states (p. 49 of Record):

"Where there is a tendency to oscillation, it increases with the speed. It takes place at, or is caused by, the 'low' or depressed joints of the rails and the intersection of tracks and where there is a change of grade. The oscillation with the trucks I have mentioned [all the earlier types of trucks] was so injurious that we were obliged to abandon the use of these trucks.

"The profitable operation of an electric street railway depends chiefly upon running cars at high speed. When

a car in running fast begins to oscillate, the speed has to be checked till the car becomes steady."

Littell states (p. 52 of Record):

"Where cars are running at the high rate of speed and begin to oscillate, brakes must be applied immediately and the speed reduced. If this is not done, the car may be derailed. Many derailments have been caused by excessive oscillation."

Akarman states (p. 54 of Record):

"The cause of oscillation in operating such a car body when placed upon such a truck, is as follows:

"It was the usual practice in laying the rails to leave a slight space between the ends of the rails, and when the ends of the rails became more or less depressed, a car, in passing over such a depression, gets a rocking or galloping or oscillating motion. . . . This rocking, or galloping or oscillating motion is increased when the track gets out of repair, and also when cars are run at a high rate of speed. . . .

"When a car, under such conditions, begins to rock or gallop, it pounds the joints of the rails and depresses them, thus making the track conditions more and more likely to produce such motion.

"Oscillation is greatly increased with an increase of speed, and as soon as a car in rapid motion begins to oscillate seriously, it is necessary at once to slow down the car, as in such case there is great danger of derailment."

"None of these types of trucks [the earlier ones] were successful in *preventing excessive and dangerous* oscillation, and the railway company with which I was then connected, made some experiments of its own. . . . These experiments were also unsuccessful in preventing the oscillation. In the use of all four types of trucks on that road, as above described, we had excessive and dan-

gerous oscillation of the cars, and we were unable to run our cars at the rate of speed necessary for successful operation."

The Record also shows that the truck of the patent *was a complete remedy* for oscillation and that it was *fully accepted as such in the trade.*

Fagan (p. 50 of Record):

"Four-wheel trucks with a combination of spiral and elliptic springs on the extended ends of the side beams have practically displaced all other types of single trucks in this country, and have gone into general use."

Littell (p. 52 of Record).

"So far as the use of trucks under long car bodies is concerned, I believe that this type has entirely displaced the early types with all spiral springs."

Akarman (p. 55 of Record):

"This type of truck has gone into universal use under four-wheel cars, and has substantially, if not completely displaced all other constructions of single trucks."

G. M. Brill (p. 48 of Record):

"Nearly 90 per cent. of all the four-wheel trucks in use in the United States were constructed in accordance with this invention."

Judge *Shipman*, in the *Third Avenue case*, said:

"The invention, *as a whole, attracted the immediate attention of railway superintendents*, was *found to accomplish its object* and to be almost a *complete remedy* [*obviously, oscillation of a car can never be completely eliminated*] *and trucks having spiral springs next to the*

axle-boxes and elliptic springs on the extensions of the truck frame have been universally adopted."

It is confidently asserted, and this Record establishes, that in the early days of this art, 1889 to 1891, there was no truck known to the trade which could be operated at the required speed without oscillating *to a prohibitory extent;* that the situation, to the street railway men, was serious, and that the truck of the patent was a *complete practical remedy* and was *accepted* as such and *universally adopted.* This appears in the affidavits in the Record of five of the most experienced railway men in the country, three of whom have been at the head of large systems and are entirely disinterested. The statement is not denied by the respondents' affidavits.

CLAIMS 1 AND 2, TOGETHER WITH THE SPECIFICATION, CONSIDERED.

Claims 1 and 2 are as follows:

"1. In a motor-truck, the combination, with a stationary frame supported upon the running-gear, said frame having sections extending outwardly from the axle, of a movable frame supported upon said truck, spiral springs located between the movable and stationary frames, and elliptical springs located between the extended sections of the said rigid frame and the movable frame, substantially as described.

"2. In a truck, a spring-supporting frame supported upon the running-gear by saddles and having sections extending outwardly from the axles, a movable frame having like extensions, spiral springs located between the saddles and movable frame, and elliptical springs located between the spring-supporting frame and the movable frame, substantially as described."

The springs mentioned in these claims require no explanation at this point. But the specific construction of the truck frame with which the springs are combined, and which constitutes *essential elements of the claims*, should be made perfectly clear.

The patent in suit states: "My invention relates to the application of what is known as an 'extended spring base' to trucks for street cars."

For this purpose it is manifest that a strong, stable frame was desired. The patent proceeds to describe such a frame as follows:

"In my structure I mount upon the axle-boxes, either rigidly or flexibly [that is, either rigidly metal to metal or flexibly by interposing a spring cushion such as 5^1 between the frame and the axle-boxes], what are known in the art as 'side beams,' which *singly* or when united laterally form a frame which is not affected either by the up-and-down vibrations of the car-body or movable portion of the truck, or when the said frame is flexibly supported upon the axle-boxes by the lateral thrust of the axles."

Thus the patent provides a frame which is either rigid on the axle boxes, or only movable vertically thereon to the extent of compression of the interposed cushions or springs 5^1, if such are used; so that a substantial and stationary support or base is provided for the springs which support the car-body. In addition to this, *the frame is provided with component or integral means* for tying together the axles at each side, and preserving them in what is technically called "parallelism," so that at all times the axels will be at right angles to the longitudinal centre of the car-body. The truck of the patent also includes what is technically termed in the art a body pedestal, forming part of the movable frame, *which positively and rigidly connects the car-body and stationary frame together* so far as *horizontal movement* (either transversely or longitudinally) of the car on the truck is concerned. These two essentials of practical modern electric truck construction (which are followed by the respondents in their trucks) are

secured by the construction referred to in the patent as follows:

> "At a point where the side beams [it being apparent that each 'side beam' has the foregoing characteristics singly, that is, when not tied together transversely to form a regtangular frame, or when so united into a rectangular frame] extend close to the axle-boxes they are secured to axle-box saddles [6 and 7], which saddles have extensions which provide seats for the 'axle-box springs,' (so called), and are also apertured to permit spring-posts [23] to pass through them. Upon these axle-box springs (which, in conjunction with the spring-posts and bracing for the same, form the pedestals for the axle-boxes) rests the upper chord [17] of the truck."

By means of the spring-posts, which pass through the saddles, a body pedestal is secured for holding the truck and car-body together as a unit, and for preserving the longitudinal parallelism of the side beams with the car sills. The spring-posts, passing through the side beams, relieve the car springs of any stress due to *horizontal* movement of the car-body on the truck.

The patent states that "6 and 7 are saddles supported on the axle-boxes either rigidly, flexibly, or in such a manner as to be capable of a movement in the line of the axle." This means that there is almost always a slight movement of the axle in the axle-boxes in the direction of the length of the axle. This is provided in order to relieve the axle-boxes of any undue strain caused by endwise thrusts to which the axles are invariably subjected. *Relatively to the axle*, therefore, there may possibly be a slight transverse movement of the side beams in the line of the axle coincident with that of the axle-boxes.

The patent further recites:

> "The side beams may be united laterally to form an integral frame; but this does not enter into the present

invention to any material extent, and so I have not shown them as united, *for the side beams act herein as an independent frame or support.*

"This truck is to be distinguished from the truck of the ordinary structure by reason of the fact that it comprises two distinct parts—one part comprising (apart from the running-gear) *the side beams or frame* and another part comprising the upper chord with its bracing and spring-posts. The first I shall term the 'stationary frame,' (although it is not stationary in the true sense of the word, because there is a play of the axles in the boxes and there may be a movement [vertically on the cushions] of the side beams) because it is not affected by the movement of *the car body to any appreciable extent.* . . ."

In addition to the characteristics of the side beams (or "independent frame or support" as it is termed in the patent), it is to be noted that the only movements they have is a slight vertical movement on the cushions 5^1, and a slight possible movement due to the axle thrust. *There is positively no movement whatsoever of the side beams in the direction of their length, or, in relation to the axle boxes, in any direction. It is clear that any longitudinal movement, or any swinging or lateral movement of the side beams other than the axle thrust just referred to, would completely destroy the efficiency of the frame as a base or support for the car springs, and would eliminate the important features of its construction, viz: component axle-box saddles preserving the parallelism of the axles, and body pedestals directly secured to the side beams or stationary frame.*

The relation which Claims 1 and 2 bear to the other claims of the patent is shown as follows, following along the lines of the *Third Avenue Case* before Judge Shipman:

The fundamental contention of the complainant in that case was that the eight claims there in controversy were to be placed in three groups.

First group, Claims 1 and 2 (the only claims now in controversy) cover the combination, with the frames of the truck structure, of the sets of springs of different character (spiral and elliptic springs) *arranged as recited therein*, to spring support the car body more efficiently and to neutralize the tendency towards longitudinal oscillation of the car body upon the supporting side frames.

Second group, Claims 9, 10, 11 and 14, cover such an arrangement of the springs that one set of springs is brought into action, on the downward movement of the car body, after the other set of springs has begun to be compressed.

Third group, Claims 12 and 27, relate to details of construction by which the elliptical springs are connected and engaged with the frames with which they co-operate.

The petitioners' expert witness, Mr. Livermore, after describing the structure of the patent in suit, says as follows (Record p. 68):

> "That portion of the invention of the patent in suit which consists in the combination with the frames of the truck structure thus far described, of the sets of springs of a different character arranged as described, to neutralize the tendency toward longitudinal oscillation of the car body upon said supporting frame, is what I understand is referred to in Claims 1 and 2 of the patent in suit."

As to the *second* group of claims, he proceeds to say:

> "The *subsidiary* features which I have above referred to may be briefly described as follows: One of the said features forming the subject of Claims 9, 10, 11 and 14 of the Brill patent, consists in so arranging and proportioning the springs that the slow-acting elliptical springs will not come into play until after the axle-box springs have begun to compress, and the action of the spirals in lifting the car body is continued after the elliptical springs have ceased to act."

And as to the *third* group he states:

"Another feature forming the subject of Claims 12 and 27 resides in the details of construction of the parts by which the elliptical springs are connected and engaged with the frames with which they co-operate."

We quote again from Judge Shipman on this point:

"The gist of the invention consisted *in combining with the frames of the truck and the spiral springs, another class of springs, viz., elliptical springs, between the car body and the extensions of the independent frame.*

"This *leading feature* of the invention is described in *Claims 1 and 2*, which *do not contain the limitations of the invention described in the next paragraph.* A *second* and *minor feature* of the invention described in Claims 9, 10, 11 and 14, is such an arrangement of the elliptical springs with the car body that they 'will not come into play *until after the axle box springs have begun to compress*, and the action of the spiral springs in lifting the car body is continued after the elliptical springs have ceased to act.' The elliptical springs are not depressed until the car body or one end of it has become depressed by the *weight of the passengers or some other cause*, when this slower motion interposes and checks the continuation or increase of oscillation.

"A *third* and *more subordinate feature of the invention* is described in Claims 12, 17 and 27, and consists in the construction by which the elliptical springs are engaged with the independent frame of the truck and car body."

That Claims 1 and 2 were *broad claims* (to be *interpreted as they read*), and this grouping of the claims and this theory of the scope of the respective groups, were the *basis of the complainant's contention* in the Third Avenue case. The complainant's expert in that case, Mr. Livermore, considered the

case entirely from that standpoint. The defendant's expert witness there, Mr. Chapin, followed the same line of thought. The argument of complainant's counsel followed along the lines of Mr. Livermore's testimony and the counsel for the defendant expressly followed the same grouping. They would, if they had thought the position *tenable*, undoubtedly have taken the ground that Claims 1 and 2 *should be limited* to successive compression. The reason for this is that the defendant's counsel in the Third Avenue case urgently contended, though unsuccessfully, that as a matter of fact *all* the Third Avenue trucks had their spiral and elliptic springs so arranged that *all came under compression at the same moment* upon the mounting of car body thereon. Their defence would have been to establish that such was the *fact*, and then to contend that Claims 1 and 2 must be limited to subsequent compression (the precise contention of the respondents in this case) They did not, however, attempt to take this position, but admitted the broad scope of Claims 1 and 2, if held valid at all, and attacked their validity, endeavoring to escape infringement of Claims 9, 10, 11 and 14 by showing that their trucks did not *in fact* show subsequent compression.

Thus, Judge Shipman said (Rec. p. 242):

> "The *contest* in regard to infringement related to Claims 9, 10, 11 and 14."

Claims 1 and 2 cover the broad invention which the evidence *shows the patentee to have made*. The fact is that in the Brill truck the spiral springs are what might be called the master car springs and in action they are supplemented by the elliptic springs. But when both are doing their work, *i. e.* carrying the car body and sustaining a load, they both act simultaneously in carrying the weight of the car body and the weight of the passengers. As the patent states, "one adaptation of the invention" was to make the *spirals* somewhat weaker than the spirals had *formerly* been in all-spiral trucks.

Obviously then the weaker spiral springs would more quickly compress and bring the load down to the elliptic springs.

When a car is placed upon the movable frame which is supported by the springs, the spiral springs are forthwith compressed and bring the weight down to the elliptical springs, which, thereupon, come under compression. During the actual use of the car both sets of springs support the weight of the car and its load and lessen longitudinal oscillation. Inasmuch as a car truck is a structure intended *for use under a load*, it must be considered from that standpoint. This explains why, in the drawing of the patent in suit, of a truck *without a car superimposed upon it*, a space is shown between the top of the elliptical springs and the movable frames. As just stated, when the car is placed upon the truck this space is taken up and the weight is brought down so as to compress the elliptical springs. Any other mode of construction would be an absurdity. The object of using the two kinds of springs is to produce an easy-riding car and to prevent oscillation; that is, after the *initiation* of the compression of spirals, the elliptics *at once* are in action, and they *cooperate* to this end in practical use.

This is shown by the following language of the specification (p. 2, line 120):

> "To this end I supplement the axle-box springs by placing elliptical springs of slower action between the extended portions or sections of the side beams and upper chord, and so arrange them in respect to each other that the elliptical springs will not come into play until after the axle-box springs have *begun* to compress."

Just *how heavy* the weight must be before both sets thus cooperate, is, of course, impossible to specify and the patent in suit does not attempt to specify, either in the language just quoted therefrom or in two other passages therein in which the expression "abnormal depression" of the spiral springs is used. This latter phrase clearly has no definite significance.

The point is that one set of springs will come first into action and with the load of the car thereon both sets will co-operate to support the weight and lessen or prevent oscillation.

The same relative arrangement is used by the respondents. Thus Beetem says, in relation to respondents' trucks (Record p. 103):

> "The arrangement of the car supporting springs is such that the weight of the *car body* is *first* supported upon four elliptic springs which are rigidly secured between the top and bottom, and carry the greater part of the *weight of the car body*. The spirals, which are weaker, carry the remainder of the load."

And the same thing is shown in a later Peckham patent, 563,685 (to be referred to below), which *covers the precise structure of the respondents' trucks complained of*. The specification of that patent states, at page 3, line 31:

> "I overcome serious objections heretofore encountered when making use of elliptical springs in truck structures, as I am enabled to bring the weight of the *car body* more directly upon the *elliptical springs* than upon said *spiral springs*."

The Court below found that the mode of operation of the respondents' trucks was the same. We quote the language of its opinion:

> "In the car trucks of the defendant both sets of springs are brought into action and begin to compress simultaneously *when the weight upon them is greater than the normal weight of the car*."

The sole function of the combined spirals and elliptics of the patent is not to lessen end galloping; *primarily springs are intended to sustain the car*. The end galloping admittedly takes place only under *unusual* conditions. Therefore, it is

not true, that the elliptics come under compression only when the car is galloping. Obviously they come under compression *when the car is placed on the truck* and under *further* compression when the car is loaded. The specification shows this. It recites that long cars had then come in vogue, that is, cars carrying a heavier load than formerly. Of course this load would be too heavy for the spiral springs of the capacity of the old spirals put under the short cars built for comparatively small loads. Besides this, the specification states that in one adaption of the invention, the spirals were to be made even weaker than they had been when used in all-spiral, extended spring-base trucks. Clearly, therefore, the intent of the inventor was that the spirals should sooner compress and sooner bring the weight down on the elliptic springs.

In the respondents' truck structure it is said that the elliptics are the master car springs and that they are supplemented by the spirals; but in both structures all the springs are operative and at work *when the car and truck are at work.* In both structures all the springs are compressed relatively at the same time, when the car body is on the truck. Both have the same mode of operation and both are efficient in their operation for the checking of oscillation.

In the truck of the patent in suit there is a *certain* subsequent compression of the elliptics; but this is merely a *suitable relative arrangement* or graduation of springs. It is clearly the subsequent compression idea covered by the second group of claims (9, 10, 11 and 14).

It will appear later that Claim 9 covers the subsequent compression of *either* set of springs and Claim 10 refers to the subsequent compression of the *end springs*, thus covering all classes of respondents' trucks. Both of these claims were sustained by Judge Shipman. And it will be observed that the respondents' trucks are *all* covered by the terms of Claims 1 and 2, because they *all* have elliptical springs on *extensions of the side beams* (Livermore, Record p. 71).

THE LANGUAGE OF THE BRILL PATENT. IT DOES NOT IMPOSE ANY LIMITATION UPON THE BROAD CLAIMS 1 AND 2.

The Court below held that the language of the patent is such that Claims 1 and 2 must be limited to an arrangement of springs in which the elliptical springs are not "brought into play until the spiral springs have been compressed by the weight of the car body *and the added load*, 'until the weight of the load on the axle-box springs begins to depress said springs abnormally.'"

We submit that placing this limitation upon these broad claims is entirely erroneous for the following reasons:

1. Brill *really invented* the *broad combination* of spiral and elliptical springs and stationary and movable frames in their patented relation, without regard to the *minor* element of subsequent spring compression. This is shown:

(*a*) By the position of his invention in the art. There is no real pretence of any pertinent patent but Peckham, 419,876, and, as will be shown more fully hereafter, that patent is entitled to no more consideration here than Judge Shipman gave it in the *Third Avenue* case. It did not disclose the *combination* of Claims 1 and 2 of the Brill patent *nor their separate elements*. It was not a *practical* device and taught nothing to the art and was never put into use. And *all* the earlier devices, many in number, were useless to remedy oscillation and pounding, but as soon as the Brill device was brought out, all other trucks were rejected and the Brill device was "universally adopted." The Peckham Company, probably about 1892, began to sell the truck complained of, and they advertise that up to 1900 they had sold 10,000 of them. (Record p. 89.) A historical discussion of the place in the art of this patent to Peckham 419,876 will be found below at page 80.

(*b*) Judge Shipman, after an arduous contest and full hearing in the *Third Avenue* case, sustained the broad construction of Claims 1 and 2. He says:

> "The only remaining question is that of patentable novelty. It has already appeared that the *gist of the invention* is described in Claims 1 and 2. The necessity for a remedy against the pounding of the car, the importance of the result, the adoption of the invention by experienced railway superintendents, the number of previous attempts at a remedy and the barrenness of their results go far to show that the work of an inventive mind was required and was active in the invention. The testimony of the defendant's expert itself, as he goes through the history of the art and thereby points out what the patentee's combination did, as compared with previous efforts to do something, *shows that the patented improvement was patentable.*"

2. The patentee having *made the broad invention* of the use of elliptical springs (of slower action and different periodicity) combined with quick-acting spiral springs, *in the patented relation*, described one method of applying the invention and *claimed* it *broadly* in Claims 1 and 2, and claimed it *with the modification of subsequent spring compression*, in Claims 9, 10, 11 and 14.

3. Even if we admit (which we do not) that Claims 1 and 2 are to be limited to *some degree* of subsequent spring compression, then we point out (1) that Brill is entitled at least to the credit of being the first to have made the *combination* of movable and stationary frames and spiral and elliptical springs in which *either* the spiral or elliptical springs are first compressed; and (2) that the Court below *finds* that respondents' trucks *have* the element of subsequent compression of one set of springs. It cannot be argued that it makes any difference which set of springs are the last to compress. Claims 9 and 10 expressly negative this. Claim 9 refers to

the subsequent compression of *some* of the springs without specifying which, and Claim 10 refers to the subsequent compression of the *end* springs. In view of these claims and of the primacy and importance in the art of the Brill invention —"universally adopted"—it would seem a hardship to permit the respondents to appropriate it and go free by merely reversing the order in which their springs act. There is no evidence that, *in practice*, it makes any difference which set of springs compress subsequently. The theory of the patent being the *breaking of rhythm* (as Judge Shipman found), there *can* be no difference in that respect. Claims 9 and 10 were fully sustained by Judge Shipman.

Infringement of other claims, and especially of Claims 9 and 10, can be shown at final hearing. As said above, Claims 9 and 10 relate to subsequent compression as between two sets of springs, but without specifying that it is the spiral springs which are compressed before the ellipticals. Either set may be compressed after the other. Claim 9 states that *some* of the springs are compressed subsequently to other springs, which applies to all three of respondents' classes of trucks. Claim 10 specifies that the *end* springs are compressed subsequently to the other springs, which applies to their "Standard" and "Extra Long" trucks, on their own showing and as found by the Court below in these words:

> "In the car trucks of the defendants, both sets of springs are brought into action, and *begin* to compress *simultaneously* when the weight upon them is greater than the normal weight of the car."

Obviously, this is equivalent to stating that one set of respondents' springs takes the entire weight up to a point, and, after that, the other set begins to compress—which is subsequent compression of one set.

And while the respondents *allege* that their elliptical springs are stronger than their spiral springs and *call* them their *main* car springs, yet they did not offer to show *how much* stronger

they are, and it is obvious that the four elliptical springs on one of their so-called "Extra Long" trucks *cannot* be stronger, in the sense of load-supporting ability, than the twelve spiral springs on the same structure.

It should be observed that *all* the respondents' trucks have spiral springs between their saddles, or adjacent to the saddles, and their movable frames and that all their elliptical springs rest on the *extension* of their stationary frames.

4. The *drawings* of the patent show a structure in which the elliptics are brought into action subsequently to the *initial* compression of the spirals. But this is not the feature of the invention to which the respondents seek to limit Claims 1 and 2. This subsequent bringing into action of the elliptics is a feature which is incidental only to the *placing of the car body on the truck.* The moment the car body *is in place*, *all the springs* (elliptics and spirals) *are in action*, and *thereafter* are simultaneously compressed in the practical work of the truck, when sustaining either the weight of the car alone or that of the car and a load of passengers.

In Fig. 1 is shown a space between the top of the elliptic and the under surface of the coacting shoe. This space there *appears* larger than it actually is in that drawing. This arises from the fact that the draftsman has erroneously connected the *flanges* of the cap 45 by a dotted line, whereas the dotted line *should have been much lower*—about even with the *bottom of the nuts* connecting the flanges of the cap 45 with the ends 20 of the top chord.

This can be demonstrated by Fig. 2, which shows the same space, its *under* surface being indicated by a heavy black line at the *bottom* of the nuts which secure the flanges of the cap to the top chord. If the dotted line in Fig. 1 were correctly drawn, it would extend from the bottom of the nuts in that figure, thus indicating a much *smaller space* between the top of the spring and the under part of the caps than Fig. 1 would seem now to indicate.

By accurate measurement of this space in Fig. 1 with a scale graduated to 1-32 of an inch, and assuming that the wheel base is 7 feet, this space is shown to be .807 of an inch. On the assumption of a 6½-foot wheel base, it is .75 of an inch. (That these lengths constitute the usual wheel base, see Record pp. 141, 160.) These statements are amply supported by the Third Avenue Record, where at p. 340 of Complainant's Proof is shown a photograph of the first truck built (1891) by the Brill Company. The space between the elliptic and the cap is here shown, and is shown to be very slight; also, this photograph explains the error just pointed out in the dotted line of Fig. 1. At pages 155, 156 of the same record, Mr. Adams identified the photograph and testified that it "represents a truck of precisely the same kind as in Fig. 1 of the patent in suit." The attention of the Court is asked to the exact accordance of Figs. 1 and 2 of the drawings of the patent in suit (as to the parts now under consideration) with the truck of this photograph, except as to the erroneous dotted line in Fig. 1, above referred to.

The spaces between the coils of the spiral springs in the drawing are at least as thick as the coils. In the drawing there are eight or more coils to each of the spirals. The capacity of settlement of the spiral springs is equal to the distance between the coils multiplied by the number of coils. Certainly this compression may run up to 3¾ or 4 inches, as is the practice.

It will be remembered also that the patent states (p. 1, l. 100) that an "adaptation of my invention consists in making the axle-box springs [25] *comparatively weaker and slower* than has formerly been done." Therefore the heavier car body, weighing from 6,000 to 7,000 pounds, more quickly brings the weight down to the elliptics, after closing to about one-fourth of their possible movement, thus placing the car weight on the elliptics and slightly compressing them. There will then be left more than half of the residue of movement in the springs to take care of added passenger load

and other conditions such as *initial* or *partially acquired oscillation*, *unequal loading* of the car platforms, etc. The matter of relative action or movement of the springs was a matter of "graduation," of the capacity of resistance of the two kinds of springs, as Mr. G. M. Brill testified in the Third Avenue case (p. 143).

> "The spiral spring in our tests has proven that it works considerably quicker and has a longer throw to it of movement than an elliptic, consequently we, in practice, will allow the spiral spring at a certain winding to compass [compress] to a certain load and at that certain load we make the elliptic spring to come into action."

Mr. Fagan, Superintendent of Motive Power of a large Traction company, testified in that case (p. 126) that in the Brill trucks used by his company the elliptical springs were in contact with the car body when the latter were mounted on the truck; that the weight of the car body on the truck rested in part on the elliptical springs when the car body was not in motion, and that the same condition existed "when there are no passengers in the car."

Mr. Adams, truck designer and draftsman of the J. G. Brill Co. testified in the Third Avenue Case (p. 155 of Complete Rec.) that Fig. 1 of the patent in suit represented a truck "without the weight of the car body thereon," and that "when a car body is applied to the truck the spiral springs settle and allow the elliptic springs to take a portion of the weight of the body," meaning, he said, "the empty car body."

There can be no doubt that if a copy of the patent in suit were given a competent truck builder, "skilled in the art," with no other instruction than the patent itself affords, he would build a truck in which by "graduating" the springs so that the spirals are "weaker and slower" than they were formerly made, all the springs would come into bearing merely by adding the weight of the car thereto.

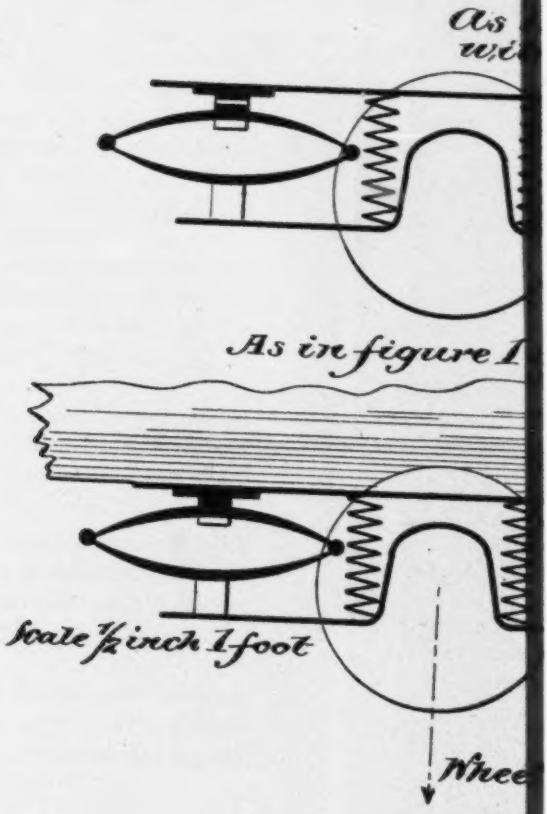
The annexed illustrative drawing is made in conformity with Figs. 1 and 2 of the patent in suit and is of the same relative size as the drawings in a printed Patent Office copy of the patent. It shows the space between the top of the elliptic and the cap in accordance with Fig. 2 of the patent drawing. The lower figure in this sketch indicates the same truck with the car body in place, and the spirals and elliptics under compression as they would be *when the weight of the car body* is placed on them. Of course this fraction of an inch of compression does not exhaust the capacity o the springs for further compression. Obviously, considerable additional spring capacity remains to sustain the added weight of passengers and to allow for movements of the car body when in motion. In this capacity for further spring resistance, the elliptical springs work simultaneously with the spirals.

We submit that the limitations on the broad Claims 1 and 2 which the Court below imposed are not warranted by anything in the patent. We shall again refer to the language of the Court below on the subject.

The opinion of the Court below sustains our position fully when it says of the claims of the patent (p. 154):

> "They were obviously framed to cover any possible theory of the invention which is hinted at in the specification, and which the exigencies of an infringement action may require."

We submit that we come within the rule of *Winans* vs. *Denmead*, 15 How. 330, where it was held that the "patentee, having described his invention, and shown its principles, and claimed it in that form which most perfectly embodies it, is, in contemplation of law, deemed to claim every form in which his invention may be copied, unless he manifests an intention to disclaim some of those forms."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Scale 1/2 inch 1 foot
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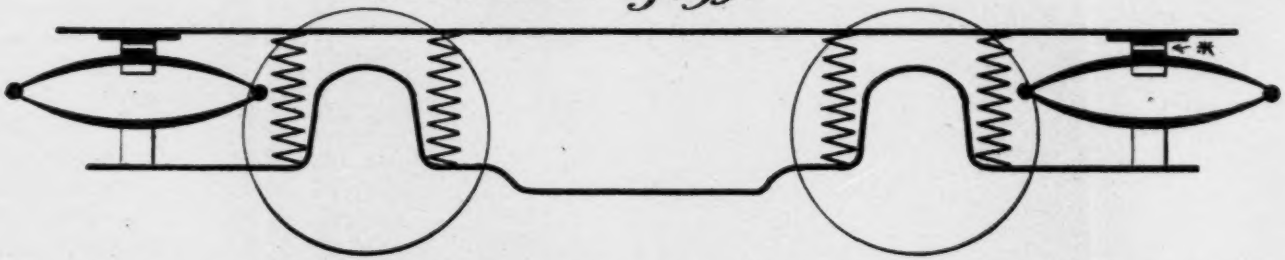
As in figure 1 of patent in suit, with car body off.



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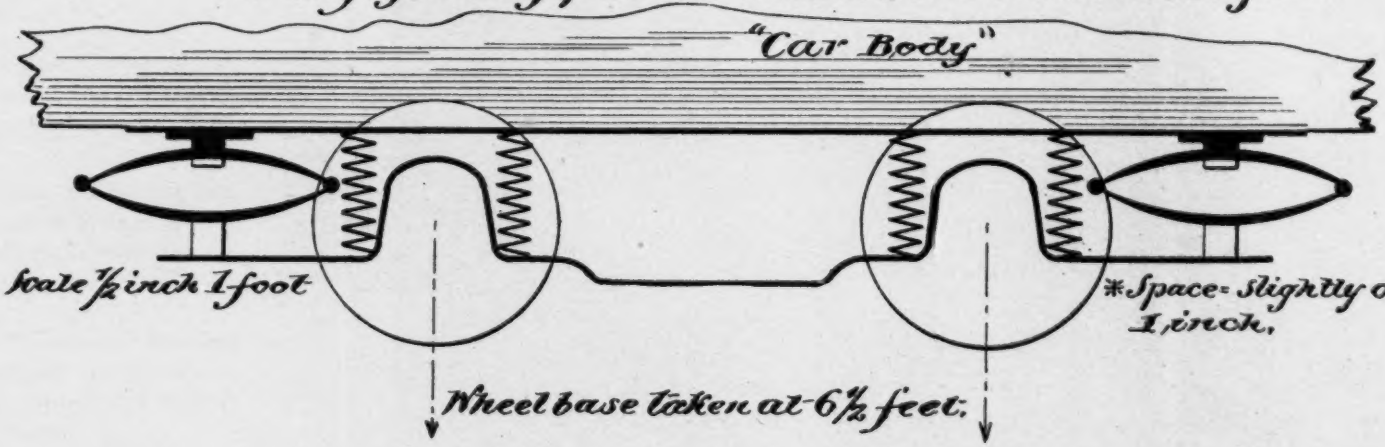

THE RESPONDENTS' STRUCTURES INFRINGE.

We come now to infringement. There is no dispute as to the actual construction of the respondents' trucks. They manufacture three kinds, differing slightly, and designate them as "Excelsior," "Standard" and "Extra Long." The Record shows them at page 45, which is a photograph of one of the respondents' advertisements. They are also shown somewhat more in detail in two drawings at p. 64. There are also two drawings representing "Excelsior" and "Extra Long" trucks at page 69. That the respondent corporation has manufactured and sold a very large number (10,000) of all these three kinds of trucks is not disputed.

It has been freely *admitted by respondents' counsel throughout the case* that "*if either of respondents' trucks infringe, all do.*" Therefore, the only question that need be considered is whether the respondents' **"Excelsior"** truck (p. 45) infringes upon Claims 1 and 2.

An inspection shows that the "Excelsior" truck in the first of these drawings is covered by Claims 1 and 2 as they read and as interpreted in the adjudication of Judge Shipman. He says (Record p. 141):

> "The *gist* of the invention consisted in combining with the frames of the truck and the spiral springs another class of springs, viz., elliptical springs, between the car body and the extensions of the independent frame."

The "Excelsior" truck, as they all do, certainly combines "with the frames of the truck and the spiral springs another class of springs, viz., elliptical springs, between the car body and the extensions of the independent frame."

Judge Lacombe so held (Record p. 135).

> ". . . . but the combination which Judge Shipman described as the gist of the invention is undoubtedly in defendants' structure, and under well-settled rules of

practice complainant is entitled to a restraining order until final hearing."

Mr. Livermore, in his affidavit, after observing that the "Excelsior" "has the springs in the same arrangement as shown in the drawings of the Brill patent" and describing the variation in the relative position of the springs in the "Standard" and "Extra Long," proceeds to say (pp. 114 to 116):

"It is to be observed that in Claim 1, the specific arrangement of the spiral springs (*i. e.*, their location or distribution along the space between the independent and movable frames) is not specifically referred to. Furthermore, the *specific arrangement or distribution* of the spiral springs shown in the drawings of the Brill patent is *not essential* to the proper coaction between the spiral springs and the elliptical springs for attaining the desired result of neutralizing the tendency to oscillation and therefore preventing the car from acquiring an excessive longitudinal oscillation or rocking or galloping movement. Clearly, therefore, the Peckham trucks embody the substance of the Brill invention and are literally covered by the language of Claim 1 of the Brill patent.

"In Claim 2, the spiral springs are referred to as located between the saddles and movable frames. The saddles and stationary frame constitute substantially a single rigid structural element, *and it is immaterial whether the springs rest directly upon the saddles or upon the frame adjacent to the saddles.* It is only necessary that they should be distributed *sufficiently lengthwise* of the independent frame and car body to form an efficient and stable support for the car body. For this reason, I regard the arrangement embodied in the Peckham 'Standard' and 'Extra Long' trucks, in which the inner spiral springs are arranged on the independent frame close beside, instead of directly upon, the axle-box saddles, and the outer

spiral springs are arranged at the extreme ends of the independent frame, as being a substantial equivalent for the arrangement recited in Claim 2, so far as the following elements, viz., spring supporting frame supported upon the running gear by saddles, and the movable frame, and interposed spiral springs,—are concerned, and said Peckham trucks clearly contain these elements in combination with the elliptical springs, which *combination* is the characteristic or novel feature of the Brill truck.

"It is clear that both the Peckham 'Standard' and 'Extra Long' trucks have elliptic springs, combined with the spiral supporting springs, and arranged as shown in the Brill patent over the end extensions of the independent frame, and thus near the ends of the car body, where they will be effective in checking the rocking movement of the car body. It seems obvious that there is no reason for adopting the elliptical springs in these Peckham trucks other than in order that they may cooperate with the spiral springs in order to prevent excessive endwise oscillation or galloping movement of the car body, the same as is done by the like combinations of elliptical and spiral springs in the specific arrangement shown in the drawings of the Brill patent."

The petitioners produce the evidence of three experienced street railway men who state that the method of operation of the respondents' trucks is the same as that of the patent in suit in breaking up rhythm and thereby lessening oscillation. Thus Fagan testifies (Record p. 50):

"I believe that the combination of spiral and elliptic springs on the extended spring base of the Peckham 'Standard' and 'Extra Long' types of trucks, operates in the same way as they do when they are combined and arranged as on the Peckham 'Excelsior' trucks and on the Brill 'No. 13,' [the truck of the patent in suit] and,

in use, have the same or a similar effect in preventing or lessening the galloping motion of the car."

Littell testifies (Record p. 53):

"I am familiar with the four-wheel electric car trucks that have been manufactured by the Peckham Motor Truck & Wheel Company, of Kingston, New York, for some years past, and known in the trade as 'Excelsior,' 'Standard,' and 'Extra Long.' In my opinion, the operation of the said combination of elliptic and spiral springs as arranged on the 'Standard' and the 'Extra Long' trucks is the same as that of the combination of elliptic and spiral springs as arranged on the 'Excelsior' and on the Brill 'No. 13' truck. The combination of elliptics and spirals in all four of said constructions to break up the rhythm or period of the oscillation of the car bodies when in motion and thereby lessens or prevents the galloping or rocking motion of the car."

Akarman testifies (Record p. 56):

"A combination of elliptic and spiral springs arranged as on said 'Standard' and 'Extra Long,' trucks operates in the same way as the combination thereof arranged as in said 'Excelsior' truck and in Brill 'No. 13,' (the truck of the Brill patent in suit), in my opinion. In all four trucks the rhythm is broken up, and the result is that the rocking or galloping motion is done away with."

Even with a Limitation placed upon Claims 1 and 2, the Respondents infringe.

Again, admitting (which we do not) that the Court below is, in part, correct in limiting Claims 1 and 2 to an arrangement having some degree of subsequent compression of one set of springs, the respondents' trucks have *in fact* the element

of subsequent spring compression, and infringe upon those claims as so limited. The argument will be in part a repetition of what precedes.

The opinion of the Court below specifically finds that the respondents' trucks have this element of subsequent spring compression (p. 150).

By placing its finding side by side with the following language of the specification, it appears that the degree of subsequency found by the Court in the respondents' trucks is even greater than that disclosed in the specification.

The respondents' truck as described by the Court below:

"In the car trucks of the defendant both sets of springs are *brought into action and* **begin to compress simultaneously** when the weight upon them is *greater* than the *normal weight of the car.*"

The language of the specification:

"I supplement the axle-box springs by placing elliptical springs . . . and so arrange them in respect to each other that the elliptical springs *will not come into play* until after the axle-box springs have **begun to compress.**"

"The spiral springs . . . normally take the *weight of the car.*"

The respondents' elliptical springs, therefore, as found by the Court below, must support *at least* the weight of the car before *any weight* comes on their spiral springs, and this is certainly equivalent to stating that there *is* subsequent compression of the spiral springs in their trucks.

Just *how heavy* the load must be *before* both sets of springs thus cooperate, either in the respondents' truck or in the truck of the patent, it is, of course, impossible to specify, and the patent in suit does not attempt to specify. In two places

(p. 1, l. 73; p. 2, l. 3) that patent speaks in a general way of the "abnormal depression" of the spiral springs, but this phrase clearly has no *definite* significance. It would seem, however, to correspond in its scope to the language just quoted from the opinion of the Court below in which reference is made to the "normal weight of the car" in connection with respondents' trucks. The fact is that in both respondents' trucks and the truck of the patent, one set of springs first comes into action, and thereafter both sets co-operate to sustain the load and to lessen the objectionable oscillation. The *exact relative adjustment* as between the two sets of springs *is a matter for the practical spring maker* or car builder who *regulates* it to produce an *easy-riding* car under varying conditions of load.

Observe that by merely tightening the nuts 24, 27 (Fig. 1 of the patent in suit), all the springs will at once be brought in contact with the upper chord.

But we submit that "*abnormally*" in the patent is not to be given any *controlling* weight, for this reason:

On p. 2, l. 126, the patent states: "The elliptical springs will not come into play until after the axle-box springs *have* BEGUN to compress." This language is quite distinct from "abnormal compression" used in the earlier part of the patent and indicates about the same degree of subsequent compression as the Court below finds in respondents' trucks. Why should the Court below rely upon the words "abnormal compression" to strike down the patent while giving no weight to the equally important language just quoted, which clearly shows that the patentee did not attach any special importance to the words "abnormal depression" used in another part of the specification? This subject will be again referred to at p. 100.

If it be argued that the subsequent compression referred to in the patent in suit must relate to the elliptical springs, it is a sufficient reply to say that Claims 9 and 10 both relate to successive compression as between two sets of springs, but without specifying which set of springs are to be compressed

first and which class compressed last. Rhythm of oscillation is equally broken in either case, and that is the distinctive method of operation of the Brill invention.

It is wholly unimportant *in pratice* and immaterial to the present issue whether it is the elliptical springs or the spiral springs that mainly support the car with a light load, and, conversely, which class are subsequently compressed. In fact, we do not understand that anyone has alleged that there is any difference in practice in this respect.

We add that in respondents' "Extra Long" truck, which has *twelve* spiral springs and only *four* elliptic springs, the *twelve spiral* springs are *necessarily the main car springs* and the four elliptic springs must necessarily be subsidiary springs, supplementing the spiral springs and acting by subsequent spring compression, and the same is true of their other forms of trucks which have eight spirals and four elliptical springs each.

The petitioners averred in their petition that they expected to be able to prove, from published statements of the Peckham Company (and they would have proved this on the motion for a preliminary injunction, if it had not been unnecessary under what was understood to be the established practice of the Court below in such cases), that the spiral springs of the respondents' trucks are *in fact* their *main* car-supporting springs, and that they do in fact support the greater part of the weight of the car body and its load, and consequently that the respondents' elliptical springs are those which come under subsequent compression "when the weight upon them is greater than the normal weight of the car" (Judge Wallace's opinion). The *four* elliptical springs on the "Extra Long" truck certainly cannot be stronger than its *twelve* spirals. It is well known and is recognized in practice that spiral springs more quickly respond to changes in the load and are therefore more desirable as the *master* springs.

THE ALLEGED PRIOR ART SET UP BY RESPONDENTS.

The respondents rely upon and the Court below refers to only two patents.

1. Manier, No 409,993, granted August 27, 1889.
2. Peckham, No. 419,876, granted January 21, 1890.

With regard to both of these it is to be observed:

1. That both patents were fully fought over in the *Third Avenue case;* both were fully considered by the experts therein; and Judge Shipman held that neither anticipated in or imposed any limitation upon the claims of the patent in suit.

2. That both of these patents were cited as references in the Patent Office on the application for the patent in suit, and both were withdrawn by the Patent Office, as not affecting Claims 1 and 2 of the patent in suit, which were allowed by the Patent Office precisely as filed in the original application. This appears by the Record in the Third Avenue case before the Court.

It will be shown in a later part of this Brief that the complete conception of the invention by the patentee, Mr. G. M. Brill, antedated the date of issue of both of these patents, the facts as to which the petitioners claim a right to establish by proofs for final hearing.

We may here state, by way of preface, that counsel for respondents, referring to these two patents in his brief of argument in the Court below, expressly admitted that the overcoming of oscillation "*by so combining elliptical and spiral springs in a car truck that the rhythm of the one should overcome that of the other, is not foreshadowed in any way in either the Manier or Peckham patents.*"

The Manier Patent.

The Manier patent is not, as counsel for the respondents has frequently stated, for a *combination* of spiral and elliptical springs. One of the drawings shows spiral springs only and the other shows elliptical springs only. The Court below states that "this patent shows every element of the first claim of the patent in suit broadly considered, *except the conjoint* use of spiral and elliptical springs." The exception is *vital* and removes this patent from the need of further consideration. The learned Court below finds that Manier "does not show the combination of the second claim." During the hearing below, the presiding judge of the Court below, after an inspection of this patent, stated to counsel, in effect, that he did not consider it as of any relevancy in the case.

Judge Shipman pointed out that Manier's only thought was the "mounting of the body springs *forward* of the axles," and that "the springs, or the kind of springs, which he was to use are *no part* of his invention." Judge Shipman further said:

> "Manier's invention was entirely apart from that of Brill, and had no conception of its character. . . . Manier's invention was not designed, nor adapted, nor used for the performance of the function performed by Brill's device, nor was the way to accomplish Brill's result suggested by Manier's invention (*Topliff* vs. *Topliff*, *145 U. S. 156*)."

Manier was one of the entirely unsuccessful attempts made in the early days of electric street railway propulsion to remedy the pressing evil of oscillation. Of these attempts Akarman speaks in his affidavit on behalf of the petitioners and his statement was not disputed. He says (p. 55):

> "This type of truck [the Brill truck] has gone into universal use under four-wheel cars, and has substantially,

if not completely, displaced all other constructions of single trucks."

The learned Court below now nowhere points out the extent to which it considers that the Manier patent imposes any limitation upon the broad invention of Claims 1 and 2. It need not be further considered.

The Peckham Patent, 419,876.

In restricting Claims 1 and 2 to a narrower scope than their terms import and than the original invention of the patentee and than that given to these claims by Judge Shipman, the opinion of the Court below relies solely upon the Peckham patent, 419,876.

It must be borne in mind that every presumption is against this Peckham patent disclosing a structure having the same mode of operation as the Brill combination of springs, for it appears that Peckham, in all his three types of trucks here complained of as infringements (Record p. 45), combines with the spiral springs full elliptical springs, *located between the extended sections of the sides of the upper chords* and *of the side beams, precisely as Brill did*, and *has not used* the transverse semi-elliptical springs of this 419,876 patent, nor its type of *truck frame*.

In fact, this Peckham patent is a mere paper patent. Neither Mr. Peckham in his affidavit describing various forms of car trucks used by his companies from 1888, nor any other of respondents' witnesses, suggests that a single truck of the construction shown in this Peckham patent has ever been manufactured or sold by Mr. Peckham or either of the Peckham companies, *or used by any street railway company*. In fact, as is shown by the Record (p. 56), the Peckham Company continued up to 1895 to advertise car trucks supported by sets of *spiral* springs only; and it was after the issue of the Brill patent and the wide adoption of the Brill invention,

that the Peckham Company began the use of its infringing constructions, and Peckham applied in 1894 and in 1895 for two patents, Nos. 555,530 and 563,685 (now before the court), which show the combination of spirals and full elliptics on the side beams, here complained of as infringements.

Fagan, Littell and Akarman in this Record, all men of wide experience in this business, describe a number of trucks which had been used in this art since its infancy, but they do not include the truck of 419,876 among them, though they clearly mean to describe all the various methods of spring construction which had been adopted prior to 1890-91 and found to be failures.

Judge Shipman held in the *Third Avenue* case, in the most emphatic language, that the Peckham patent was irrelevant because the construction "*has not the conjoint action of the patented combination, nor does it perform the function of the Brill device ;*" and pointed out that defendants' expert in that case had not *referred* to this patent in his direct examination as one of the "*best anticipations.*"

The Peckham patent, 419,876 (Figs. 4 and 5), *is radically different from that used by Brill and from the respondents' infringing truck, not so much because* it has *a semi-elliptical* spring, as because there are no elliptical or semi-elliptical springs *located between the extended sections of the upper chord and the side beams* to support the car body at *each of its four corners ;* on the contrary, each of the two semi-elliptical springs is carried across the truck transversely, so that it comes into contact at its middle point with a supplementary transverse truss at the front or rear of the car body, and its ends *play loosely* in shoes on the lower beams.

And these beams are *loosely* hung from the axle boxes, and have themselves both *transverse and longitudinal pivotal motion.* The corners of the car have no support, and the pivoted, loosely moving side beams furnish no substantial and stationary support for the semi-elliptic springs, nor any of the

car springs, which is an *essential requirement* of the Brill patent in suit.

It has spiral springs grouped about the wheels, *i. e.*, not far from the middle of the truck, measured lengthwise. Under each end of the car it has a single point of support on the longitudinal *centre line* of the truck. Obviously, a car body with its overhanging platforms loaded with passengers and running at speed would acquire an irregular oscillating movement, by reason of the absence of support at the four *corners* of the car platforms which would be most objectionable to the passengers, and which, by reason of its torsional nature, would be destructive to the car and truck parts themselves. It would set up rather than lessen oscillation.

For these reasons the Peckham device was *not a truck capable of use.*

Again, as showing that the truck structure of this Peckham patent, 419,876, was not considered a practical truck, even by the inventor, or by the Peckham Company, it appears that the application for these letters patent was filed September 2, 1889, but that in October, 1889, Peckham and his then Peckham Street Car Wheel & Axle Company, of which he was president, was advertising, "an improved truck for street cars" which was stated by him or by the Company in that advertisement to be "an admirable solution of the problem" of how "to prevent rocking or oscillation" of cars. A cut of this "improved truck for street cars" is shown in the present Record at p. 40 (Exhibit A). It is *not* the truck of patent 419,876, but is a truck having all spiral springs and having the *frame of the patent in suit.* The advertisement (printed at p. 32 of this Record) proceeds to state in regard to this "improved truck": "This arrangement, as will at once be seen, must entirely prevent any rocking motion and the car ought to ride as smoothly as any steam railway passenger coach on its double trucks." The truck *had no elliptic or semi-elliptic springs* and its springs were *at the corners.*

As said before, nowhere in respondents' affidavits is reference made to this Peckham patent, 419,876, as a practical or operative device. Certainly, Peckham would have sworn that it was an operative truck and had been used, if such had been the case.

It is most significant, too, that this Peckham device was gotten up by one who, at the time, was a truck builder, and who, therefore, must have endeavored to put it on the market, and who would have done so if it had been *capable of practical use*, especially at a time when the street car companies were *all looking anxiously for a truck* with which they could run their cars at the required speed.

It is also very significant that 15 days after he applied for patent 419,876, he applied for a patent (419,877) in which he entirely abandoned the mode of construction of his patent 419,876 and directed his efforts in an entirely different line of construction, along which latter line, as shown by his patents, he subsequently worked.

Patent 419,876 states that *spiral* springs may be used on the extended side beams, or that a *transverse* semi-elliptic spring may be used. Figure 1 shows *spiral* springs on the extended side beams. This construction differs entirely from that shown in 419,877, which *latter* construction was at once *advertised* (October, 1889) as "Peckham's Non-oscillating Motor Truck" (see Exhibit A, p. 40 of Record), and with slight changes, and with *all spirals*, continued to be advertised by Peckham till 1895 (Curwen, p. 56, 57 of Record). Obviously, therefore, the *transverse* half-elliptic spring of 419,876, was a mere suggestion, of no value and never put in actual practice.

And the affidavit of S. M. Curwen (at page 56) shows that in June, 1890, the Peckham Company advertised trucks with six spiral springs on each side and warranted them "to prevent oscillation," and continued to advertise them up to October, 1895. This is the necessary inference from Mr. Curwen's affidavit, which is not denied in any of the respondents' affidavits. And Peckham's patent, 563,685, applied for March 12,

1894, issued July 7, 1896, shows further the abandonment of the device of 419,876.

The Court below, in considering the Peckham patent 419,876 as imposing a limitation upon Claims 1 and 2 of the patent in suit, quotes, in its opinion, the words of the Brill patent (p. 1, lines 66-69), "*between the extended sections of the upper chord and the side beams* I place elliptical springs, which *preferably* extend *longitudinally* of the truck;" and, we submit, misinterprets that language. For that Court deduces from this passage the conclusion that "the circumstance that the semi-elliptical springs of the Peckham patent extend *transversely* instead of *longitudinally* is, therefore, immaterial." But the *point* of this passage in the patent is that the *four elliptical springs support the four corners of the car*, and, to effect this result, are placed "between the *extended sections* of the upper chord and the side beams." *In this location* each of the four springs may extend either *longitudinally* or *transversely*, although obviously, the longitudinal is the preferable position, as the patentee says. But Peckham's semi-elliptical springs are not between *the longitudinal extensions of the upper chords and the side beams at all;* each is between the two side beams and a transverse truss, and, therefore, each of the four corners of the car is left without any proper support, a construction which would be wholly inoperative in practical use. Judge Shipman had this distinction in mind when he states of the Peckham patent:

> "The upper beams are supported on *spiral* springs on *the axle boxes.*"

The distinction is not, as the Court below seems to suppose, *in which direction* the elliptical springs extend, but *where they are located.*

This matter of the *location* of the elliptical springs is mentioned over and over again in the Brill specification. For example, page 2, line 122:

"By placing elliptical springs of slower action *between the extended portions* or sections of the side beams and upper chord."

Line 130:

"The devices which secure the elliptical springs *between the side beams and the upper chord.*"

Page 3, line 26:

"The [elliptical] springs are *rigidly secured to the side beams.*"

Line 71:

"A portion of this action would be taken on the springs *supported on the ends of the side beams.*"

We may add that the *means disclosed* in the patent in suit for connecting the top of the elliptical springs with the upper frame or chord *would not permit of the transverse* disposition of the elliptical springs. "Preferably," therefore, as used in the passage cited, is mere surplusage.

There is *a vital difference* between the location of the petitioners' and respondents' elliptical springs, on the one hand, and the location of the semi-elliptical spring of the Peckham patent on the other. Not only had Peckham in his patent *no notion of the utility* of combining elliptical and spiral springs (as is evident both from the language of this patent and from his own subsequent conduct and patents, as we shall show more fully hereafter), but the construction shown by him in figures 4 and 5 of this patent was *not practical* even for the purposes of its intentional construction.

We deem it necessary, at the risk of some repetition, to set out in detail some further, and as we believe, pertinent, considerations as to this subject.

We will consider this Peckham patent,

A. As to its frame.
B. As to its springs.

A. *The frame of the Peckham patent. It is not the frame of the patent in suit.*

The construction of the Peckham frame is entirely antagonistic to the purposes and functions of the "side beams" or stationary frame of the Brill patent in suit. It is a distinct departure from the line of development disclosed in that patent.

In the Peckham patent *all of the car-supporting springs* are supported upon parts which are both *transversely* and *longitudinally movable* with relation to the axle boxes and car body. In the patent in suit the car-supporting springs are *supported* upon a *stationary truck frame or side beams.* This is a fundamental difference, both in construction and in function.

The spring-supporting frame of the Peckham patent 419,876 is a movable frame, so intended and so constructed. There are no saddles forming part of a stationary frame which is, as the patent in suit says, "not affected by the movement of the car body to any appreciable extent . . ." The frame, indicated generally by the letter A^1 throughout the drawings of the Peckham patent, is designed to have a longitudinal and transverse swing relatively *to everything that is above it.* Fig. 3 of the patent shows the so-called saddles as separate pieces S S apparently pivotally supported on the axle boxes by a *round bolt.* These so-called saddle pieces have ears and pendant portions which support a pin which pivots a hanger *e* thereto. A pin *d* passes through the lower end of the hanger parallel with the axle and pivotally supports a strap *h* which is *pivotally connected* to the beam A^1. This construction permits of a lateral swing of the so-called saddles S S on the axle boxes; a further swing laterally of the hanger *e* from the lower end of the saddles; a *longitudinal swing* of the straps *h* on the pin *d* at lower end of the hangers *e;* and a longitudinal swing of the beams A^1 on the straps *h*. The lower ends of the straps *h* are rounded to provide a *rocking surface* for the beams A thereon.

The construction at the right hand of Fig. 4 of the Peckham patent involves the lateral swing of the saddles S and beams A^1 from the top of the axle boxes and an independent longitudinal swing of the beams A^1 from the bottom of the saddles.

It, is therefore, manifest that the beams A^1 are intended to have both a lateral and longitudinal swing. The frame would be entirely impracticable for reasons hereinafter set forth.

The opinion of the Court below, referring to this Peckham patent, states that: "It also shows saddles mounted like those of Brill upon the axle boxes." But this is erroneous. The so-called saddles S S are not saddles in the sense of the patent in suit. They are not rigidly connected to the beams A^1. These so-called saddles S S are not the saddles of either the Brill patent in suit or of the respondents' trucks. (And we may add that they are not the saddles (the equivalent of the Brill saddles) shown in all of the Peckham patents subsequent to the one now under consideration).

In the form shown at the left hand of Fig. 4, the spiral springs are not equivalent to the axle box or car-supporting spiral springs of Brill. The springs (left hand, Fig. 4) take the place of mere rubber cushions 5^1 of the patent in suit.

In the *operation* of the Peckham truck, not only would the springs t (Fig. 1) or the so-called semi-elliptic springs t^1 (Fig. 4) be subjected to torsional strain, which they are not intended to bear, but the strains of the motor propulsion of the car would come upon the spring posts and springs t (in Fig. 1) or upon the outer ends of the transverse so-called semi-elliptical springs t^1 (in Fig. 4). At the same time, a like abnormal strain, although to a less extent, would be imposed upon the springs C and their posts which pass through the ears of the saddles S. Such a construction would, in use, be absolutely impracticable and dangerous.

The transverse swing of the beams A^1 also either puts a stress on the springs t^1 in the direction of their length or

moves the beams against the friction of their sliding ends, thereby producing unusual strains.

From any point of view, the beams A[1] and the saddles supported on the axle boxes, as well as the springs which they each support, are at all times intentionally subjected to the stress of propulsion and to the horizontal surging of the car body either longitudinally or transversely.

Clearly this Peckham patent does not involve or disclose in any way the *frame construction* recited in Claims 1 and 2 of the patent in suit.

Furthermore, this Record shows that the respondents, immediately after an application was filed for a patent on this truck (September 2, 1889; executed August 24, 1889), *adopted an entirely different truck structure*, and continued to use the latter form from that time until the present. Thus, in the advertisement of the Peckham Company in the Street Railway Journal, October, *1889* (Record, p. 40), is shown an entirely different frame, *i. e.*, one having *all* of the characteristics of the *stationary frame or "side beams" of the Brill patent in suit* (except that it is *rigid* on the axle boxes, metal to metal, without an intervening rubber or other cushion). And this different stationary frame ("side beams") is found in *every Peckham patent* granted upon an application filed subsequent to September 2, 1889, beginning with patent 419,877, filed September 17, 1889, and ending with his patent 599,474, application filed April 6, 1897 (making twelve patents in addition to the two previously mentioned), and we find it also *in the three forms of respondents' trucks complained of* (*see Record, p. 45*). *In all of these, the Brill form of stationary or independent frame or "side beams" is present and the transversely and longitudinally swinging frame of the Peckham patent 419,876 is absent.*

This clearly indicates *an acknowledgment of the entire impracticability of the movable spring-supporting frame shown*

in Peckham 419,876. Its entire rejection by the Peckham Company seems to admit its lack of structural and functional identity with the frame which is an element of the combination in Claims 1 and 2 of the Brill patent in suit, and which has been "universally adopted" in the trade.

B. *The spring system of Peckham patent 419,876. It does not disclose any suggestion of the spring combination of the patent in suit, nor its mode of operation, nor any construction which will secure the results of that combination.*

Claims 1 and 2 of the Brill patent in suit recite the spring combination substantially as follows:

Claim 1: "*Spiral springs* located between the *movable and stationary* frames, and elliptical springs located between the *extended sections* of the *said rigid frame*, substantially as described."

Claim 2: "*Spiral* springs located between the *saddles* and *movable* frame, and *elliptical springs* located between the *spring-supporting frame* and the *movable* frame, substantially as described."

We have just shown that the Peckham 419,876 patent does not show a *stationary spring-supporting frame and* springs of any kind *extending between that frame and the movable frame.* It will now be shown that it never recognized any virtue *of one kind of a spring over the other and never appreciated* that the inharmonious rhythms of *different kinds of springs* could be employed advantageously. The patent did *not even employ the so-called semi-elliptic spring in such a way as to obtain the advantage of its peculiar characteristics in the combination.* Certainly the patent does not disclose the Brill combination. The arrangement of the spring t^1 is transverse *and it bears only at one point, centrally of the*

car body. If Peckham had desired to *avail himself* of the characteristics and virtues of *the leaf spring*, as Brill has taught the art, he would have *disposed it longitudinally of the truck between the extensions* of the beams A^1 and the beams A, *one at each corner*, as he did the spring t (Fig. 1).

The fact must not be lost sight of that in this patent the beams A^1 A^1 are positively and *intentionally constructed with a view* to providing both a *longitudinal and transverse* swing, and that such longitudinal and transverse swing of the beams is *claimed as a feature of construction in this patent.* (See Claims 5, 6, 7 and 8 especially). Thus it is clear that strains foreign to those for which the semi-elliptic springs are designed to bear are imposed upon their ends. While this is going on (and possibly one of the beams A^1 working in opposite direction to the other, or both in the same direction), the ends of the springs are subjected to torsional strains which impair their action even as leaf springs.

Furthermore, in the Peckham patent, the *spiral springs* in Figs. 4 and 5 are not between *the stationary or independent spring-supporting frame* and the car body, but are placed *between the axle boxes and the car body.* This is obviously true in respect to the left hand of Fig. 4, and as to the construction at the right hand, the so-called saddles are no more than ears movably secured upon the axle boxes instead of being integral therewith, as was a well-known form of construction.

Again the semi-elliptic spring t^1 of the Peckham patent 419,876 *slides in shoes* on the beams A^1. This produces friction between the ends of the springs and the shoes on which the ends rest, in addition to the friction of the leaves of the spring itself, thereby differing essentially even from a full elliptic spring placed in the same position. The greatest resistance to pressure of the semi-elliptic spring is at the middle, where it is thickest, and the least resistance is at its end, where it is thinnest. At its ends, therefore, arranged as in the Peckham patent, it does not co-operate with the other car springs as it would if it were arranged longitudinally

in line with the other car springs. Further, by placing the full elliptic springs *on the side frames in line with the car spirals, the full power and strength and all of the characteristics of a complete leaf spring* are utilized to act in concert with the other springs. No such action could be possible with the semi-elliptic spring as arranged in the Peckham patent.

This truck, so far as relates to the combination of springs shown in Figs. 4 and 5, tends first to invite and then to increase rather than decrease or obviate longitudinal oscillation or galloping. It is a step backward in the art and in practical efficiency even from the end spiral form shown in the other figures of the same patent.

The Court below, in this connection, quotes a statement made by complainants' expert (in the *Third Avenue case*) to the effect that the construction shown in this patent "embodying the semi-elliptic springs would measurably attain the result that is attained by the conjoint use of the spiral and elliptical springs as embodied in the Brill truck, and that a car having the truck structure shown in Figs. 4 and 5 of this Peckham patent would be less liable to excessive longitudinal oscillation than any of the trucks of the prior art *heretofore* considered."

Now, it is clear that the complainants' expert here fell into the error of merely considering *the presence of semi-elliptic springs* in the Peckham structure without investigation as *to the effects of their position and their action in the structure in which they are shown.*

Instead of being "less liable to excessive longitudinal oscillation than any of the trucks of the prior art heretofore considered," as complainant's expert stated, the exact contrary is true. *The fact is that, as these semi-elliptical springs are employed, they set up and promote oscillation.* The reason is plain :

It must be understood that the forces which tend to cause the car to oscillate or gallop on the track are mainly irregularities in the track or roadbed. These irregularities do not occur simultaneously on *both sides of the track*. Where there is a loose rail joint, it is only on one rail (the rail joints being staggered); where there is an obstruction, as a stone or the like, it is on one rail; where there is a depression, it is not usually on both rails. In other words, the causes which initiate oscillation operate through the wheels *on one side* of the truck and thence upwardly *on that side* to the car body, affecting the truck frame and springs in its upward course. It is clear, therefore, that a car body which *is balanced at its centre line upon two springs*, which are weakest at their ends where they rest upon the truck frame, will not only *permit* a vertical vibration of the spiral car-supporting springs set up by any cause, *but will aid in its continuance*. The obstruction impacts upon one or the other of the wheels, lifting them violently, and compressing the spiral springs, which may either lift one end of the car body on an even plane or tilt it over to one side, and thereby set up either transverse oscillation or a longitudinal oscillation, or a compound of both of these, viz.: a diagonal swaying of the car.

It is clear, therefore, that what complainant's expert inadvertently found in patent 419,876 (that it would "measurably" attain the result of lessening oscillation) does not, in fact, exist.

If so, why did not some one build such a truck at that early period in the art when oscillation was considered in the trade a most serious evil, and when the trade and the truck builders were looking eagerly for a truck which *would lessen* it? The fact that no one ever appears to have done so and that, as we shall now show, even *Peckham himself rejected it* in all his subsequent patents and advertisements and in his practice, seems clearly to lead to the conclusion that instead of "measurably" preventing oscillation of the car body on the truck (whether transverse or longitudinal or diagonal) it was adapted to set it up and

continue it. Undoubtedly it was the appreciation of this fact that forced Mr. Peckham to discard altogether this method of construction.

That he did discard it is shown:

From the 17th of September, 1889, when Mr. Peckham filed his application for patent No. 419,877, up to the 11th of June, 1895, at which time he applied for his patent No. 555,530 (between which dates he had applied for and obtained at least ten patents), and even to the last of his patents, No. 599,474, applied for April 6, 1897, *not a single, one of his trucks had a car-supporting spring located between the side frames of the truck so as to bear on the car body centrally.* On the contrary, *every one* has the springs *ranged in longitudinal alignment on the side frames from end to end, the four corners of the truck being provided with springs to support the car body at each side over the side frames.*

And it is also shown that the art rejected the frame and spring system of this patent. All the patents in this case, both of the prior art and those subsequent to Brill's invention, with but two possible exceptions, *have disposed their car-supporting, oscillation-preventing springs on the extensions of the truck frames, all longitudinally in alignment.* That is, as to the end springs, they extend between the extensions of the truck frame directly upward to the extensions of the movable frame or car body, thereby supporting the car body *upon the four corners of the truck and at the sides of the truck.*

The two exceptions are Figs. 4 and 5 of the Peckham patent under consideration and the patent (referred to in the respondents' answer) to Taylor, No. 437,167, dated September 23, 1890, in which an elliptic spring is disposed centrally of the truck, by way of a vague and immaterial modification. But even in this Taylor patent *all* of the springs, which are *full elliptic springs* (eight altogether), *are disposed close to the side frames of the truck throughout.*

It appears, therefore, that Peckham 419,876 stands *alone* in the art as employing a leaf spring with a *bearing at its middle point upon the centre line of the car*, and *with its ends* (*the weakest part of the spring*) *bearing on the side frames.*

These matters are here considered merely in their historical aspect; the question of how much of the Brill invention Mr. Peckham would have made had he ranged the semi-elliptic springs, two at each end, on the frame extension and longitudinally, is not under discussion. Whether or not Peckham appreciated the invention of the Brill patent *in any aspect*, and provided means for accomplishing its results, is, considered historically, and not conjecturally, the question under discussion.

It is, therefore, clear that if viewed historically, Mr. Peckham, in this patent, never contemplated the conjoint action of the springs of the Brill patent, no matter how they are viewed, nor did he provide a combination of elements which even suggest the coactive relationship and the result-producing characteristics of the Brill combination. His structure shows nothing which could even be *modified* so as to meet the combination of the Brill claims.

And he could not (then nor until years thereafter) have appreciated that there was any difference in the conconjoint action of *leaf and spiral springs over and above the use of all spiral springs*, because he employs the leaf spring in this *truck manifestly in a way that completely* negatives any characteristic of the leaf spring being used in a coactive combination with spiral springs, at least for the purposes of the Brill invention.

Respondents urged, in discussing the Peckham patent 419,876 in their brief in opposing the application for the writ, of *certiorari* that the fact

> "That the combination of the patent in suit supports the corners of the car better than does that of this Peck-

ham patent, would seem to be quite immaterial. The question is not whether this Peckham patent anticipates the patent in suit, but whether it limits *by showing the combination of elliptic and spiral springs in a car truck to overcome galloping.* The drawing and specifications of this Peckham patent show and describe this combination, and the specification states explicitly it is for that very purpose."

To this we reply that the truck of the Peckham patent (Figures 4 and 5) does not show such a combination nor does it support the car *at* the corners at all.

This is *material*, since, with the *corner* support, the car is *properly supported;* and without it, as we show above, the car is *invited* to oscillate. It is quite *material*, since no one prior to this Peckham patent, nor since it, even including Peckham, ever supported the car body *except at the corners.*

This Peckham patent does not show "the combination *of elliptic and spiral springs*" *at all*, nor any *arrangement, disposition*, or *suggestion of the same.* Its "drawings and specifications" in no way *suggest the same.* They certainly do not "show and describe the combination."

The respondents' brief below says, as to the Peckham patent: "How could the Court decide otherwise than that this Peckham patent precluded any broad subsequent claims for this combination, and limited the complainants to their own construction."

The Court below does not hold that the patented combination is present in the Peckham patent; it holds that that patent points the way to substitute elliptics for "so-called semi-elliptic" springs, which substitution it holds, while producing "an improved result," does not produce "a new result."

Therefore, if it is *material* that the *corners* of the car body be supported, then this Peckham patent clearly fails to show the embodiment of any feature of the Brill invention.

Respondents in their brief opposing the application for the writ also say, referring to p. 1, that—

> "The specifications of the Patent-in-Suit, however, make it quite immaterial whether the axle-box frame is *rigidly or flexibly supported from the saddles or pedestals.*"

Counsel apparently did not understand this point, or he would not have made such a statement. The specification says nothing about "rigidly or flexibly" supporting the "axle-box frame," (stationary frame or side beams) from "the saddles or pedestals." The "saddles 6, 7" are not termed "pedestals." The *saddles are secured rigidly* to the bars 12, 13, 14, which compose the "side beams."

As Judge Shipman said (p. 237):

> "In the patented structure a pair of *rigid* longitudinal side beams, which derive their support from the axle-boxes, extend lengthwise of the truck beyond the wheels at each end."

On the other hand, the Peckham patent shows the side beams *pivotally* connected with the axle-boxes, so as to be able to swing back and forth transversely and longitudinally—a perfectly useless construction, which has never been practically used.

The only motion of the side beams or saddles in Brill is on the *rubber cushion* 5[1] or with the axles when they thrust. In this is the clear distinction (elsewhere more fully developed) between the *movable spring supporting frame of the Peckham patent and the "rigid or stationary frame" of the Brill patent in suit.*

This shows how respondents' counsel has fallen into error, and how his conclusions, therefore, do not apply and why the Court below was in error in finding in Peckham even the frame of the patent in suit or of respondents' truck.

Judge Shipman disposed of this patent by saying (p. 143):

> "This construction, although it contains the name semi-elliptic spring, has not the conjoint action of the

patented combination, nor does it perform the function of the Brill device."

All these considerations show why the Peckham patent was *rejected* by Judge Shipman after the fullest consideration, as not anticipating or imposing any limitation upon Claims 1 and 2; why it was *rejected* by the Patent Office in reference to these two claims: why it was *rejected* by the defendants' expert witness in the *Third Avenue* case, who *did not even refer to it in his examination-in-chief;* why the able and experienced counsel for the defendant in that case relied upon it but slightly in their printed argument; why Mr. Abbott, the respondents' expert witness in this case, barely refers to it in his affidavit; and why the counsel for the respondents in this case have paid slight attention to it in their arguments in the various stages of this case. The Court below, itself, for the first time in the history of the case, gave any real force to this patent. The real defence by counsel in this case has not rested upon this Peckham patent, but upon the contention that oscillation in the respondents' trucks is overcome by the *tension spring* which the respondents use in their trucks, and that they use elliptical springs, not because they are useful to overcome oscillation (for which purpose they say they are a "*positive detriment*" to their trucks), but because they serve as braces to prevent the horizontal movement of the car body on the truck.

Again, suppose even that the patentee, G. M. Brill, in conducting his experiments in 1889 (as all the street railway world were) towards a successful electric truck, had himself designed the truck of the Peckham patent, 419,876, and that it turned out a complete failure, was refused by the trade and was thrown aside (which was the fate of the Peckham device). Certainly such a failure would not invalidate a patent for a successful truck which he afterwards invented, which the trade immediately and *universally adopted*, and for which he applied for and received the protection of the patent laws.

Clearly, such a case would fall within the remark of Mr. Justice Brown in the Barbed Wire case: "In the law of patents, *it is the last step that wins.*"

When, in 1889, Mr. Peckham and Mr. Brill and the hundred other expert minds were struggling to devise a truck which would meet the vital requirements of the business, Mr. Peckham hit upon the device of the Peckham patent, 419,876, and obtained a patent for it. He does not appear to have sold a single truck of this construction. It was not only an entire failure, but it is shown to be *incapable* of practical use. He appears not even to have advertised it, because at that very time he was advertising another type of truck, which he said "successfully solved the problem of oscillation." On the other hand, Mr. Brill, in 1889 (as his affidavit shows), devised his truck and afterwards patented it, and it met with immediate and universal acceptance upon its introduction in January, 1891. Mr. Peckham and his companies then began to sell infringing trucks. When sued for infringement he assumes the position that his device of 1889, useless and never used, places such a limitation upon the *successful* invention of Mr. Brill that he is free to infringe upon the Brill patent in suit. Such a position does not commend itself.

It will be observed that the Peckham Company, respondent, does not justify its trucks under any of its patents. The reason is clear. Its own patents, as we shall show below, completely refute its contention of non-patentability and non-infringement of the patent in suit.

History of the Development of the Truck Art as Shown by a Consideration of the Various Letters Patent in Evidence and those set up in the Answer to the Bill of Complaint in this Case.

We shall now point out that the truck of the Peckham patent 419,876, which was clearly not a practical truck, and is shown to have been entirely rejected in the trade, was an

experiment along lines peculiar to that structure; that no other truck structure was ever developed along the same lines; that its lines are essentially different in construction from all the other trucks, and that the successful line of development which has been accepted by the trade leads, through many experiments and partial successes, directly to the truck of the patent in suit. The *only* non-pivotal street-railway motor-truck in use now and for years past is, and has long been, as much a *standard type* as is, and has been for thirty years or more, the well-known "Master Car Builders' Truck" universally used in steam railroad practice.

The subject will be considered by a reference to the various letters patent in evidence and those set up by the respondents in the answer to the bill of complaint (Record pp. 8, 10, 11). The latter may be considered here for that reason. Or, if not, then, if they furnish persuasive evidence as to the patentability of the subject-matter of the broad Claims 1 and 2 of the patent in suit, the petitioners will claim the right to show the matters now to be referred to at final hearing.

It will not be denied that there is *but one type of non-pivotal truck in general use on electric street railways to-day*, and that this type alone has been *exclusively* used for many years. The *truck frame* structure of this type (apart from the car-supporting spring system) is the truck structure disclosed in Brill patent 432,115 (application filed April 27, 1889, prior to the application for Peckham patent 419,876). Its structure is described in the patent in suit, and is as follows:

Pedestals (or yokes or saddles) C are supported on the axle boxes, and the ends of these pedestals are united by low-hung beams D thus forming a strong, substantial and *stationary* frame for the support of the car-spring system. The pedestals are made (component or [Fig. 9] integral) parts of that frame. The frame maintains the parallelism of the axles. In addition, the frame comprises spring-posts (F), which pass through the pedestals up to the car body; these posts serves to keep the car body on this stationary truck frame and to pre-

vent its horizontal displacement thereon. These posts thus also act as pedestals. These stationary side beams may be transversely connected together, thus uniting the side beams into a rigid, rectangular frame. This frame is a stationary or independent frame, for, though it may have cushions (c^2) between it and the axle boxes, it is not subject to the motion of the car body on the car springs to any *appreciable* extent.

It forms a stationary foundation for the car-spring system. This is obviously the truck construction of the patent in suit and of all the respondents' trucks.

Considered without regard to the greater or less extension of the stationary side beams (the extensions are made in order to provide a more extended spring support or "base" for an increased length of car body), the above-described truck frame structure is, and has for years been, the only truck frame structure in use. There may be differences in details of construction, but the fundamental principle has long been universally used in the trade.

It can further be stated that there is not now in use, and has not been for years, a non-pivotal street car truck in which the car-supporting spring system has not consisted of a *combination* of *spiral* and *elliptic* springs, supported on *stationary side beams* or frames of the kind just described, with the elliptic springs arranged or disposed in *line with the other car springs*, and extending *longitudinally* along the *extensions* of the side beams, the *end springs* being at the *four corners* of the truck.

It is a sufficient warrant for the accuracy of these statements to say that the Brill truck of the patent in suit, the respondents' three trucks, and the Bemis trucks in the Third Avenue case all fall within this universally accepted type of truck. The affidavits of Fagan, Littell, Akarman and J. A. and G. M. Brill as to the universal adoption of such a type of truck fully support the above statements, and this is not disputed by respondents, but is supported by their affidavits.

It may be further stated, without the possibility of denial, that all types of non-pivotal trucks *not* embodying these two features of stationary side beams and combined spiral and elliptic springs so disposed and supported, have been failures, and have either never gone into use, or, if used, have long since been totally rejected by the trade.

We shall now show:

(1.) That every patent set up in the Answer and all the *early Peckham* patents, *except 419,876*, uniformly developed their respective structures along the lines of the above described type of truck frame. By "early Peckham patents" we mean all of his patents (except 419,876) applied for up to the time when Peckham first disclosed, in a patent, the combined spiral and elliptic springs of the trucks here complained of.

(2.) That all of the patents referred to in (1) disclosed various car-supporting spring systems resting upon stationary side beams, some having *all spiral* springs and some having *all elliptics*, but none of them having *combined* spiral and elliptic springs, with the elliptic springs disposed longitudinally on the extensions of the stationary side beams.

(3.) That the patent in suit was *the first* to disclose combined spiral and elliptic springs, the latter longitudinally disposed on the extensions of the stationary side beams or frames.

(4.) That the Peckham patent, 419,876, was a development along a *peculiar and entirely distinct line*, that it has no *stationary* side beams, and, of course, no combination of spiral and longitudinally disposed elliptic springs, the latter mounted on extensions of such side beams, and that it differs in these respects from every other truck disclosed in the art as shown by the patents referred to in (1).

The patents referred to in (1) may be grouped as follows. We repeat that all of them disclose stationary side beams or frames. *The dates given are application dates.*

The following show truck structures having stationary side beams or frames of the kind above described, but having the

various kinds of car-supporting spring systems which will be mentioned in connection with each.

I. Patents showing all spirals, with spiral end springs at the four corners of truck:

a. Patents set up in the Answer:

J. A. Brill 373,640, February 23, 1887.
Manier 409,993, June 21, 1889.
J. A. Brill 418,441, April 27, 1889.
Hubbard 457,740, February 25, 1890.
Bird 436,031, May 16, 1890.
Bickford 450,608, November 25, 1890.
Robinson 451,952, December 27, 1890.
W. S. G. Baker 460,348, June 2, 1891.

b. Peckham patents:

Peckham 419,877, September 17, 1889.
(This truck is shown in Exhibit A., Record p. 40.)
Peckham 419,878, September 17, 1889.
Peckham 424,723, December 7, 1889.
Peckham 440,189, May 29, 1890.
Peckham 458,749, October 30, 1890.
Peckham 464,253, October 30, 1890.
Peckham 467,896, October 30, 1890.
Peckham 471,061, October 30, 1890.
Peckham 555,526, August 18, 1891.

II. Patents showing the *alternative* use of *either* all-spiral *or* all-elliptic springs on extensions of the side frames; or located *both* intermediate of, and on, extensions of the side frames.

John A. Brill, 373,640, June 23, 1887.
Manier, 409,993, June 21, 1889.

III. *Patents showing the use of all elliptics:*

Taylor, 437,167, June 25, 1890.

In all of the foregoing, the end car-supporting springs were disposed *longitudinally* in line with the other springs on the stationary side frames, and at the *four corners* of the truck.

This review of the patents in the art shows:

(1.) That while many inventors tried to develop a non-oscillating truck, they all failed, and that Brill alone succeeded in the development of a *type* of truck, which was thenceforth adopted, to the substantial exclusion of all other non-pivotal street car trucks.

(2.) That the Peckham Patent, 419,876, was entirely out of touch with the art as it developed, and taught nothing.

We submit that it cannot and should not be given any effect as limiting the scope of the Brill invention, which was a development of the art along totally distinct and *successful* lines.

It will be interesting to note that it was not till March 12, 1894, years after the introduction and general adoption of the truck of the patent in suit, that Peckham fell into line with the settled development of the art and filed *his first application* disclosing a combination of *spiral* and longitudinally extending *elliptic* springs, the latter supported on the extensions of the stationary side beams. His development along this line appears in the following patents. (The dates are application dates):

Peckham 563,685, March 12, 1894.

(This shows the precise structure of two of respondents' trucks complained of—"Standard" and "Extra Long.")

Peckham 555,530, June 11, 1895.

(This shows the precise structure of respondents' third truck complained of—the "Excelsior.")

Peckham 560,816, February 29, 1896.

Peckham 599,474, April 6, 1897.

If his patent 419,876 taught anything, or even suggested anything to this art (or any form, embodiment or manner of use of the combination of elements recited in Brill Claims in suit 1 and 2), how can he explain the fact that it took Mr. Peck-

ham, a truck builder, years to reach the form of truck complained of, and that in the interval between September 2, 1889, and March 12, 1894, he (with all the others in the art, except G. M. Brill) went off and worked on lines subsequently abondoned by everyone and never afterwards reverted to?

It may be interesting to note how close even John A. Brill came to the invention of the patent in suit without grasping it. His patent 373,640 (application filed February 23, 1887), discloses a form of *stationary* frame having *extensions* beyond the axle boxes, with springs supported *on* the extensions at the *corners* of the frame for the prevention of oscillation. In that patent he discloses the *alternative* use of *either* spiral *or* elliptic springs (just as in the Manier patent 409,993). His patent 432,115 (application filed April 27, 1889, just before G. M. Brill disclosed to him [May, 1889], in definite form his invention, the truck of the patent in suit), shows the stationary side beams above referred to. But neither of these trucks met the needs of the trade or sufficiently prevented oscillation. He just missed the successful truck which did fully solve the problem and did meet all the requirements of the trade.

But further, even when in May, 1889, the patentee, G. M. Brill, disclosed his invention to J. A. Brill, the latter was even then unable to grasp the fact that the patentee had reached the "last step" in the broad development of the art and produced a structure which was to supplant all other structures in the trade. Thus he states (Record p. 34):

> "Although I fully understood the said invention as explained and illustrated [May, 1889] to me by G. M. Brill, *I did not appreciate its great value* nor recognize that it would be the best and most practicable and the *only possible solution of the problem* of the prevention of oscillation in the operation of four-wheel electric cars."

These considerations must have been in the mind of Judge Shipman when he said (Record p. 144):

> "The only remaining question is that of *patentable novelty*. It has already appeared that the gist of the invention is described in Claims 1 and 2. The necessity for a remedy against the pounding of the car, the importance of the result, the adoption of the invention by experienced railway superintendents, *the number of previous attempts at a remedy and the barrenness of their results go far to show that the work of an inventive mind was required and was active in the invention.* The testimony of the *defendants' expert itself*, as he goes through the history of the art and thereby points out what the patentee's combination did, as compared with previous efforts to do something, *shows that the patented improvement was patentable.*"

We submit that this historical view of the art is most persuasive as establishing the patentable novelty of the patent in suit. Courts have always found great difficulty in applying the *conjectural* method to the ascertainment of what is patentable invention. Probably this method is one which can never be satisfactorily applied, least of all in this case. We believe that the *historical* method will be found to furnish a better and surer means of deciding this question. Where, historically considered, an art has developed along divergent lines, one line ending in success and the other in failure, it is fair to say that the line which ended in failure may ordinarily be disregarded and consideration given only to those steps which led along the lines of successful development. The historical method is particularly applicable in cases like the present, where the art was an important one, affecting large interests, and one on which many active and trained minds were hard at work to solve the problems. To an unusual degree one invention was successful and was *universally* adopted, while all the other attempted solutions of the problem were failures and were all rejected.

And, after all, the historical method of investigation is merely another name for the well-established rule that evidence that a patented device has gone into general use is persuasive evidence of the exercise of patentable invention and in cases of doubt is "sufficient to turn the scale" (*Smith* vs. *Goodyear Dental Vul. Co.*, 93 U. S. 495).

A truck patent is a difficult one to deal with on theory alone. Trucks are used under very exacting conditions. They must sustain a weight of many tons (perhaps 10 to 15); they must be run at a rate of 20 or 30 miles an hour; they must carry a heavy motor, and, with all this, they must be so constructed that they furnish an easy-riding car for passengers. The problem of patentable invention, in relation to such a structure as this, is not an easy one for a court to solve. It may perhaps be well left to those skilled in the art and to the practical experience of trained men, acting in the line of their business and enlightened self-interest. What the art, in the opinion of such men, required; what they devised to meet its requirements, patented and introduced and tried practically and then rejected; and, finally, what they accepted and universally adopted as fully meeting the requirements of the art—facts of this kind ordinarily afford a safe guide in solving the difficult problem of patentable invention.

In this connection we cite a few of the cases on "*Taking the Market*" as evidence of patentable novelty.

AUTHORITIES ON TAKING THE MARKET AS PERSUASIVE ON THE QUESTION OF PATENTABLE NOVELTY.

It would be difficult to imagine a case in which evidence that a patented device has "taken the market" would be *more* persuasive than the present case. There are but few truck builders in the United States. They build trucks only on *orders* from the railroad companies. Their customers

are comparatively few. Each customer, about to equip a street railway, necessarily makes a careful and thorough investigation of the merits of the different trucks in the market. He is an intelligent and usually a trained man, spending large sums and taking action the effect of which will last for years, for profit or loss, on his road. To take that market is an unusual proof of merit.

In *Smith* vs. *Goodyear Dental Vul. Co.*, 93 U. S. 495, it was said:

> "Undoubtedly, the results or consequences of a process or manufacture may in some cases be regarded as of importance when the inquiry is, whether the process or manufacture exhibits invention, thought and ingenuity. Webster, on the subject-matter of patents, page 30, says: 'The utility of the change, *as ascertained by its consequences, is the real practical test of the sufficiency of an invention.* . . . Where the utility is proved to exist in any degree, a sufficiency of invention to support the patent must be presumed.' We do not say the single fact that a device has gone into general use, and has displaced other devices which had previously been employed for analagous uses, establishes in all cases that the latter device involves a patentable invention. It may, however, always be considered; and, when the other facts in the case leave the question in doubt, *it is sufficient to turn the scale.*"

Keystone Manfg. Co. vs. *Adams*, 151 U. S. 139.

> "While it is true that the mere fact that a device has gone into general use, and has displaced other devices which had previously been employed for analogous uses, does not establish, in all cases, that the later device involves invention within the meaning of the patent laws,

yet such fact is always of importance, and is entitled to weight, when the question is whether the machine exhibits patentable invention (*Smith* vs. *Goodyear*, 93 U. S. 486, 495)."

In view of the extensive use of the invention covered by the patent in suit, in *Topliff* vs. *Topliff*, 145 U. S. 156, Mr. Justice Brown, said:

"While the question of patentable novelty in this device is by no means free from doubt, we are inclined, in view of the *extensive use* to which these springs have been put by *manufacturers of wagons*, to resolve that doubt in favor of the patentees, and *sustain the patent*."

It was in evidence in *The Barbed Wire Patent*, 143 U. S. 275, that the patented fence wire did not radically differ from other fence wires that were old; but it was apparent, also, that the improvement covered by the patent in suit made the barbed wire fence a practical and commercial success. It was also shown that the sales were very large, and that the device immediately met with favor. Mr. Justice Brown said:

"Under such circumstances courts have not been reluctant to sustain a patent to the man who has taken the final step which has turned a failure into a success."

ERRONEOUS CONCLUSIONS IN THE OPINION OF THE COURT BELOW.

1. The Court below erred in holding that Claims 1 and 2, broadly construed, do not involve patentable invention.

The Court below, after considering the Manier and Peckham (419,876) patents, and only those, says (Rec. p. 152):

"It thus appears that it was old in the prior art to employ for the purpose of obviating the oscillation of the

car body all the parts enumerated in the first and second claims except the two kinds of springs in the same car truck, and that the only novelty in the inventions of those claims, details of construction being disregarded, consists in the *substitution of both spiral and elliptical* in the place of either spiral or elliptical springs. Indeed, the inventions are wanting even in this *measure of novelty*, and reside merely in the substitution of elliptical for the semi-elliptical end springs. The claims are *not limited to longitudinal end springs*, as the specification points out they are only preferably employed; and the circumstance that the semi-elliptic springs of the Peckham patent extend transversely instead of longitudinally is therefore immaterial.

"It is manifest that the inventions secured by the claims are of a very narrow character, and that they cannot receive the broad construction which their language would authorize without affirming their invalidity for want of patentable novelty. It would be merely an *aggregation* of old parts to supplement the spiral springs by the elliptic springs, or the elliptic spring by the spiral springs, and would not involve invention, unless some new mode of operation due to the conjoint action of the two kinds of springs should result from doing so. It is asserted that a new result is obtained by the conjoint use of the two kinds of springs in that it breaks the rhythm of the impulses imparted by each kind and thereby decreases the amplitude of the oscillation of the car. But when it is shown that the *substitution* merely consisted in employing elliptic springs in conjunction with the spiral springs, instead of semi-elliptic springs in conjunction with such springs, and that this substitution produces merely an improved and not a new result, the structural changes in form and arrangement which may be discovered in the specification afford the only features of novelty which can support the claims."

We will consider in detail the various positions here taken by the learned Court, though repeating in part matters already considered above :

A. The Court below said :

" . . . the inventions . . . reside merely in the substitution of elliptical for the semi-elliptical end springs."

We submit that this is erroneous.

Merely to displace the semi-elliptic spring of the Peckham patent and substitute a full elliptic spring—placing it in the same place, may or may not have produced an *improvement* in the *result* of the operation of this *new* combination, but such result, although new in that truck, would not be a *new result*, since the result would only be due to the difference in operation of the elliptic over the semi-elliptic, and this could have reasonably been anticipated.

This would be the *net result* of the *mere* substitution of ellipties for the semi-ellipties in the Peckham patent.

This in no way even remotely approximates the invention of Claims 1 and 2, either as to the combination of elements therein recited, or their respective mode of operation, and the the results produced thereby.

If this language of the opinion below means that Brill merely "substituted" a full elliptical spring in the Peckham patent, obviously the full elliptical spring thus "substituted" must be put in the place of the semi-elliptic, *i. e.*, transversely across the end of the truck supporting the car body along the centre line of the truck. But this would not produce the Brill non-oscillating truck. It would be no better than the Peckham truck with its semi-elliptic spring. Like that truck, it would rather stimulate and increase oscillation than lessen it. The vertical lines of disturbance in running a truck are at the sides—over the rails—and arise from "low" rail joints, obstacles on the rails, etc. A support on the centre line of the truck (especially with a load of passengers on the overhanging platforms), would promote a rolling or rocking motion. Only when the

springs of the Brill combination are disposed in line with the expected plane of disturbance and at the corners of the truck, can oscillation be properly controlled or kept within proper limits. And, besides, it would not have the very important feature of the increase of the spring base (to the extent of nearly half the length of the full elliptic spring) by the use of a full elliptic spring *longitudinally* disposed. And this substituted structure would also lack the stationary and movable frames of the claims in suit. All these considerations have been fully pointed out elsewhere in this brief.

The Court below, in order to reach even (what we consider) the erroneous position here referred to, was obliged to "disregard details of construction." but these are necessary elements of the invention. We do not claim a mere combination of spirals and elliptics, but we claim such a combination in connection with the other structural details of the claims, *i. e.*, the stationary and movable frames and the springs disposed thereon as recited in the claims.

B. Again, consider the next position taken by the Court below in the passage first above quoted:

> "The claims are *not limited to longitudinal end springs*, as the specification points out they are only preferably employed; and the circumstance that the semi-elliptic springs of the Peckham patent extend transversely instead of longitudinally is therefore immaterial."

This also, we submit, embodies an erroneous view of the structure of the patent in suit as we show elsewhere. The Brill end springs are supported on *extensions* of the side beams and *between* them and the movable frames. That is, *they support the car at its four corners.* Whereas, in the truck of the Peckham patent, the end springs support the car on the centre line, and leave its corners unsupported and liable to all kinds of plunging or swaying motions. True that in the Brill truck, the end springs are stated by the specification to be only *preferably* placed in a *longitudinal* direction, but

whether placed longitudinally or transversely, they must, clearly be placed so as to *support the car at its corners*, which the Peckham semi-elliptic springs do not.

C. The next position taken by the Court below is:

"It would be merely an *aggregation* of old parts to supplement the spiral springs by the elliptic springs, or the elliptic spring by the spiral springs, and would not involve invention unless some new mode of operation due to the conjoint action of the two kinds of springs should result from doing so. It is asserted that a new result is obtained by the conjoint use of the two kinds of springs in that it breaks the rhythm of the impulses imparted by each kind and thereby decreases the amplitude of the oscillation of the car. But when it is shown that the *substitution* merely consisted in employing elliptic springs in conjunction with the spiral springs, instead of semi-elliptic springs in conjunction with such springs, and that this substitution produces merely an improved and not a new result, the structural changes in form and arrangement which may be discovered in the specification afford the only features of novelty which can support the claims."

We reply to this:

1. The *combination of elements* recited in the claims is admittedly new in the art.

2. The combination of Claims 1 and 2 cannot "be merely an *aggregation* of old parts," since the Court below admits that it involves an *improved result;* whereas, an aggregation, in the sense of the patent law, means the mere bringing together of old elements in such a way that they do not coact to alter or improve the operation of the new arrangement. That there is a mutual contribution of each element of Claims 1 and 2 to produce a new mode of operation, a new result, and an improved truck has been sufficiently established.

3. It is not correct to say that the patent merely *substituted* a full elliptic spring for half elliptics. On the contrary, it is fully shown that neither semi-elliptics nor full elliptics *combined with spiral springs* had ever before been used together in combination with the stationary and movable frames of Claims 1 and 2, and disposed as therein specified.

4. The result was a new type of truck; a *more efficient structure* for the lessening of oscillation, which solved a serious problem in the art and took the market, almost to the exclusion of all earlier devices. We submit that this constituted a *new result*, the result of the new combination of elements and sufficient to sustain a patent therefor.

D. The quotation from the expert in the Opinion (Record p. 152) should not have the significance apparently attached to it by the Court below.

This, be it observed, is *not* a quotation from anything *said in this present case* by the petitioners' expert witness. The reference which he makes *in this case* to Peckham 419,876 is at page 77 of this Record, in which he refers to this patent only by quoting the words with which Judge Shipman, in the *Third Avenue case*, had disposed of it as of no importance. When the expert, in testifying in *that* case, took up the consideration of this Peckham patent, he had in mind the fact that the defendants' expert in *that* case had taken but slight note of that patent, *not even mentioning it in his examination-in-chief.* He passed it by, therefore, with the remark quoted by the Court below. In this we believe his position was wrong. The Peckham 419,876 truck, would, as we have shown elsewhere, and as an inspection shows, *promote*, rather than measurably lessen, oscillation.

But admit for the moment that this Peckham device would "measurably" affect oscillation, so, perhaps, did the earlier trucks with all spiral springs on the extended spring bases. Even they were "measurably" better in restraining oscillation than *no end springs.* But the latter were found not

to lessen it *sufficiently for practical* purposes, and they were entirely abandoned in the trade in favor of the truck of the patent in suit; and the Peckham 419,876 truck does not appear ever to have been put to the test of actual use (and has been shown elsewhere in this Brief to have been quite impractical). The oscillation problem was too serious for a "*measurable*" remedy. It required an *efficient* remedy. The continued *exclusive* use of this type of truck in the trade up to the present time—twelve years since its introduction, in which time the respondents alone have sold 10,000 of them—shows how completely the patentee, by the exercise of the inventive faculty, met the requirements of the case and provided a standard truck apparently destined to last as long as non-pivotal trucks are used in electric street railway practice.

E. It is, perhaps, somewhat difficult to understand in what sense the Court below considers that this really valuable invention embodies an "improved" result, but does not embody a "new result." If all other trucks failed and this alone succeeded, we submit that it is just such an advance in the art that the patent laws are made to protect. These considerations were persuasive to Judge Shipman's mind in the Third Avenue case when he summed up his opinion in these words (Record p. 144):

> "The only remaining question is that of *patentable novelty*. It has already appeared that the gist of the invention is described in Claims 1 and 2. The necessity for a remedy against the pounding of the car, the importance of the result, the adoption of the invention by experienced railway superintendents, the number of previous attempts at a remedy and the barrenness of their results *go far to show that the work of an inventive mind* was required and was active in the invention. The testimony of the defendant's expert itself, as he goes

through the history of the art and thereby points out what the patentee's combination did, as compared with previous efforts to do something, *shows that the patented improvement was patentable.* The result of the minor invention of Claims 9, 10, 11 and 14 was important, though upon first inspection, its marked importance does not appear, but it perfected the *general invention of the first two claims.*"

2. The Court below erred in holding that the language of the specification confines Claims 1 and 2 to special features of construction in which the elliptical springs do not come into play until the spirals have been depressed abnormally.

The learned Court below having thus, we submit, erroneously settled the position of this invention in the art, proceeds (p. 153) to consider the language of the specification, and finds that the invention is thereby confined to special features of construction by which "the elliptic springs will not be brought into play until the spiral springs have been compressed by the weight of the car body and the added load, 'until the weight of the load on the axle box springs begins to depress said springs abnormally,'" and limits the broad Claims 1 and 2 by reading this characteristic into them.

We submit that here also the Court below was in error.

First. It is a *specific embodiment* of the Brill invention to graduate and adjust the spring system to meet varying loads and thus furnish an easy riding truck. This embodiment is such that there is an initial compression of the spirals slightly in advance of the elliptics.

Second. This is the precise arrangement of the respondents' structures, as we have just shown, except that they *claim* that their initial compression is of the elliptical springs.

We have shown that in all truck constructions (of the present kind) it is proper and usual to adjust or graduate the springs so as to carry with equal ease either a light or a heavy load, and that the respondents' springs are thus adjusted. We will now return to that part of the opinion of the Court below which holds that the *specification* expressly limits Claims 1 and 2 to an arrangement of springs in which the elliptical springs do not come into play until the weight on the spiral springs begins to compress the spirals abnormally, thereby imposing a limitation upon these broad claims and finding that they are not broad enough to cover the respondents' structures.

1. It cannot be contended that the combination of spiral and elliptic springs, the latter supported on the extensions of the stationary frames and disposed between these frames and the upper frames, was not new in the art. It certainly is clear that no such structure appeared in the art until Mr. Brill introduced it.

Indeed the Court below said that

> "the only novelty in the inventions of those claims, details of construction being disregarded, consists in the *substitution of both spiral and elliptical* in the place of either spiral or elliptical springs."

2. The patent contains a broad group of Claims (1 and 2) and a narrower or limited group (9, 10, 11 and 14). The presence of a broad group is certainly a most persuasive *expression* of an intent, to be gathered from the whole instrument, to cover the broad invention.

Where there is any doubt as to whether a specification discloses a broad invention or only a specific detail or form of that invention, the fact that the broad invention is claimed in one group of claims and the specific form in another group, may certainly be considered, and to be entitled to weight in endeavoring to ascertain the intent of the whole instrument.

And this argument becomes even stronger when it is observed that not even the group of limited Claims, 9, 10, 11 and 14, indicate any *degree* of subsequency of compression of the end springs, and that Claims 9, 10 and 11 also cover the arrangement of respondents' springs. Thus Claim 9, for instance, reads: "Some of said series [of springs] being adapted to be compressed by the downward movement of said frame subsequent to the compression of the other of the series," and Claims 10 and 11 contain a like feature.

The opinion below (p. 153) recognized the force of this argument, but met it by stating that the limited group of claims "differ in other respects [than in respect of subsequent compression] from the two claims in the controversy." But this is erroneous. Claims 9 and 10 differ in no other respect.

In view of these two groups of claims, it would seem to be a strained construction of this instrument and one not easily to be adopted, which limits the *broad claims* to a *degree* of subsequency of compression which is *not found* even in the group of expressly limited claims.

3. The spiral springs are, according to the specification, to be made weaker than spirals had been made in the old art (Specif. p. 1, l. 100), so as *sooner* to bring the weight down to the elliptics under the *heavier load of a long car* at the time when the car is placed thereon, so that at that time both sets of springs may compress simultaneously. This is in accordance, as above shown, with the usual practice, and with the respondents' practice.

4. *The drawing of the patent* in suit does not support the Court in its extreme position. We have elsewhere shown (*supra*, p. 49) that *on the face of the drawing* itself, and by testimony thereupon in the Third Avenue case, the car *body alone* without *added passenger weight*, is sufficient to cause *all* the springs to take a bearing, and that there is ample latitude of settlement in the spiral springs (of the truck exactly

as illustrated in the patent) to provide for all further requirements of use.

Between this condition of use and the excessive weight theory of the Court below is a wide margin within which both the truck of the patent in suit and those of respondents clearly fall.

We submit that these considerations are exceedingly persuasive of the view that the broad claims should stand as they read and as Judge Shipman interpreted them.

What is there that has been urged on behalf of the view of the Court below? Merely the use in the specifications of the words "abnormal" and "abnormally" in relation to compression. As we state elsewhere, these words have no *definite* significance. They indicate no *exact degree* of compression. They ought not to control in any way the phrase of the specifications (p. 2, line 12) "until after the axle box springs have **begun** to compress," which expresses a clear, definite and accurate idea. "Abnormal" is, we submit, used carelessly and unnecessarily and should be given but little, if any, weight. That the writer's comprehension of the word was vague and uncertain is shown by the two following passages from the specification, one of which uses the word and one of which does not, yet both of which describe precisely the same operation of the truck structure:

". . . elliptical springs . . . which will not be brought into action until the weight of the load on the axle box springs **begins** *to depress* said springs abnormally."	". . . the elliptical springs will not come into play until the axle box springs have **begun** *to compress.*"

If "abnormally" in the first of these passages is of any real significance, why was it omitted in the second passage when *both passages describe precisely the same operation of the truck?*

It may be that in the mind of the writer of the specification "abnormal" may have meant any deviation of the upper frame from a horizontal position during the *oscillation* of the car. It is certainly so used in the following passage in the specification:

> "The devices which secure the elliptical springs between the side beams and the upper chord are devised to permit one end of the upper chord to approach the side beams and the other end to be elevated, as will occur in the act of oscillation, one set of elliptical springs being compressed while the other remains in its *normal* condition."

Another passage at p. 3, l. 64, of the specification (Record p. 19) may be referred to briefly although it was not adverted to by the Court below and has now been referred to by opposing counsel. The passage is as follows:

> "It will be seen that this method of bracing gives a greater carrying capacity to the ends of the side beams, permitting them to carry great loads without fracturing the saddles, upon which in this case a considerable portion of the strain would come, when by reason of excessive loading of the car body, and consequent depression of the springs, a portion of this action would be taken on the springs supported on the ends of the side beams. When the excessive loading is not present, the springs on the ends of the side beams act as buffers, the ordinary action of the car body on the truck being taken up by the spiral springs."

We will consider this passage:

1. It occurs in a part of the specification relating entirely to certain braces (marked 50 in Fig. 1 of the patent) intended to *strengthen* the extended ends of the side beams so as to enable them to stand *excessive* strains when there is an "excessive loading of the car body" on the ends of the side beams.

That is, when the strain is excessive, these braces are there to meet it. But the passage quoted does not signify, and is not intended to signify, in any way, the exact point at which, as between a truck without a car body on it and an excessively loaded car, the compression of the elliptical springs has *begun*.

2. The last sentence of the passage just quoted does not import any degree of subsequency of compression, certainly not that which the respondents' contend for and which the Court below found. The spiral springs are intended, at all times, whether the ellipticals are in action or not, and with or without the so-called abnormal compression, to act as the main car springs.

And the same thought is found in another passage of the specification: "The spiral springs . . . normally take the weight of the car."

Neither passage is inconsistent with the idea that even under the action contemplated in the passage quoted, the elliptics are under compression. The theory of the specific embodiment of the invention is that the spirals are the master car springs and the ellipticals are reinforcing springs—to resist forcible downward movement of the car body at all times. And when a car is unduly loaded at one end and the upper frame is inclined to the stationary frame, as is a common case, obviously all the springs are under compression simultaneously and are in part arranged to meet that condition of load. And this is the precise practice shown in the Peckham patent in evidence, 563,685, which states, at p. 3, l. 54:

> "There are four of these elliptical springs in the truck structure, two at each end of the truck, and it is upon these four elliptical springs that dependence is placed to sustain the car when not loaded, and as the weight of the car is increased, the spiral springs come into play to reinforce the elliptical springs."

Even when the springs are *all* bearing, say when supporting an "abnormal" load, then the spiral springs, in the

specific embodiment, "take up" the "ordinary action of the car body."

These clauses are not inconsistent with the conjoint action (in the patent) of *all* the springs.

In its opinion (p. 154), the Court below says:

> "They [the 28 claims] were obviously framed *to cover any possible theory of the invention* which is *hinted at* in the specification, and which the exigencies of an infringement action may require."

And yet it adopts a construction of Claims 1 and 2 which reduces the entire scope of the patent and of all its claims to a single phase of the invention.

We submit that the learned Court overlooked the fundamental rule for the construction of letters patent announced in *Keystone Mfg. Co.* vs. *Adams*, 151 U. S. 139, where it was said:

> "Where the patented invention consists of an improvement of machines previously existing, it is not always easy to point out what it is that distinguishes a new and successful machine from an old and ineffectual one. But when, in a class of machines so widely used as those in question, it is made to appear that *at last, after repeated and futile attempts*, a machine has been contrived which *accomplishes the result desired*, and when the Patent Office has granted a patent to the successful inventor *the courts should not be ready to adopt a narrow or astute construction, fatal to the grant.*"

The case at bar strongly resembles *Topliff* vs. *Topliff*, 145 U. S. 156, where Mr. Justice Brown, in delivering the opinion of the Court, said:

> "While it is possible that the Stringfellow and Surles patent might, *by a slight modification*, be made to perform the function of equaliziug the springs which it was

the object of the Augur patent to secure, that was evidently not in the mind of the patentees, and the patent is inoperative for that purpose. Their device evidently *approached very near* the idea of an equalizer; but this idea did not apparently dawn upon them, nor was there anything in their patent which *would have suggested it to a mechanic* of ordinary intelligence, unless he were examining it for that purpose. It is not sufficient to constitute an anticipation that the device relied upon *might, by modification*, be made to accomplish the function performed by the patent in question, if it were not designed by its maker, nor adapted, nor actually used, for the performance of such functions.

"While the question of patentable novelty in this device is by no means free from doubt, we are inclined, in view of the extensive use to which these springs have been put by manufacturers of wagons, to resolve that doubt in favor of the patentees, and sustain the patent."

See also the following decisions rendered by judges of wide experience in patent cases:

"There is no hard and fast rule by which to adjudge invention. Each case must stand on its own facts; but where it appears that the *patented structure is at the head of the evolution in its particular art;* that it is a marked improvement on what preceded it; that it *does better work* and *accomplishes more satisfactory results*, the Court should surely be predisposed in its favor."

Bray vs. *United States Net and Twine Co.*, 70 Fed. Rep. 1006. C. C., S. D. of N. Y., per Coxe, D. J.

"No one can read this record without being impressed by the fact that Van Depoele was more than a skilled mechanic in the art of electrical railway propulsion. *The Patent Office has raised a presumption in his favor as an inventor by the grant of numerous patents to him.* Some thirty have been introduced by defendant, several

of which cover highly meritorious inventions, which have largely contributed to the successful practical operation of the trolley roads throughout this country."

Thomson-Houston Electric Co. vs. *Winchester Ave. Ry. Co.*, 71 Fed. Rep. 192. C. C., D. of Conn., per Townsend, D. J.

The Court below appears to have taken a different view of *patentable novelty* in *George Frost Co.* vs. *Cohn*, 119 Fed. Rep. 505 (December, 1902), which involved a question of patentable novelty of a *hose supporter* (a *garter*).

Here also Wallace, C. J., wrote the opinion of the Court sustaining the patent. He said:

"It is not necessary to the patentable novelty of a device, which consists in employing a new material for an old one in constructing one of its parts, that the substitution should involve the discovery or utilization of an unknown or unexpected property of the material. This is one of the tests of patentable novelty, but it is not the only one. Whether the feature of novelty is the employment of a new material or a change of adaptation in other respects, the inquiry always is whether what was done involved the exercise of inventive faculty as distinguished from the ordinary skill of the calling. When the substitution has accomplished a *result* which those skilled in the art had long and vainly sought to effect, the evidence that it involved something beyond the skill of the calling is so persuasive that it generally resolves the inquiry in favor of patentable novelty. Applying that rule to the present case, we conclude that the patent in suit, as regards the claim in controversy, is not invalid for want of patentable novelty."

It will be convenient at this place to call the attention of the Court to the following authorities on patentable invention:

AUTHORITIES ON PATENTABLE INVENTION.

In *Consolidated Safety Valve Company* vs. *Crosby Steam Gauge and Valve Company*, 113 U. S. 157, which was on a patent in improvement in steam safety valves, in rendering *the opinion of the Court*, sustaining the patents, Blatchford, J., said :

> "*Taught by Richardson*, and by the use of his apparatus, it *is not difficult for skilled mechanics* to take the prior structures and so arrange and use them as to produce more or less of the beneficial results first made known by Richardson ; but, prior to 1866, *though these old patents and their descriptions were accessible*, no valve was made producing any such results."

In *Potts* vs. *Creager*, 155 U. S. 597, Mr. Justice Brown said in rendering the opinion of the Court :

> "The apparent simplicity of a new device often leads an *inexperienced person* to think that it would have occurred to anyone familiar with the subject ; but the decisive answer is that *with dozens and perhaps hundreds of others laboring in the same field, it had never occurred to anyone before.* The practiced eye of an ordinary mechanic may be safely trusted to see what ought to be apparent to every one."

In *Webster Loom Co.* vs. *Higgins*, 105 U. S. 580, 591, it was said by Mr. Justice Bradley : "But it is plain from the evidence, and from the very fact that it was not sooner adopted and used, that it did not, for years, occur in this light to even the most skillful persons. *It may have been under their very eyes*, they may almost be said to have stumbled over it ; but they certainly failed to see it, to estimate its value and to bring it into notice. . . . *Now that it has succeeded*, it may seem very plain to anyone that he could have done it

as well. This is often the case with inventions of the greatest merit. It may be laid down as a general rule, though perhaps not an invariable one, that if a new combination and arrangement of known elements produce a new and *beneficial* result, never attained before, it is evidence of invention."

The following are well-considered cases in the Circuit Court of Appeals:

> "The argument that these differences could be overcome by a mechanic of ordinary skill, without calling for any exercise of the inventive faculty, *is the one always resorted to in cases like the present.* The task of distinguishing between invention and the power of adaptation possessed by a skillful mechanic is not always an easy one, nor have the courts apparently succeeded in formulating a proposition to cover all cases. While the statutes require that a patent, to be valid, must disclose invention and novelty, yet the degree or amount of invention required is not prescribed, and from the nature of the case, cannot be."
>
> *Hilborn* vs. *Hale, etc., Manufg. Co.*, 69 Fed. Rep. 958, C. C. of A., Third Circuit. Per Shiras, Circuit Justice.

National Hollow Brake Beam Co. vs. *Interchangeable Brake Beam Co.*, 106 Fed. Rep. 693 (C. C. of A., Eighth Circuit), was on a patent on a brake beam. The Court, after referring to the standard requirements of the Master Car-Builders' Association, calling for a brake beam on freight cars, having a capacity to withstand a load of 7500 pounds applied at the centre, and on passenger cars of 15,000 pounds, said (Sanborn, C. J.):

> "The problem was grave and difficult, and to him who successfully solved it honor and reward were justly due. Many men interested in railway equipment worked and

searched for the solution, and among them the patentee, Phillip Hien. He attempted to supply the acknowledged want, and to this end he devised, described and claimed a trussed hollow metallic brake beam, which completely filled the requirements of the Master Car-Builders' Association, and which went into such immediate and general use upon the railroads of the land that in 1892 85 per cent. of these railroads, controlling 80 per cent. of the cars using iron brakes, had adopted those made under these patents to Hien, and in 1898 more than 1,000,000 brake beams constructed under these patents had been manufactured and sold. These facts establish neither the novelty nor the patentability of his device, but they certainly challenge admiration, and demand that the presumption of validity which supports his patents shall not be stricken down without careful consideration and cogent and convincing proof. The keen, shrewd mercantile spirit of this age is seldom deceived with the purchase and continued use of worthless improvements in mechanical devices, and, when all is said, success is by no means the poorest criterion by which to judge of the acts and words of men."

It may perhaps be said that the learned Court below too easily worked along the line of thought that the "substitution" was "obvious." Of course, the elements which the constructor of a truck deals with are few. They are springs, beams, pedestals, etc., from which must be made up the means of connecting the axles of a car with the car body—that is, the means for sustaining the car body on the axles. New trucks can be made only by combinations of these various elements. And the art is a most difficult one. It deals with such vast elements of weight and speed. It has for long years occupied the attention and thought of many able inventors, and thousands of truck patents have been granted. It required, it is said, forty years to develop a standard locomotive truck, and

it took about as long for the development and final perfecting of the standard steam-car truck universally accepted in the trade and known as the "Master Car-Builders'" truck. And even with all those years of development in the locomotive and steam-car truck arts, neither of those arts taught anything to the art of electric railway non-pivotal trucks driven by electric motors. The conditions necessary in that art were practically absent in the former art.

If every combination constituting an advance in the truck art is held to be a mere "obvious substitution" because the elements of the combination are old, what shall be said of the thousands of patents which have been granted in the truck art, many of which have undoubtedly been valuable and many of which have been sustained by the courts? A more accurate view is, we submit, to consider that a truck combination which is novel and which constitutes a distinct advance in the art, and particularly which has met with general or universal adoption, is, broadly speaking, entitled to the protection of the patent laws, notwithstanding the elements of the combination are old, as they necessarily must be. To hold otherwise would be almost equivalent to saying that in the future no valid patents can be granted on car trucks.

As to respondents' theory that no infringement is shown.

We state again that at no time have respondents attempted to deny that their structures do not infringe Claims 1 and 2 either

1. As they read, or

2. As interpreted by Judge Shipman in the Third Avenue case.

Before taking up the respondents' theory that no infringement has been made to appear we will show the

TIME AND MANNER OF INTRODUCTION OF THE BRILL TRUCK.

In January, 1891, the earliest trucks made in accordance with the patent in suit were put in use on a street railway in Cleveland, and until recently, at least, they were still in use. There were ten of them.

John A. Brill, p. 35 of Record.
G. M. Brill, pp. 47, 48 of Record.

In October, 1891, there was an annual convention of the Street Railway Association, at Pittsburg, at which "the J. G. Brill Company exhibited a truck of this style and at the same time had some of them in operation on one of the street railways in Pittsburg, which were exhibited to the railway men attending the said Convention."

John A. Brill, p. 36 of Record.

"This was followed by a large number of sales of the trucks to various street railway companies in various parts of the country. The J. G. Brill Company manufactured it to the practical exclusion of its former types of trucks for four-wheel cars. Since then, it has been copied by other truck manufacturers, and street railway companies have recognized it as a necessity of the business and have almost universally adopted it. The type of truck of the patent in suit has, since then, supplanted all other four-wheel truck structures in the markets of the United States."

John A. Brill, p. 36 of Record.

"The type of truck which I invented, as above stated, . . . was made known to the trade in 1891 and thereafter and entirely took the market throughout the United States. Nearly all of the truck dealers began to build trucks constructed in accordance with the patent in suit, and the railway companies began to order them almost exclusively. Practically, and except for a few limited

purposes where short car bodies were required, the old types of truck were no longer manufactured or sold, and in the course of a few years after my said invention, nearly 90 per cent. of all the four-wheel trucks in use in the United States were constructed in accordance with this invention."

G. M. Brill, p. 48 of Record.

See also James Fagan, p. 50 of Record.

"Trucks constructed with side beams and combined elliptic and spiral springs, with an extension frame, have long since gone into general and almost exclusive use on street railways throughout the United States. They have almost entirely displaced the trucks . . . which had all spiral springs. So far as the use of trucks under long car bodies is concerned, I believe that this type has entirely displaced the earlier types with all spiral springs."

H. M. Littell, p. 52 of Record.

"This type of truck has gone into universal use under four wheel cars, and has substantially, if not completely, displaced all other constructions of single trucks."

John N. Akarman, p. 55 of Record.

Edgar Peckham, p. 89 of Record, attempts to controvert John A. Brill's affidavit as to the universal adoption of the truck of the patent in suit. What he means is that, *according to his theory of the scope of the patent*, only the few trucks he mentions have been sold. He does not attempt to deny the statements of G. M. Brill, Fagan, Littell and Akarman. Of course the petitioners' allegation of the universal adoption of their truck is intended to include sales and use of Peckham trucks, and all other trucks of the patented type, containing the combination of the patent in suit.

What Peckham and His Successive Companies were Doing at this Time.

In September, 1889, he applied for his patent 419,876. It certainly has been sufficiently made to appear that *this was not a practical device* and that *they never built trucks* under it.

In *October*, 1889, he advertised "*Peckham's Non-oscillating Electric Motor Truck*," a drawing of which is shown at Exhibit A, p. 40 of Record. It was an *all-spiral* truck, *differing entirely* from the truck of his patent No. 419,876. The Peckham Company's advertisement in the *Street Railway Journal* of October, 1889, states (Record p. 32):

> "The illustration in figure 1 represents a *new truck* gotten up by Mr. E. Peckham, President of the Peckham etc., Company." "Instead of having the springs placed as usual on the pedestals, one on each side of the car is located at each extremity of the frame, and the others at points between the axles equi-distant from the outer springs. This arrangement, as will at once be seen, *must entirely prevent any rocking motion.*"

September 17, 1889, Peckham applied for a patent on this last type of truck, which was issued January 21, 1890, as No. 419,877. Peckham (pp. 85, 86 of Record) describes this truck as his "first extended spring base truck." His affidavit states that subsequently he added a rubber *tension spring* and after that a spiral tension spring, under the lower chord of the truck frame (p. 86).

Peckham says at page 86: "I adopted this method in 1890 or 1891." The Peckham Company *continued to advertise this all-spiral truck* until about December, 1895. (Curwen, pp. 56, 57.)

The respondents' affidavits nowhere show distinctly just when the Peckham Company adopted the combination of the patent in suit, but there is enough in them to establish that

it was not *before* 1892. We ask attention to the evidence on this subject.

Peckham states, at page 91 of the Record, that his *sales* of the truck in question had "extended over some eight years or more." This affidavit was made October 25, 1900. Consequently he must have begun these sales about October, 1892.

Again the Peckham patent of July 7, 1896, No. 563,685, specifically describes a truck having *the same combination* of spiral and elliptic springs *as in the patent in suit*, combined with the tension spring above referred to, *the whole being respondents' present truck structure.* The application for this patent was filed March 12, *1894*. Now, he says that the spirals and the tension springs of this patent were old and had been used by him. If he had also used the elliptics in combination with them for more than two years before his application for a patent on the combination of all three, he had thereby abandoned the subject-matter of the application, and his oath in support of it was false. It would appear, therefore, that the truck of patent No. 563,685 (that is, elliptics combined with his old spirals and tension springs) could not have been in use by him for more than two years prior to March 12, 1894 (*i. e.*, March 12, 1892), *which was fifteen months after the first Brill trucks were put into use* at Cleveland (in January, 1891) and *five months after* the Brill truck was exhibited at the Convention of the Street Railway Association, at Pittsburg (in October, 1891), and was seen there and in use on a Pittsburg street railway by the trade (and presumably by Mr. Peckham, a leading truck builder) at that time.

The affidavit of Peckham (bottom of p. 87, etc.) refers to his having introduced a semi-elliptical spring, etc. In the same passage he is speaking of the lateral and longitudinal motion of the car body in relation to the truck frame, and its prevention by substituting an elliptical spring, in place of his former spirals, to obviate this motion. He is, therefore, en-

tirely mistaken in saying that he used a semi-elliptical spring for that purpose, in any connection. Clearly a semi-elliptical spring would not prevent either lateral or longitudinal motion. Its *ends* must have *free motion*, and therefore it could not prevent motion of the car body in any horizontal direction whatever.

In adopting the combination of spiral and elliptic springs of the patent in suit, they took it outright. They, however, added a feature to it by fastening the top of the elliptic to the upper chord, and they say that their elliptics were so made as to take the stress of the load and that their spirals were made to supplement the elliptics. As. J. R. Beetem states (p. 102 of Record):

> "The spiral springs are made weaker and reinforce the elliptic springs as the load of the car increases."

If the inference that their elliptic springs are stronger than their spiral springs is to be drawn from the affidavits, the statement is too vague to have much weight. The respondents should have shown more specifically to what extent their elliptic springs are the stronger and controlling springs, for it is obvious, if their elliptics and spirals are *substantially* of the *same* strength, that in a truck which has *six* spirals and only *two* elliptics on a side (as in the respondents' "Extra Long" truck, Record p. 45, Exh. I) the greater part of the weight would be borne on the spirals, and if the respondents had wished to show that the contrary is the fact, they should have shown clearly that their elliptics are always *in the aggregate* stronger than their spirals. True, the respondents could not escape infringement merely by showing that they made their elliptics substantially stronger than their spirals. We merely wish to show that the *theory* upon which they seek to take their trucks out of the operation of this patent is not founded upon fact.

The rigid attachment of the upper part of the elliptic spring to the upper chord in the respondents' trucks is a matter of no

importance in the present case. Mr. Livermore considers this subject at page 72 of this Record, at too great length for quotation here. The attention of the Court is asked to his statements.

Having briefly set out the course of the introduction of the truck of the Brill patent in suit (in 1891) and of the successive steps taken by the respondents up to the time (1892) when they fully adopted and began to manufacture the truck of the patent in suit, we proceed to consider the theory upon which they justify their acts.

Theories by which respondents attempt to differentiate their Truck Structure from Claims 1 and 2.

Called upon to produce some theory upon which a defence could be based, the respondents' experts evolved the following:

1. That the so-called "underlying" *tension spring* in respondents' truck placed under the stationary side beam or truck frame, is *its sole factor in overcoming oscillation.*

2. That there is no such thing as overcoming oscillation by difference of rhythm between spiral and elliptic springs.

We will take up these theories in order:

1. THE RESPONDENTS' THEORY THAT THEIR TENSION SPRING IS THEIR SOLE FACTOR IN OVERCOMING OSCILLATION.

A new importance is now attached to this tension spring, which the history of the truck structures of the Peckham Company and of its patents has never disclosed to the world.

We will discuss the subjects from the point of view:

A. Of the advertisements of the Peckham Company in its business.

B. The disclosure of certain Peckham patents.

C. The construction of the respondents' structure.

A. Their "non-oscillating electric motor truck" of 1889 (Exhibit A, p. 40) *does not have this tension spring*, and yet it was advertised (Record p. 32) as "an admirable solution of the problem of oscillation."

Their trucks advertised in June, 1890, as "*warranted to prevent oscillation*," "*positively prevents oscillation of cars*," do not have this tension spring (Curwen, pp. 56, 57).

On the other hand, in the Peckham advertisements of trucks *which have this tension spring, no attention is called to its value*, but on the contrary, we find in their advertisement of February, 1893, a "Standard" truck, in relation to which it is stated: "*elliptic and spiral springs* so combined as to give the utmost *elasticity* with both light and heavy loads." (Curwen, p. 57.) (Clearly this means car-supporting springs only.)

Mr. Curwen (Rec. pp. 56, 57) states that in the Peckham advertisement of October, 1895, containing drawings of "Excelsior," "Standard" and "Extra Long" trucks, there is the following statement in regard to those trucks:

> "Why Peckham's cantilever extension trucks are superior to other trucks."
>
> "4th. Because the *elliptic* and *spiral springs* SUPPORTING the car bodies are so arranged as to give an easy-riding car, whether light or heavily loaded."

The Peckham advertisements, which Mr. Curwen there quotes (which are intended to set forth the virtues of the very Peckham trucks now in controversy), contain *no reference to tension springs* as a valuable or efficient part of any of these three trucks.

B. Again let us take up the Peckham patents in evidence. They also *completely negative the respondents' contention* that

this tension spring is "alone relied upon to overcome galloping," upon which they practically rest their case.

The first Peckham patent showing a tension spring is No. 555,530, dated as late as March 3, 1896, and applied for June 11, 1895. The specification refers to this "counter" or tension spring (p. 2, l. 14) but *says nothing of its utility in preventing oscillation*, though the express object of the invention is to "*prevent the car from oscillating*," an object which it accomplishes by providing *side frames* with means for accommodating at given points springs of different types (not tension springs).

The next Peckham patent in which a tension spring appears is No. 563,685, issued in 1896, July 7th, application filed March 12, 1894, and prior *in application* to the last mentioned patent. In this patent (p. 3, line 23) the tension spring is referred to thus:

> "The function of the under tension-spring 61 is to *take up lost motion* of spiral spring 59 and to *keep the same in proper tension*, thereby providing at this point of the truck structure what I term a '*tension*' *appliance*."

And p. 3, line 38:

> "And by this disposition of the springs I am also enabled to combine advantageously with the spiral spring 59 the lower tension-spring 61, thus providing an effective *tension device serving to prevent breakage of the elliptical springs by upthrusts of the truck*, the said tension device also relieving the car from shocks by cushioning the nut 62 at the bottom of the rod or bolt 60."

No reference is made in the specification of this patent *to any effect of the tension spring in lessening oscillation*. Indeed its name indicates its sole function.

Of what value, therefore, is the statement of Peckham, in his affidavit, p. 87, where he says that his tension spring constitutes his sole anti-oscillation device.

And what possible ground for the statement made in the Brief in the Court below that "it [the tension spring] is the only provision in the defendants' trucks to overcome galloping, and that is its sole function."

And what basis is there for the statement made in the Brief in the Court below, that "neither he [Peckham] nor the Defendant Company . . . has ever made any four-wheeled street car truck in which any other means than this underlying spring has been relied on to overcome galloping."

Such evidence of the *solemn acts* of the respondents in their business, in their dealings with their customers and with the public, and in their letters patent on their trucks, and relating to a *time when no suits were pending or threatened*, is certainly more persuasive than the theories of patent experts, formulated in the eleven days that elapsed between notice of the motion for a preliminary injunction and the hearing of the motion.

C. Again, an inspection of the respondents' "Excelsior" truck (shown at 45 of the Record) will satisfy the Court that *this slight tension spring* cannot possibly have the effect on the operation of the truck attributed to it in the respondents' affidavits. In this drawing it is said to be "*concealed*" in a box in the truck frame. Obviously, it is but *a slight affair* relatively to that truck structure. If we suppose an "Excelsior" truck running at speed with a load of seven tons of passengers, a number of them crowded on the platforms which have an overhang of many feet beyond the location of this "tension" spring, it will be seen at once how entirely inadequate it is for the purposes claimed for it in the respondents' affidavits. Would this light spring check the upward movement of the end of the loaded car, the downward movement of which requires two *heavy* spiral springs and one elliptic spring on each side to sustain and check it?

And if called upon to play any serious part in checking the upthrust of this great strain, is it not clear that the nut on the lower end of the bolt would at once shear off?

Again, while one end of the truck is rising so as to bring the two small tension springs at one end into play, the elliptic and spiral springs at the other end [six in all at each end of Excelsior and Standard, and eight in the Extra Long], are being compressed to limit the elevation of the other end of the car, and these co-operate together at the depressed end to resist the elevation of the other end, just as they do in the Brill truck under like conditions. It is very plain that in the Peckham trucks, the resistance by the elliptic springs to an upward movement, and the resistance by the compression of the elliptic and spiral springs at the other end to a corresponding downward movement would be sufficient to avoid a tendency to undue oscillation without calling in the aid of these tension springs at all.

The affidavit of H. F. Newbury (p. 115) sets forth that these tension springs

> "Will be further compressed upon the upward movement of the car body . . . and the further compression of these spiral springs will be in proportion to such upward movement of the car body *until they are fully compressed, when they positively arrest such upward ment.* When this upward movement of the car body *is thus arrested, it cannot move further upward without lifting the lower member* of the truck frame and its connected parts."

But the fact is that the upward movement of the car body at one end corresponds to the downward movement at the other end, where the latter is being checked by six heavy springs, four spiral and two elliptics. In this movement, possibly the tension spring may play a slight *additional* part, but the efficient work is obviously done by the heavy spiral and elliptic springs. That is, the oscillation in the Peckham trucks has been efficiently checked by the combined spiral and elliptic car springs of the patent in suit before this tension spring comes into play. What part is played by this slight

tension spring in this powerful movement of a heavy car and its many tons of passengers is at least problematical.

Mr. Newbury's statement that when the tension spring becomes fully compressed, there can be no further upward movement, is obviously true, because the tension spring has then become a *washer* and the nut underneath it has then been brought into close contact with the lower side of the side beam. And the same is precisely as true in relation to the *spring bolts* on the Brill truck, of which there are four on each side, *disposed precisely* as in respondents' "Excelsior Truck." After a certain amount of upward motion at one end of the car, the nuts on the lower end of these Brill *spring bolts* likewise *come into contact* with the under part of the side frame and *check the further rise of the car body.*

It will be observed that four experienced witnesses depose that all three of the respondents' trucks and the petitioners' truck *operate in the same way* for lessening oscillation.

John A. Brill (Record p. 39);
James Fagan (Record p. 50);
Harvey M. Littell (Record p. 53);
J. N. Akarman (Record p. 56).
See also Mr. Livermore (p. 71).

From all this evidence it seems to be fully established that the respondents' theory of the part played by their tension spring is entirely disproved.

The fact is, the respondents' truck *is the truck of the patent* in suit with a "*tension*" *spring added to it.* But this addition is nowhere shown to affect in any way the method of operation of the combination of spiral and elliptic springs of Claims 1 and 2 of the patent in suit, which combination is undeniably present in their trucks.

If the respondents believe, as stated by their former employee, Fowler (Record p. 95), "that the introduction of that lower spring [the tension spring] to resist the upper motion

of the car has been *perfectly effectual* in accomplishing the result for which it was intended," one may naturally ask why the Peckham Company did not confine itself to this device, and why, on the other hand, they appropriated the combination of the patent in 1892 more than a year after its introduction in the trade (January, 1891), applied for a patent for the combination of spiral and elliptic springs of the patent in suit in combination with this tension spring, in 1894, and are now strenuously contesting the rights of the petitioners under the letters patent in suit, notwithstanding that there is no present attempt to interfere with them in the use of their "perfectly effectual tension spring."

But the whole theory of the part played by the tension spring as the *sole factor* in the checking of oscillation in the Peckham truck is *negatived by their own witness Beetem*, who is their only *practical* man, who goes only so far as to say that this spring "*assists*" in checking oscillation (Record p. 103).

2. Respondents' Contention that there can be no Difference of Rhythm between the Spirals and Elliptics of the Brill Patent.

Again, the respondents endeavor to differentiate their trucks from the truck of the patent in suit by showing that "there can be no difference whatever between the rhythm of movement generally considered of two series of springs where one is stronger than the other, whether such two series be all of the elliptic form, semi-elliptic form or spiral form, or part of one and part of the other." (Newbury, p. 107.)

We show that this contention is untenable:

A. Judge Shipman's interpretation of the scope of patent is otherwise.

B. Practical street railway men testified otherwise.

C. Peckham's patents show the contrary.

D. The Peckham Company's advertisements show the contrary.

A. For the purposes of this present case, it is sufficient to say that Judge Shipman found otherwise in the Third Avenue case. Thus, in describing the invention of the patent in suit, Judge Shipman says (p. 141):

> "The elliptical springs are slower in their action than the spiral springs and neutralize the longitudinal oscillation of the car body. Mr. Akarman, a *practical trolley railroad superintendent*, stated the result and reason of it, as follows:
>
> 'From a practical observation my opinion is that the combination of an elliptical and spiral spring, as applied in trucks of this type, breaks the rhythm of motion, or interrupts it. In trucks with all spiral springs, or I should think, if it were possible to construct a truck having all elliptic springs, the rhythm of motion is perfect, the springs acting in unison. In the truck, as previously described, having the combination of elliptic and spiral springs, the rhythm is broken and the result is that the galloping or rocking motion was done away with.'"

B. In this finding Judge Shipman was supported not only by the *undisputed* evidence of Akarman but by Littell and Fagan, both *experienced and practical* railway men.

The deposition of Mr. Akarman to the same effect as quoted by Judge Shipman is found in the present Record at page 55.

At page 50, James Fagan, and at p. 53, H. M. Littell, make similar statements.

No practical street railway man has been produced to rebut this evidence. Even Peckham himself does not attempt to deny it. Indeed, in the face of his own patents, now to be referred to, he could hardly attempt to do so. On the other hand, he *admits* it, for he speaks of the Brill construction as a "system which depends upon a difference of rhythm of action between elliptic and spiral springs" (Record p. 86). Beetem, who is

a *practical* railway man, does not attempt to controvert the the position as to rhythm taken by Akarman, Fagan and Littell and adopted by Judge Shipman. Indeed, none of the respondents' witnesses so attempt, except one of their experts. Even Fowler does not, and Newbury himself seems substantially to admit the existence of a difference of rhythm between springs of different character.

C. Furthermore, the *patents of Peckham* found in this Record show conclusively that the contention of the respondents that the use of springs of different character do not lessen oscillation, is entirely untenable.

Thus, patent to Peckham, No. 555,526, dated March 3, 1896, application filed August 18, 1891, is one of the first of the Peckham patents to mention the evils of oscillation and to suggest a means of lessening it. That patent discloses *all spiral springs* (no elliptics). In the specification, after stating that the object of the invention "is to construct a car truck wherein end oscillation or tilting of the car body mounted thereon will be largely if not entirely avoided," it is stated (p. 2, line 71):

> "The springs located on the truck frame . . . are of *different degrees of stiffness*, and they are so disposed with relation to the truss frame . . . as to insure under all conditions an easy riding car and to distribute the load, particularly when the car is filled with passengers or otherwise heavily loaded, upon such springs approximately in proportion to their stiffness. . . . "

Again, take patent to Peckham, 555,530, dated March 3, 1896, application filed June 11, 1895. Fig. 1 of this patent shows the very arrangement and combination of spiral and elliptic springs shown in Fig. 1 of the patent in suit; and it is also the respondents' "Excelsior" truck. The specification states, p. 1, line 15:

"A further object is . . . to provide such side frames with means for accommodating at given points *springs of different types*, made use of for neutralizing shocks imparted to the wheels and body of the car, and *for preventing the car from teetering or oscillating when in motion.*"

Patent to Peckham, 563,685, dated July 7, 1896, application filed March 12, 1894. This shows in the drawings and claim as new the construction of two of the trucks now in controversy, viz., the "Standard" and "Extra Long." The specification states, p. 1, line 12:

"The invention is hereinafter described . . . and its object is to relieve the truck frame from shocks or concussion and to *prevent the oscillation of the car when in motion.*"

Also p. 1, line 84:

"The *particular combination of elliptical and spiral springs* and tension appliance hereinafter described is, however, one of the improvements forming the subject of this application."

It will be observed that the dates of the last two patents are respectively as late as March 3 and July 7, 1896, and that the above-mentioned Peckham patent (555,526) was pending in the Patent Office from August 18, 1891, to March 3, 1896.

D. Again, the Peckham advertisements of these trucks show the same position always to have been taken by Peckham, viz, that he depended on the combined spirals and elliptics to overcome oscillation. See Curwen (Record p. 57).

In February, 1893, they advertised their "Standard" truck thus:

"Guaranteed to prevent oscillation of 30-foot cars."

"*Elliptic* and *spiral springs so combined* to give the utmost elasticity with both light and heavy loads."

In October, 1895, they advertised all three of their present types as follows:

"Why Peckham's cantilever extension trucks are superior to other trucks."

"4. Because the *elliptic* and *spiral springs* SUPPORTING the *car bodies* are *so arranged* as to give an easy-riding car."

In December, 1896, they advertised all three forms of construction as follows:

"Why Peckham cantilever trucks are superior to other trucks."

"6. Because the *elliptic* and *spiral springs* (SUPPORTING the *car bodies*), BEING GRADUATED, give an easy-riding car, whether light or heavily loaded."

It appears, therefore, that our theory upon which the combination of spiral and elliptic springs of the patent in suit is efficient in checking oscillation is supported by the opinions of three practical railway men, has been found as a fact by Judge Shipman, and has always been distinctly recognized in the advertisement of the Peckham Company and in the patents taken out by it and by Mr. Peckham. Against this mass of testimony we have the opinion of three *theoretical* experts who appear to have given to the subject a few days' consideration.

We submit that the attempts to differentiate respondents' trucks from the structure of the patent in suit is shown to be untenable.

As to the respondents' contention that they "adopted" elliptic springs merely to prevent swaying of the car body on the truck.

It is urged by the respondents that they had used *all spiral* car springs prior to 1889, and, soon after, tension springs, and they allege that later (but it could not have been before some time in 1892) they introduced the combination of the patent in suit. If so, they did this more than a year after the trucks of the patent in suit had gone into the trade and into use, and (as Judge Shipman says, p. 142) had "attracted the immediate attention of railway superintendents [been] found to accomplish its object and to be almost a complete remedy" for oscillation.

It would seem to have been an ordinary case of the appropriation of another man's invention, by which, it appears, they succeeded in selling some 10,000 trucks, which presumably they could not have sold had they confined themselves to their own truck structures of 1890-1892, with all spiral springs. Evidently they were driven to it by trade necessities. They now say that they did not "adopt" elliptic springs for the purpose for which they are used in combination with spiral springs in the patent in suit (the lessening of oscillation). The reason they allege is given by Peckham (Record, pp. 87, 88):

> "I soon found that these spiral springs did not give as much resistance as was desirable to lateral and lengthwise motion of the car body in reference to the truck frame. This was due to the fact that the bearing of the bolts or stays passing from the car body to the truck frame was so short below and extended so far above that motion laterally and longitudinally was unavoidable. To overcome this, and *for no other reason whatsoever*, I . . . introduced a . . . . full elliptical springs . . . I repeat that *it was for this reason*, and for no other, that

I substituted the elliptical springs for one set of the spirals in my construction."

To show the error of all this contention, we ask the Court to look at the "Extra Long" truck at p. 45, Exh. I. It has *six of these spring bolts to a side* passing *snugly* through the side frames. Four of these have as long an extension below the top of the side frame as they have above them, giving a very firm bearing. With these spring bolts alone there could be no swaying. Besides this, on *each* side are *four* posts which are rigidly fastened to the upper frame and run through the yokes or pedestals. The bearing of these posts in the pedestals is probably eighteen inches. The part above the pedestal is probably not over three inches. These latter bolts alone would entirely prevent any material lateral or longitudinal swaying motion of the car in relation to the truck. In all, then, there are twenty bolts on the "Extra Long" truck intended to prevent swaying and obviously entirely efficient for that purpose. On the "Standard" and "Excelsior" there are sixteen such bolts.

In the light of these facts, the respondent's "*reasons*" for appropriating the combination of the patent in suit are, we submit, entirely untenable. Such a defence casts suspicion upon the sincerity of the entire defence.

FACTS APPEARING IN THE COURSE OF CERTAIN CORRESPONDENCE BETWEEN THE PARTIES IN 1897, LONG BEFORE SUIT BEGUN, SHOW THAT ANY CONTENTION BASED UPON THIS PECKHAM PATENT 419,876 CANNOT BE SERIOUSLY MADE BY RESPONDENTS' COUNSEL.

Certain acts of the respondents shown in this Record, are distinctly persuasive, *at least in the present* proceedings, as disposing of any contention based upon this Peckham patent, 419,876. They are as follows:

The affidavit of Hensley (Record p. 60) sets forth that in 1897, the complainant, John A. Brill, notified the Peckham

Company that it was infringing upon the letters patent here in suit and that "as soon as Mr. Brill's rights under this patent were determined by suit which he intended to bring in or about New York, he would proceed against it (the Peckham Company) for infringement." The affidavit further states that the Peckham Company then retained Charles H. Duell, Esq. (the present counsel for the respondents), as its counsel in the matter. Mr. Duell and Mr. Levy, the latter representing the petitioners, had a number of interviews in relation to the alleged infringement, the result of which was that on November 12, 1897, Mr. Duell wrote Mr. Levy a letter which is set forth on page 60 of this Record. In it he says:

> "I have *devoted a great deal of time and have had the assistance of others skilled in the art*, because it has been my desire to make a *full* and fair *investigation* and with the idea of trying to adjust the differences between our clients. . . .
>
> "While I have not been able to complete my report owing to inability to obtain copies of some *foreign patents and publications*, yet it has progressed so far that I have come to the conclusion that I must *advise my client* that it *has a complete defense* to any suits that may be brought upon any of the patents in question.
>
> "While I should prefer to avoid litigation on account of the expense connected with it, and because my client has no desire to see patents overthrown, yet if suits be brought, we are prepared to *maintain our position at any cost.*
>
> "While the *prior art is replete with anticipating and limiting patents*, with many of which, doubtless, you are familiar, yet in fairness I will call your attention to some of the many patents *upon which I shall rely in case of suit.*
>
> . . . . . .
>
> "Referring to Brill patent No. 478,218, I would call your attention to the following patents":

Here follows, on page 61 of the Record, a list of fifteen patents to which Mr. Duell refers. The list *does not include this Peckham patent 419,876.* Mr. Duell could not have been ignorant of its existence, for it was a patent *issued to his client, and,* as it shows on its face, was *actually solicited* in the Patent Office by Mr. Duell's own firm of patent solicitors, "Duell, Laass and Duell."

This is more than an ordinary and casual expression of opinion by counsel. It is the deliberate opinion of counsel of experience when endeavoring to make out the best possible case for his client in an attempt to avert a threatened law suit —an opinion reached "after a full and fair investigation," with the expenditure of "a great deal of time."

It was *not* an attempt to "buy peace," but to repel invasion, and it may, therefore, rightly be referred to.

In the present proceedings, at least, this must tend to throw some doubt upon the sincerity of the contention of respondents as to the weight that attaches to this Peckham patent 419,876, as imposing a vital and destructive limitation upon Claims 1 and 2 of the patent in suit and the meritorious invention which it discloses.

It may be observed that the counsel referred to occupied an official position while these proceedings were in the Circuit Court and the Circuit Court of Appeals, and was not concerned in the case, so far as appears, till it came into this Court.

The Court below erred in finding that it was not necessary for Judge Shipman, in the Third Avenue Case, to define accurately Claims 1 and 2.

The Court below in refusing to give due weight to Judge Shipman's adjudication in the Third Avenue case, stated the following reason :

> "In that action the infringement of these claims [1 and 2], as well as that of several other claims in the patent, including numbers 9, 10, 11 and 14, was alleged by the complainant, and the question of their validity, as well as their infringement, was *strenuously contested;* and upon final hearing the Court adjudicated the validity of all the claims and held them to be infringed by the defendant. Inasmuch, however, as the infringing car trucks embodied the combinations specified in all the claims, it was not *necessary* in that case for the Court to *accurately define* Claims 1 and 2 in order to determine what, if any, limitations *not expressed* therein *were to be read into them by implication.*"

We shall show that this was clear error and that the precise issues before Judge Shipman *did require* him to define Claims 1 and 2 accurately.

The trucks there complained of were built by the Bemis Company for the defendant. The former assumed the defence. The complainant's case was to establish the validity and infringement of both groups of claims. The defendant attacked the validity of the first group (1 and 2), but never attempted to limit them to less than their literal scope and never seriously denied their infringement. As to the second group (9, 10, 11 and 14), the defendant did not contest their validity, but sought to show that they had not been infringed—that is, that its trucks did not, in fact, have the element of subsequent spring compression, but that all the springs of its trucks came under simultaneous compression at all times. (Obviously this was an admission that they *did* infringe Claims 1 and 2 when construed literally.)

Much evidence was adduced on both sides as to whether the defendant's trucks had or had not the feature of subsequent spring compression; the defendant endeavoring to prove that its trucks were not arranged for subsequent compression. Part of their evidence showed that after the trucks were

put in use, the elliptical springs "settled" and blocks of wood, of about an inch in thickness, were inserted over the elliptical springs, to bring them into contact with the upper chord or car sill (thereby eliminating the feature of subsequent spring compression, avoiding infringement of the second group of claims and bringing the trucks within the scope of only the first group of claims).

Judge Shipman, in his opinion,

1. Found Claims 1 and 2 valid and infringed, the defendant itself having admitted that it had used a number of trucks in which the feature of *subsequent spring compression* was *not present*, and never attempting to deny infringement of the broad Claims 1 and 2. For this reason it was not necessary for Judge Shipman, in his opinion, to *discuss* infringement of Claims 1 and 2.

2. He sustained the validity of the second group.

3. He found, as a fact, upon a consideration of all the evidence, that in some of defendant's trucks, *when first put in use*, the springs were so arranged that the spiral springs came under compression before the weight began to come upon the elliptical springs.

In his opinion, after considering the prior art, Judge Shipman said:

> "The **contest** in regard to *infringement* related to Claims 9, 10, 11 and 14, the controversy being whether the elliptical springs in the defendant's trucks were so arranged with reference to the car body that the weight came upon them as soon as it came upon the spiral, so that there was no compression of the spirals before the weight began to come upon the elliptics."

The subject can be made even clearer if we show the history of the *different forms of use* by the Third Avenue Railroad Company of the trucks there in controversy. It was proved that such uses were of two different kinds, as follows:

1. Trucks having a prior compression of the spirals and a subsequent compression of the elliptics.

2. Trucks having a simultaneous compression of both the spirals and elliptics when *only* the weight of the *empty* car body rested thereon.

We will briefly review the testimony. The pages noted are the pages of the Record in the Third Avenue case, which is now before this Court.

The *construction* of the trucks there complained of is shown in two photographs, at pp. 330 and 331, and "Complainant's Exhibit, Benjamin drawings," pp. 328, 329. The history of their *use* is made clear by the following extracts from the record in that case:

McGowan was the defendant's shop foreman. He testified, page 17, that when these Bemis trucks first went into use the shoe over the elliptical spring was secured directly to the sill of the car; that at that time "there was about one-quarter of an inch space, as near as I can remember, between the iron shoe and the band of the semi-elliptic spring;" that the Third Avenue Company began to use blocks of wood between the shoe and the car sill, about 1896, about one or two years after they first went into use; and that these blocks of wood were about half an inch thick. [They are shown in the two photographs.]

Robertson, superintendent of the Third Avenue Railroad, testified (p. 65, q. 44) that as near as he could recollect all of the trucks were provided with these blocks in the winter of 1895 and 1896. (They had been put in use in 1894.)

These blocks of wood were used to make the shoes take a bearing on the elliptic spring. (See Benjamin, p. 12, xq. 9.) Robertson (p. 63) testified: "Owing to the settlement of the elliptic springs we had to place a block between the spring shoe or plate and sill of car body so that the elliptic spring would come into use." These blocks varied from half an inch to about an inch, according to the settlement of the springs

(xq. 27); and this was decided by the "distance between the top of the spring and the spring shoe." (xq. 28.) He put in "whatever thickness was required" to "*bring the top of the spring in contact with the spring shoe.*" (xq. 32.)

Referring to the time when these trucks were *supplied* to the Third Avenue Company by the Bemis Car Box Company, Robertson testified (p. 64) that "when the weight of the body came on the spiral springs, the elliptic spring and shoe were about in contact." "As I viewed it, the spiral springs carried the weight of the body and the elliptic were a reinforcement to carry the passenger weight." Also that "when the car body was loaded the elliptic springs would come into play and consequently be depressed." Further explaining the blocking down of the shoes, he testified (p. 64):

> "×Q. 36. And you inserted the blocks between the spring shoe and the car sill so as to maintain the relative position of the elliptic spring, namely, that it should take its share in supporting a loaded car? Do I understand you correctly?
>
> "A. That is right.
>
> "×Q. 37. And the block that you put in was of sufficient thickness to force the spring shoe in contact with the elliptic spring under the weight of the car body without passengers? Is that correct?
>
> "A. What I mean by contact is simply just touching, without taking any load whatever."

The blocking down of the shoes is fully explained by Robertson at page 67: "The primary cause was that the spring was not large enough to do the work required. The primary cause was the size of the springs and not being large enough to carry the load required . . . the result of which was that the [elliptic] spring has settled." (The elliptic springs having taken a permanent set, the original distance between the top of the elliptic and the shoe was thereby increased.)

McGowan, being recalled (pp. 69, 70), referring to the condition of the trucks at the time he testified, June 30, 1898, said that the spring shoes over the elliptic springs are at the present time . . . "in contact with the spring shoe above them." He could not say whether all the elliptic springs were in contact or not at the time these trucks were received by the Third Avenue Railroad Company. There were some that were not in contact. He determined this by putting his rule between the shoe and the spring at a time when the weight of the empty car body was on the truck. In some of the trucks the weight of the car body caused the shoe to take a bearing on some of the elliptic springs. The rule he used was one-eighth of an inch thick, and that was the space he found between the elliptic spring and the shoe in some of the trucks before the weight of the car body was placed thereon. In the use of the trucks where the space between the elliptic spring and the shoe got to be about an eighth of an inch, they blocked them down "*so that the shoe would touch the top of the spring.*" (p. 71.)

Fleming testified that he "assembled" some of the Bemis trucks as they were received from the manufacturer and also assisted in placing the car bodies on them. He said (q. 26, p. 251):

> "When the car body was at rest on the springs and the parts fastened, state whether or not there was any space between the top of the elliptic springs and the caps over the elliptic springs? Answer. *Some of those springs scarcely touched the cap, while others did.*"

Thus it was established that the various uses by the Third Avenue Company of its trucks responded exactly to the requirements of both of the two groups of claims of the patent in suit.

We may observe that the Benjamin Drawings, put in evidence (pp. 828, 329) in making out the *prima facie* case, dis-

close a slight space over the elliptical springs; but these were made from a single car out of 182, and were made long after the cars had been in use and the elliptical springs had settled, whereas, the employees of the defendant company testified fully as to the use and condition of *all* these cars from their first installation and *during the entire period of their use from 1894 to 1897.*

We submit that it is fully made to appear that the facts of the case before him made it absolutely necessary for Judge Shipman "to accurately define" the scope of Claims 1 and 2, and that the Court below was under an entire misapprehension of the significance of the Third Avenue case, and committed an error when it found that "it was not necessary in that case for the Court to accurately define Claims 1 and 2 in order to determine what, if any, limitations not expressed therein were to be read into them by implication."

As to respondents' contention that the scope of Claims 1 and 2 is limited by the disclosures of the file wrapper.

Respondents' expert, Mr. Abbott (p. 128, Record), states the respondents' position as follows:

> "In view of these *repeated assertions* by applicant that his invention, as intended to be claimed in the Claims 1, 2, 3 and 4 . . . . , required the combination of spiral springs to normally support the car and its load, and weaker elliptical springs to act as supplements to the spirals, and at a later time the Examiner appears to have allowed the claims."

We will now show that this statement (except the last two lines) is entirely erroneous.

The following is an abstract from the File Wrapper and Contents of the application for the patent in suit (see Def. Rec. in Brill *vs.* Third Ave.):

Claims 1 and 2 (which were Claims 2 and 4 of the original application) are found at pp. 231, 232.

They were amended (April 22, 1892,) only to correct the spelling of the word "elliptical," and *were allowed as filed.* The following is their history:

On August 22, 1891 (pp. 239, 240), the first official letter stated as follows:

> "By reference to Peckham 419,876 [printed 410,876] January 21, 1890, it will be noticed in figures 4, 5 and 6 that semi-elliptic springs are used for the end of the car. It is held that no patentable difference exists in substituting an elliptic spring for the spring named, and especially in view of the following patent, wherein elliptic springs are shown for the end of the car, Taylor, 437,167, September 23, 1890. The arrangement of the upper and lower frames and the springs is in other respects very similar to Robinson, 451,952, May 12, 1891. (These references are all in Trucks, Street Car and Motor.) In view of the patents cited, therefore, Claims 1, 2, 3, 4, 11, 12, 13, 16, 17 and 25 are rejected."

The applicant replied to this official letter, on September 10, 1891 (pp. 240–242), thus:

> "(13). In view of the large number of claims rejected and the number of references cited, it is respectfully requested that each claim be treated separately *so that applicant may know what particular reference is cited against each particular claim.*"
>
> "(14). It may here be well to call the attention of the Office to the following:
>
> "That applicant's structure is a concrete truck independent in every way from a car body or its framing."

(Then follows a discussion, quoted below, of the Robinson, Taylor and Peckham patents.)

The official letter of October 29, 1891 (pp. 242–244), set forth:

> "It is not understood what is meant by saying one set of springs being slower in their action than the other set, as set forth in Claim 1 [original] and in other claims."
>
> "All that can be said is that one set of springs do not take a bearing or do not come into action until the other set have been *partially* compressed, *and this quality is set forth in some of the claims.* It is not seen how *slow* springs or *fast* springs can be properly the basis for claims."
>
> "Claims 1 and 3 [originals] include 'one set of springs slower in their action than the other set,' and as this expression is not fully understood, the claim may receive a further consideration after an explanation."
>
> "Claims 2 and 4 [now 1 and 2 of patent] *include and seem to depend for novelty* upon the idea of having *elliptical* springs at the *ends*, and in view of patent to Manier, August 17, 1889, 409,993, and Taylor of Record *which show the elliptical springs*, these claims are rejected."

[Observe that the Patent Office has now *withdrawn Peckham* 419,876 as a reference to *these two* (*broad*) *claims*, and therefore no future communication between the applicant and the Office can have any reference to the Peckham patent.]

What the Examiner *then* understood to be comprehended by the then Claims 2 and 4, was not a combination depending *upon time of action*, but a *broad idea.*

After several non-pertinent actions, the applicant filed an amendment and an argument (pp. 246–252). The following extracts are pertinent:

> "(3) The phrase in Claims 1, 3 [original]—'springs slower in their action than the other set'—is understood to mean as follows:
>
> . . . . . .

"It is well known that a spiral spring is quicker than an elliptic spring in recovering itself.

"Applicant has placed spiral springs primarily to support the weight of the car body, and has used the elliptical springs for the purpose of assisting the spiral springs in this regard after a certain compression of the spiral springs has been had. When the car body is depressed, the spiral springs *begin* to take up this action, and a *further depression* of the *car body* falls upon *both* the *spiral* and *elliptic* springs, the spiral spring sustaining the *greatest* amount of the *weight*. On the recovery the spiral springs exert the greatest lifting power, and by reason of their acting *quicker* than the *elliptical* springs, commence the lifting action before the elliptical springs come into play. The elliptical springs follow the spiral springs in the upward movement of the car body, *and during this upward movement*, (*as well as at other times*), they *also act* as equalizers, *counteracting the end oscillation of the car body*.

"If springs as *quick* in their action as the regular springs for supporting the car body were placed on the *extended ends* of the *side* beams, the before-stated action *could not take place*, and the spring action on the car body would be *too quick and jerky*.

"It is proposed in the present structure to use spiral *springs slower than usual* and to assist the action of the spiral springs by *elliptical springs slower in their action* than the spiral springs, so that the spiral springs will permit the car body to ride easier and smoother, and the elliptical springs assisting the spiral springs after a *certain amount* of movement by the spiral springs has been had, the action of the elliptical springs being softer than that of the spiral springs, gradually taking up compression, and making such compression soft and smooth. In the same way a softer recovery is had.

"A reconsideration of Claims *1 and 3* is respectfully requested in view of the foregoing."

"(4.) *As regards the 2nd and 4th claims* [now Claims 1 and 2 in suit]:

"The patent to Manier does not contain *the combination* of either of these claims. In that patent, the truck frame A is composed of the upper and lower side bars A^1, A^2 and bars D, D. He states he can use the elliptical springs shown in figure 3, *instead* of the spiral springs shown in figure 1 *in* the extensions of the truck frame, *but he nowhere hints at the combination of the elliptical and spiral springs for supporting the weight of the car.*

"He further states that when the car is mounted on the bars J, the weight thereof is transferred to the ends of the truck exterior to or beyond the axles. He further states that the movement of the body (meaning the body of the car) on the truck frame is entirely independent of the movement of the truck frame on the car axles. The springs F are not 'springs located between the movable and stationary frames.' They are located between the upper side bars A^1 and the axle boxes. *The combination of the second and fourth claims cannot be answered by figure 3 of this patent by reason of the foregoing.*

"The spring-supporting frame set forth in the fourth claim in the application are the side bars, etc., on which the spiral springs F of the Manier patent rest, *while in the* [*Manier*] *patent they rest on the axle boxes.* In the application the elliptical springs also *rest on the side bars or spring-supporting frame.* The spirals between frame A^1 and boxes are in no sense car-supporting springs, as the lower frame A^2 is the spring-supporting frame, and takes the weight as the specification states.

"*It will thus be seen that this patent does not contain the combination nor the invention of either of these two claims.*"

"The patent to Taylor shows no spiral springs between beams A and the beam marked W, figure 2, supposed to be the car body. *It therefore does not contain the combination of the 2d and 4th claims.*

"A citation of these two patents to show the combination set forth in either the 2d or 4th claims, is not in consonance with Commissioner Simonds' opinion rendered in *ex parte* Shannon, October 29, 1891.

"In that case a number of references were cited, and the Commissioner held 'that, as no one of the references suggested an improvement which had been arrived at by claimant, that their multiplicity, when all had fallen short of the result which applicant had actually attained, was evidence of the exercise of patentable invention on his part. . . .'

"The answer to these claims cannot be built up by a number of references. In this case there is an entirely new mode of operation, and that is the test [of the patentability of a new combination]."

After several non-pertinent actions, the Office, on March 7, 1892 (pp. 256–257), wrote the applicant as follows:

"It seems evident from the argument that there is no patentable distinction between quick springs and slow springs, it being a mere question of degree. *Claims 1 and 3 are not patentable. Claims 2 and 4 are rejected for the reasons before given.*"

Here it will be noted that there is no change of *time* of action. Claims 1 and 3 related to *quick* and *slow* springs. Claims 2 and 4 were not rejected for *either* reason, but for "reasons before given," in official letter of October 29, 1891, *supra*.

On April 21, 1892 (pp. 257-260), the applicant requested a reconsideration, stating:

"In regard to the statement in the last official letter, as follows: 'It seems evident from the argument that there is no patentable distinction between quick springs and slow springs, it being merely a question of degree;' applicant would state that he is not endeavoring to obtain a claim for the combination of quick and slow springs solely, but he is endeavoring to obtain claims for *the combination with other elements of springs having certain capacities, by which combination results and modes of operation are obtained*, which are not shown or described in any patent heretofore cited by the Office.'

. . . . . .

"However, Claims 1, 2, 3, 4 (as per last official letter) embody structural features in addition to those of the springs, before stated."

Applicant asked that "*if the rejection is reiterated, a specific statement of reasons in regard thereto be made.*"

The Office letter of May 24, 1892 (pp. 260, 261), again rejected Claims 1, 2, 3, 4, and 34 to 37 inclusive, "for reasons before given." No new or other "reasons" were given.

The applicant then (p. 261) amended by cancelling Claims 1 and 3, the original Claims 2 and 4 then becoming Claims 1 and 2 of the application, and asked for a reconsideration of Claims 1 and 2 and the other retained claims, "*as the reasons for rejection have become very complex.*"

Without any further pertinent action, the application was *thereupon allowed* and the *patent issued* with Claims 1 and 2 *as originally filed and as here in suit* (pp. 262, 263, 264).

It is clear that the applicant nowhere made any statement or admission qualifying in any way the broad Claims 1 and 2, but, on the contrary, always insisted upon their broad scope; that the Examiner never urged the limitation upon these claims for which the respondents here contend; that neither applicant nor the Examiner ever used any words when speak-

ing of either original Claims 1, 2, 3 and 4 which in any manner referred to *relative time of action* of *either* of the sets of springs; that qualifying words were used only as to Claims 1 and 3 and then only as to *quick* and *slow* springs, this relating to the "capacity" of the springs; that as to original Claims 2 and 4 (now Patent Claims 1 and 2) no qualifying words whatsoever were employed; and that the Patent Office finally allowed them without change or qualification of any sort.

It cannot be said that the Examiner passed Claims 2 and 4 (1 and 2) with the *understanding* that they were to be read with limitations *impressed thereon.* It was his duty to insist upon such limitations being incorporated in the claims, if such was his understanding.

That it was not his understanding is clearly evident from the record, and from the fact that *other claims* (9, 10, etc.) expressed the limitation as to *time of action,* though not even to the extent now imposed upon Claims 1 and 2 by the Court below.

The Peckham patent No. 419,876 was disposed of early in the history of the proceedings in the Patent Office. It was cited by the Patent Office in so vague a way that it did not clearly appear as to what point or feature it was brought forward, so that the applicant was never obliged to give it serious consideration in regard to the broad claims of his application. Indeed it was *withdrawn by the Examiner* after the very first letter of the applicant to the Office pointing out its irrelevancy.

The foregoing view of the file wrapper of the patent in suit shows conclusively that it was the intention of Brill to claim the subject-matter of Claims 1 and 2 in the broadest possible way. Nowhere does the file wrapper disclose any waiver or abandonment of this intention, or any abandonment or modification of any claim which could be construed into an abandonment of the invention as broadly stated in Claims 1 and 2. To support this statement, it is enough to say that Claims 1 and 2 *were allowed as filed.* But we may go further and take up the claims as originally filed and as allowed.

Claims 1 and 3 as originally filed were subsequently cancelled. They contained no mention of elliptic springs; they were founded upon the *varying quickness of springs* as distinguished from *difference* in *character* and *rhythm*, which latter distinction was incorporated in the original Claims 2 and 4. The cancellation of original Claims 1 and 3 can therefore have no possible effect on Claims 2 and 4. Claims 2 and 4 were *retained* and were *allowed as filed.* They became Claims 1 and 2 of the patent, and are now before this Court.

Original Claims 5, 6, 7, 8, 9, 10, now Claims 3, 4, 5, 6, 7, 8, of the patent, were *allowed as filed.*

Of these claims, patent Claim 3 relates to the brace, as does patent Claim 4, and patent Claim 5 combines the brace with the spiral and elliptic spring combination. Claim 5 contains no limitation or subsequent compression of the elliptics.

Claim 6 relates to the brace.

Claim 7 relates to the specific construction of the brace.

Claim 8 relates to the combination of the brace with elliptic and spiral springs, but has no limitation as to subsequent compression of the elliptics.

Original Claims 11 and 12, now patent Claims 9 and 10, were *allowed as filed.*

Claim 9, patent number, was the *first of the series of claims to suggest the subsequent compression*, as does also patent Claim 10. Neither of these claims specifically names elliptic springs; the difference between Claims 9 and 10 is that in 10 the *end springs* were adapted to subsequent compression.

Original Claim 13, now patent Claim 11, and original Claim 17, now patent Claim 14, were *allowed as filed.* These were *the first of the claims* in which the elliptics and spiral springs were mentioned with the limitation of the subsequent compression of the elliptics.

Original Claim 14, now patent Claim 12, was *allowed as filed.* This is the first claim which expressly recites the movable connection between the car sill or upper frame and the elliptics.

Original Claim 15, now patent Claim 13, was *allowed as filed.* It relates to details of construction.

The contention that the applicant got through the Patent Office only by admitting, in some way, that his broad claims group was limited to subsequent compression, is, we submit, fully disposed of by the existence in the patent as allowed of the more limited group of claims. If the broad claims were to be limited, then Claims 9, 10, 11 and 14 were useless. And it can hardly be possible that the Patent Office could have permitted the broad claims to stand upon any mere verbal understanding that they would be considered as being in some way of only a limited scope.

Nor does the position taken by the applicant's solicitor in his correspondence with the Patent Office aid the respondents in any way. On the contrary, it shows most clearly that the *applicant maintained throughout* the position *that Claims 1 and 2 are broad claims.*

We shall now refer to so much of the letter of applicant's solicitor of September 10, 1891 (pp. 240–242), to the Patent Office, as relates to the Robinson, Taylor and Peckham, 419,876, patents, cited by the Office.

In considering these quotations, references to "*Groups*" 1 and 2 are to be understood as those Groups have been hitherto understood in this Brief and as they were classified by Judge Shipman in his opinion: Group 1 (consisting of Claims 1 and 2—originally 2 and 4) covers the broad combination of spiral and elliptic springs. Group 2 (consisting of Claims 9, 10, 11 and 14) covers the combination so arranged that there shall be subsequent compression of the elliptics.

> "Robinson, of Record, does not show nor describe the arrangement of springs of *varying tension* [This refers to original Claims 1 and 3, which were subsequently cancelled],
>
> "nor springs adapted to supplement the action of other springs, nor springs coming into action before the other [This is group 2],

"nor the combination of spiral and elliptical springs for supporting the movable frame of the truck [This is group 1].

"Taylor of record does not show nor describe springs of *varying tension* interposed between the movable frame and stationary frame [This refers to the original claims 1 and 3 which were subsequently cancelled],

"nor does he show a movable frame. His truck has but one frame, and the springs that he shows are secured to the car body directly.

"Nor does he show the combination of elliptical and spiral springs, interposed between the movable and the stationary frame of the truck [This is group 1],

"nor does he show one series of springs adapted to act before the other, one supplementing the other [This is group 2].

"Peckham describes nothing about one set of springs being *quicker or slower* than the other [This refers to original Claims 1 and 3 which were subsequently cancelled],

"nor one series of springs being adapted to act prior to the other series [This is group 2]."

The solicitor for the applicant did not, of course, in this letter, call the attention of the Patent Office to the fact that Peckham, 419,876, did not show the broad combination of spiral and elliptic springs for supporting the movable frame of the truck (the subject-matter of *group 1*), because the communication from the Examiner in relation to this Peckham patent *did not state that any such combination was found in that patent.*

The Examiner, in citing a number of *diverse* patents against a number of claims covering *diverse* subject-matter, went contrary to the rule of the Patent Office that each claim must be considered separately by the Examiner and the references must be cited directly to such claim. The solicitor, in his

reply to this communication, was therefore himself compelled to make the above analysis of the references cited against him, *and in effect*, as shown above, he said to the Examiner, in urging the withdrawal of the Robinson, Taylor and Peckham references:

> "There are in my application several groups of claims covering distinct and diverse subject-matter, but you bunch the Robinson, Taylor and Peckham patents, which show distinct and diverse subject matters, against them all, without specifically applying them to the respective claims or groups. But I now point out to you that neither Robinson nor Taylor show the subject matter of either group 1 or group 2. As to Peckham, you do not pretend that he shows the subject matter of group 1, and I now point out to you that it does not show the subject-matter of group 2."

This analysis of the proceedings in the Patent Office shows the error of the respondents' contention below that the applicant had insisted upon the peculiar method of coaction and time of operation of his combination of spiral and elliptic springs and had, upon this differentiation, avoided the alleged anticipating references hereinbefore mentioned.

Such is clearly not the case. The applicant took his ground as to Claims 1 and 2 and stood on it, and the Patent Office gave him what he asked for on those two claims and nothing less.

Robinson and Taylor, cited in the Patent Office, were not deemed of sufficient importance by Judge Shipman even to be referred to by name in his opinion in the Third Avenue case. Peckham, 419,876, was referred to by him and disposed of as irrelevant and as imposing no limitation upon the claims. Judge Shipman thus took the same view as the Patent Office finally took.

The successive steps in the Patent Office thus shown may be summed up as follows:

First, the Examiner cited Peckham (and Taylor) against a *number* of claims, including both the broad claims and the narrow claims, and thereupon rejected *all* of those claims. The applicant then presented an argument (just cited) in which he pointed out that the references did not apply to *any* of the claims. Thereupon the Examiner withdrew the references (Peckham and Taylor) and proceeded to cite Manier and Taylor as references. Again the applicant pointed out that these references did not apply to the broad combination of group 1 (Claims 1 and 2). Then, after further unimportant steps, the Examiner withdrew Manier and Taylor and allowed the broad Claims 1 and 2. Throughout the entire proceedings there was not even a suggestion anywhere of any limitations to subsequent compression being imposed upon these claims.

The cases which hold that limitations placed on the scope of a patent in its progress through the Patent Office affect its scope, do not apply. For instance, Morgan Envelope Co. *vs.* Albany, etc., Co., 152 U. S. 425, held that an inventor who acquiesces in the *rejection* of his *claim* in one form and accepts a patent with the claim changed so as to correspond with the views of the Patent Office, is estopped to claim the benefit of the rejected claim. This principle is perfectly well settled, but it has no application to the present facts.

In Hillborn *vs.* Hale & Kilburn Mfg. Co., 69 Fed. Rep. 958, 16 C. C. A. 569, it was held (Shiras, Circ. J.) quoting the syllabus:

> "The fact that numerous changes in phraseology were made in the claims, from time to time, to suit the views of the Examiner, and to distinguish the claims from those contained in prior applications, is no ground for defeating the patent, where the claims remain throughout the proceedings substantially the same, and were at no time inconsistent with those finally granted."

The case at bar is even stronger than this. Brill made *no changes* in the Claims 1 and 2; he urged their allowance

without any limitation at every stage, and they were finally allowed exactly as filed.

Reece Button-Hole Mfg. Co. *vs.* Globe Button-Hole Mfg. Co., 61 Fed. Rep. 958, is an interesting case on this subject. It, in effect, decides that mere discussions and communications back and forth in the Patent Office, not leading to any substantial amendment in the specification or the abandonment of some substantial feature of the invention, or the rejection of claims, fully acquiesced in by the applicant, are not to be considered as affecting the interpretation of the specification and claims of the patent when granted, and in such cases they have no different effect from prior negotiations between parties leading up to a formal written contract.

In that case, Putnam, C. J., said: "Courts ought, therefore, to be the more careful, under circumstances like those at bar, to give a patentee the benefit of all the equities which can be raised in his behalf, by any reasonable implication, from what appears on the face of the amendments, or from the transaction as it passed through the Patent Office."

These considerations show why it was that the able counsel for the defendant in the *Third Avenue case*, Messrs. Briesen and Knauth, especially experienced in Patent Office practice, *did not attempt*, in their defence of that case, to show that the *proceedings in the Patent Office* in relation to this patent *imposed any limitation* upon the scope of Claims 1 and 2 of the patent in suit. They effectually dispose of the present attempt to place a limitation on the broad claims by reason of anything found in the file wrapper.

The Conception of the Completed Invention was in May, 1889, prior to Manier and Peckham 419,876 Patents.

The Record contains affidavits on behalf of the petitioners which show that the patentee fully conceived and completed the invention of the patent in suit as early as May, 1889.

This was prior to the date of Manier, August 27, 1889, and to Peckham 419,876 (January 21, 1890). If this fact can be made to appear at final hearing, these two patents, of course, become irrelevant to the issue. The subject was not considered of importance by Judge Shipman, for the reason that he disposed of both of those patents upon other grounds.

Without elaborating the matter further, we submit that the affidavits of John A. Brill (p. 33) and George Martin Brill (p. 46) set out facts which bring the case fully within the rule of Loom Co. *vs.* Higgins, 105 U. S. 594, where it was said:

> "But Webster had invented it before that time, and had made a drawing of it which, in March, 1868, he exhibited and explained to Davis. An invention relating to machinery may be exhibited either *in a drawing* or in a model, so as to lay the foundation of a claim to priority, if it be sufficiently plain to enable those skilled in the art to understand it."

Certainly the petitioners are entitled to go to final hearing on this evidence.

We submit that on the whole case the Court below erred in reversing the decree of the Circuit Court and directing the cause to be remanded with instructions to dismiss the bill.

We further submit that for reasons hereinabove set forth the decree of the Court below should be reversed and the Record be remanded to the Circuit Court with instructions to reinstate the bill of complaint and the preliminary injunction hitherto ordered by the said Court, to vacate its suspending order and to proceed with the cause to final hearing.

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